Supreme Court, U.S.
FILED
AUG 2 2 2006
OFFICE OF THE CLERK

No. 04-1350

IN THE

Supreme Court of the United States

KSR INTERNATIONAL CO.,

Petitioner,

—against—

TELEFLEX INC. and
TECHNOLOGY HOLDING CO.,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

JOINT APPENDIX

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PETITION FOR CERTIORARI FILED APRIL 6, 2005
CERTIORARI GRANTED JUNE 26, 2006

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The following decision, opinion and order have been omitted in printing this joint Appendix because they appear in the appendix of the Petition for a Writ of Certiorari on the following pages:

Decision Of The United States Court Of Appeals For The Federal Circuit Decided January 6, 2005 ... 1a

Opinion And Order Of The United States District Court For The Eastern District Of Michigan Filed December 12, 2003 ..... 18a

APPENDIX A — RELEVANT DOCKET ENTRIES OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2004-1152

TELEFLEX INC V. KSR INTERNATIONAL

[No Relevant Docket Entries]

APPENDIX B — RELEVANT DOCKET ENTRIES OF THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF MICHIGAN, DETROIT

U.S. DISTRICT COURT
Eastern District of Michigan (Detroit)
CIVIL DOCKET FOR CASE #: 2:02-cv-74586-LPZ

Teleflex Inc, et al v. KSR Intl Inc
Assigned to: Judge Lawrence P Zatkoff
Demand: $0

Date Filed: 11/18/2002
Jury Demand: Both
Nature of Suit: 190 Contract: Other
Jurisdiction: Federal Question

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V.

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Appendix B

Date Filed	Docket Text
	* * *
12/04/2002	ORDER reassigning case from Judge John Feikens to Judge Lawrence P. Zatkoff - Reason: companion case to 01-74775 (ew) (Entered: 12/05/2002)
	* * *
12/11/2002	AFFIRMATIVE defenses by defendant KSR Intl Inc (ew) (Entered: 12/12/2002)
01/02/2003	STIPULATED PROTECTIVE order by Judge Lawrence P. Zatkoff [EOD Date: 1/3/03] (DT) Modified on 01/03/2003 (Entered: 01/03/2003)
	* * *
02/06/2003	PRETRIAL scheduling order by Judge Lawrence P. Zatkoff - setting deadline for witness list for 5/30/03 , setting deadline for discovery for 6/13/03 , setting deadline for filing dispositive motions for 7/7/03 , setting final pretrial/settlement conference for 2:00 11/19/03 , setting trailing trial docket for December 2003 with proof of service (kb) (Entered: 02/07/2003)

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04/02/2003	MOTION by defendant to dismiss for lack of jurisdiction with brief, exhibits 1-5, and proof of service. (PP) (Entered: 04/02/2003)
04/02/2003	MOTION by plaintiff Teleflex Inc for protective order with brief, exhibits A-H, notice of hearing and proof of service. (RH) (Entered: 04/07/2003)
04/07/2003	ORDER by Judge Lawrence P. Zatkoff, referring motion for protective order by Teleflex Inc [9-1] to Magistrate Judge Steven D. Pepe , for hearing and determination , with proof of service. [EOD Date 4/8/03] (RH) (Entered: 04/08/2003)
04/09/2003	ORDER by Magistrate Judge Steven D. Pepe, setting hearing on motion for protective order by Teleflex Inc [9-1] for 5/28/03 , setting deadline for statement of issues in motion for protective order by Teleflex Inc [9-1] for 5/14/03 with proof of service [EOD Date 4/15/03] (lh) (Entered: 04/15/2003)
04/14/2003	ORDER by Judge Lawrence P. Zatkoff with stipulation, withdrawing by Robert M. Kalec as attorney for KSR Intl Inc , substitution for defendant KSR Intl Inc of attorney Kenneth J. McIntyre in place of attorney Robert M. Kalec [EOD Date: 4/15/03] (lh) (Entered: 04/15/2003)

Appendix B

04/14/2003 ORDER by Judge Lawrence P. Zatkoff allowing plaintiff to file exhibits "G" and "H" under seal [EOD Date 4/15/03] (lh) Modified on 04/15/2003 (Entered: 04/15/2003)

04/14/2003 MOTION by plaintiff Teleflex Inc to compel KSR to produce and disclose responses to the following interrogatories and requests with brief, exhibits "A" thru "F" and "I" thru "N", and notice of hearing (lh) (Entered: 04/15/2003)

* * *

04/21/2003 AMENDED ORDER by Magistrate Judge Steven D. Pepe, setting deadline for statement of issues in motion to compel KSR produce and disclose responses to the following interrogatories and requests by Teleflex Inc [14-1], motion for protective order by Teleflex Inc [9-1] for 5/14/03 , setting hearing on motion to compel KSR to produce and disclose responses to the following interrogatories and requests by Teleflex Inc [14-1] for 5/28/03, motion for protective order by Teleflex Inc [9-1] for 5/23/03, directing compliance with Local Rule 37.1 [EOD Date 4/24/03] (ew) (Entered: 04/24/2003)

* * *

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04/24/2003	ORDER by Judge Lawrence P. Zatkoff, allowing plaintiff to file exhibits under seal [23-1] [EOD Date 4/25/03] (ew) (Entered: 04/25/2003)

* * *

04/25/2003	MOTION by defendant KSR Intl Inc for protective order , stay of proceedings pending determination of dispositive motions with brief, exhibits 1-8, notice of hearing, proof of service (dh) (Entered: 04/28/2003)
05/02/2003	ORDER by Magistrate Judge Steven D. Pepe withdrawing motion for protective order by Teleflex Inc [9-1] with attachments [EOD Date 5/8/03] (kb) Modified on 05/08/2003 (Entered: 05/08/2003)

* * *

05/09/2003	RESPONSE by plaintiff to motion for protective order by KSR Intl Inc [26-1], motion stay of proceedings pending determination of dispositive motions by KSR Intl Inc [26-2] with proof of service. (PP) (Entered: 05/12/2003)
05/19/2003	REPLY by defendant KSR Intl Inc to defendant's response to motion for protective order by KSR Intl Inc [26-1] with exhibits 1-4 and proof of service. (RH) (Entered: 05/20/2003)

* * *

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06/09/2003	AMENDED STATEMENT by Teleflex Inc of resolved and unresolved issues as to motion to compel KSR to produce and disclose responses to the following interrogatories and requests by Teleflex Inc [14-1] with proof of service [EOD Date: 6/12/03] (kb) (Entered: 06/12/2003)
06/16/2003	ORDER by Magistrate Judge Steven D. Pepe withdrawing motion to compel KSR to produce and disclose responses to the following interrogatories and requests by Teleflex Inc [14-1] [EOD Date 6/18/03], with attachment. (PP) (Entered: 06/18/2003)

* * *

07/07/2003	MOTION by plaintiff Teleflex Inc for summary judgment of infringement of Engelgau Patent with brief, attachments "A" and "1" and exhibits "A" thru "K" (lh) Modified on 07/08/2003 (Entered: 07/08/2003)
07/07/2003	MOTION by plaintiff Teleflex Inc for summary judgment of infringement Johansson Patents with brief, attachments "B" and "1" and exhibits "A" thru "G" (lh) (Entered: 07/08/2003)

* * *

Appendix B

07/07/2003 MOTION by defendant KSR Intl Inc for summary judgment of invalidity with brief, exhibits "1" thru "13" and notice of hearing (lh) Modified on 07/08/2003 (Entered: 07/08/2003)

* * *

07/07/2003 ORDER by Judge Lawrence P. Zatkoff with stipulation, granting additional pages for parties' dispositive motion and brief [EOD Date: 7/8/03] (lh) (Entered: 07/08/2003)

* * *

07/28/2003 BRIEF in opposition by defendant to motion for summary judgment of infringement Johansson Patents by Teleflex Inc [38-1], motion for summary judgment of infringement of Engelgau Patent by Teleflex Inc [37-1] with exhibits 1-6, and proof of service. (PP) (Entered: 07/29/2003)

* * *

07/30/2003 SECOND declaration of Daniel H. Kruger (LS) (Entered: 07/31/2003)

* * *

08/07/2003 OPINION and order by Judge Lawrence P. Zatkoff denying motion to dismiss for lack of

jurisdiction by KSR Intl Inc [8-1] and the parties are to show cause in writing no later than 8/20/03 [EOD Date: 8/8/03] (RH) (Entered: 08/08/2003)

08/11/2003 ORDER by Judge Lawrence P. Zatkoff with stipulation, for dismissal with prejudice of claims II and III of Teleflex's second amended complaint [EOD Date: 8/12/03] (ew) (Entered: 08/12/2003)

* * *

08/11/2003 RESPONSE by plaintiff Teleflex Inc to motion for summary judgment of invalidity by KSR Intl Inc [41-1] with exhibits (ew) (Entered: 08/14/2003)

08/11/2003 REPLY brief in support of 37 Motion for Summary Judgment of infringement of Engelgau Pantent filed by Teleflex, Incorporated. (JPur,) (Entered: 02/12/2004)

08/21/2003 ORDER by Judge Lawrence P. Zatkoff with stipulation, setting deadline for KSR to file reply brief in support of their motion for summary judgment of invalidity [41-1] by 8/29/03 [EOD Date: 8/22/03] (lh) (Entered: 08/22/2003)

* * *

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09/19/2003 EXPARTE motion by plaintiff Teleflex Inc for oral argument with brief (lh) (Entered: 09/22/2003)

09/25/2003 MOTION by movant Tech Holding Co to intervene with exhibit "A" (intervenor complaint) and proof of service (lh) (Entered: 09/26/2003)

09/26/2003 ORDER by Judge Lawrence P. Zatkoff with stipulation, adding Technology Holding Company as party plaintiff [EOD Date: 9/29/03] (dh) (Entered: 09/29/2003)

* * *

10/01/2003 INTERVENOR'S complaint by Tech Holding Co, Teleflex Inc against defendant KSR Intl Inc with proof of service (dh) Modified on 10/02/2003 (Entered: 10/02/2003)

10/08/2003 BRIEF in opposition by defendant to motion for oral argument by Teleflex Inc [63-1] with attachments 1-4, and proof of service. (PP) (Entered: 10/09/2003)

10/16/2003 REPLY by plaintiff Teleflex Inc to response to motion for oral argument by Teleflex Inc [63-1] with proof of service. (RH) (Entered: 10/17/2003)

* * *

Appendix B

10/23/2003 ANSWER by defendant to intervenor complaint [71-1] with proof of service (ew) (Entered: 10/24/2003)

* * *

10/29/2003 MOTION by plaintiff Teleflex Inc to compel discovery with brief, exhibits A-F, proof of service and notice of hearing (lh) (Entered: 10/30/2003)

11/05/2003 EXPEDITED HEARING AND ORDER by Judge Lawrence P. Zatkoff, referring motion to compel discovery by Teleflex Inc [76-1] to Magistrate Steven D. Pepe , for hearing and determination with proof of service [EOD Date 11/6/03] (dh) (Entered: 11/06/2003)

11/07/2003 ORDER by Magistrate Judge Steven D. Pepe, setting hearing on motion to compel discovery by Teleflex Inc [76-1] for 11/19/03, setting deadline for statement of issues in motion to compel discovery by Teleflex Inc [76-1] for 11/18/03 [EOD Date 11/10/03] (PP) (Entered: 11/10/2003)

11/17/2003 RESPONSE by defendant KSR Intl Inc to motion to compel discovery by Teleflex Inc [76-1] with exhibits 1-9 and proof of service. (RH) (Entered: 11/18/2003)

* * *

Appendix B

11/18/2003 STATEMENT by plaintiff Teleflex Inc of resolved and unresolved issues as to motion to compel discovery by Teleflex Inc [76-1] [EOD Date: 11/19/03], with proof of service. (RH) (Entered: 11/19/2003)

* * *

11/25/2003 NOTICE by KSR Intl Inc pursuant to 35 USC 282 (ew) (Entered: 11/26/2003)

12/12/2003 OPINION and order by Judge Lawrence P. Zatkoff denying motion for oral argument by Teleflex Inc [63-1], granting motion for summary judgment of invalidity by KSR Intl Inc [41-1] and denying motion for summary judgment of infringement Johansson Patents by Teleflex Inc [38-1] and denying motion for summary judgment of infringement of Engelgau Patent by Teleflex Inc [37-1] [EOD Date: 12/23/03] (lh) (Entered: 12/23/2003)

12/12/2003 JUDGMENT entered by Judge Lawrence P. Zatkoff that plaintiffs' complaint is dismissed with prejudice [EOD Date: 12/23/03] and with proof of service (lh) (Entered: 12/23/2003)

* * *

01/12/2004 NOTICE of docketing from the U.S. Court of Appeals for the Federal Circuit (DHame,) (Entered: 01/31/2004)

Appendix B

01/11/2005	(Not Certified) ORDER from FC re [84] Notice of Appeal filed by Teleflex, Incorporated and Technology Holding Company, vacate and remand. [Appeal Case Number 04-1152] (LBeh,) (Entered: 01/11/2005)
02/01/2005	(Certified) ORDER from FC re [84] Notice of Appeal filed by Teleflex, Incorporated, and Technology Holding Company, vacate and remand. [Appeal Case Number 04-1152] (LBeh,) (Entered: 02/01/2005)
02/01/2005	APPEAL JUDGMENT from USCA as to [84] Notice of Appeal filed by Teleflex, Incorporated and Technology Holding Company, vacated and remanded. [Appeal Case Number 04-1152] (LBeh,) (Entered: 02/01/2005)
03/03/2005	NOTICE TO APPEAR: Status Conference set for 3/31/2005 10:30 AM before Honorable Lawrence P Zatkoff. (MVer,) (Entered: 03/03/2005)
03/21/2005	NOTICE of Change of Location for 93 Notice of Status Conference (JGilb,) (Entered: 03/22/2005)

* * *

Appendix B

10/03/2005	NOTICE of Change of Attorney Information by Teleflex, Incorporated, Teleflex, Incorporated. (Hirsch, Kevin) (Entered: 10/03/2005)
10/03/2005	NOTICE of Change of Attorney Information by Teleflex, Incorporated, Teleflex, Incorporated. (Susser, Steven) (Entered: 10/03/2005)

APPENDIX C — COMPLAINT DATED AND FILED NOVEMBER 18, 2002

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

TELEFLEX INCORPORATED,

Plaintiff,

v.

KSR INTERNATIONAL CO.,

Defendant.

RODGER D. YOUNG (P22652)
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COMPLAINT FOR PATENT INFRINGEMENT

Plaintiff Teleflex Incorporated ("Teleflex"), by its attorneys, Young & Susser, P.C., and for its Amended Complaint against Defendant KSR International Co. ("KSR"), alleges as follows:

Appendix C

PARTIES

1. Teleflex is a Delaware corporation, having its principal place of business at 630 W. Germantown Pike, Plymouth Meeting, Pennsylvania 19462.

2. Upon information and belief, KSR is a Canadian corporation, having its principal place of business in Ridgetown, Ontario, and an office in this district located at 20300 Civic Center Drive, #330, Southfield, Michigan.

JURISDICTION

3. This is an action for patent infringement under Title 35, United States Code, §§ 271 et seq.

4. This Court has jurisdiction under 28 U.S.C. § 1338.

5. Venue is proper pursuant to 28 U.S.C. §§ 1391 and 1400(b).

COUNT I
INFRINGEMENT OF '565 PATENT

6. Teleflex incorporates the allegations of the foregoing Paragraphs 1-5 as though fully set forth herein.

7. On May 29, 2001, United States Patent No. 6,237,565, entitled "Adjustable Pedal Assembly With Electronic Throttle Control" ("the '565 Patent"), was duly and legally issued by the United States Patent and Trademark

Office to Steven J. Engelgau. A copy of the '565 Patent is attached hereto as Exhibit A.

8. Teleflex is the current assignee of all right, title and interest in the '565 Patent, including the right to bring and maintain this action with respect to the '565 Patent.

9. KSR has made, used, offered for sale, and sold in the United States products infringing the '565 Patent and has otherwise committed acts prohibited by 35 U.S.C. § 271.

10. KSR continues to infringe the '565 Patent.

11. KSR's infringement is willful and intentional.

12. As a result of KSR's activities and infringement, Teleflex has suffered and will continue to suffer substantial damages.

13. KSR's infringement of the '565 Patent will continue unless and until enjoined by this Court.

COUNT II
INFRINGEMENT OF '239 PATENT

14. Teleflex incorporates the allegations of the foregoing Paragraphs 1-13 as though fully set forth herein.

15. On October 23, 2001, United States Patent No. 6,305,239 B l, entitled "adjustable pedal assembly" ("the '239 Patent") was duly and legally issued by the United Sates Patent

and Trademark Office to Mattias Johansson and Gunnar Fornell. A copy of the '239 Patent is attached hereto as Exhibit B.

16. Teleflex is the current assignee as to all right, title and interest in the '239 Patent, including the right to bring and maintain this action with respect to the '239 Patent.

17. KSR has made, used, offered for sale, and sold in the United States products infringing the '239 Patent and has otherwise committed acts prohibited by 35 U.S.C. § 271.

18. KSR continues to infringe the '239 Patent.

19. KSR's infringement is willful and intentional.

20. As a result of KSR's activities and infringement, Teleflex has suffered and will continue to suffer substantial damages.

21. KSR's infringement of the '239 Patent will continue unless and until enjoined by this Court.

COUNT III
INFRINGEMENT OF '695 PATENT

22. Teleflex incorporates the allegations of the foregoing Paragraphs 1-21 as though fully set forth herein.

23. On April 23, 2002, United States Patent No. 6, 374,695, entitled "adjustable pedal assembly" ("the '695 Patent") was duly and legally issued by the United Sates Patent and Trademark Office to Mattias Johansson and Gunnar Fornell. A copy of the '695 Patent is attached hereto as Exhibit C.

24. Teleflex is the current assignee as to all right, title and interest in the '695 Patent, including the right to bring and maintain this action with respect to the '695 Patent.

25. KSR has made, used, offered for sale, and sold in the United States products infringing the '695 Patent and has otherwise committed acts prohibited by 35 U.S.C. § 271.

26. KSR continues to infringe the '695 Patent.

27. KSR's infringement is willful and intentional.

28. As a result of KSR's activities and infringement, Teleflex has suffered and will continue to suffer substantial damages.

29. KSR's infringement of the '695 Patent will continue unless and until enjoined by this Court.

WHEREFORE, Teleflex Incorporated requests that this Court enter Judgment that:

A. Declares that the '565, '239, and '695 Patents are valid and infringed by KSR;

B. declares KSR's infringement of the '565, '239, and '695 Patents has been knowing and willful;

C. awards Teleflex its damages caused by KSR's infringement of the '565, '239, and '695 Patents, trebled pursuant to 35 U.S.C. § 284;

D. finds this to be an exceptional case pursuant to 35 U.S.C. § 285 and awards Teleflex its attorneys' fees and costs incurred in this matter;

E. permanently enjoins KSR and its subsidiaries, agents, officers, and employees, and all others acting in concert with it, from further infringement of the '565, 239, and '695 Patents under penalty of contempt; and,

F. awards to Teleflex such other and further equitable relief as the Court may deem necessary and proper to correct the injury to Teleflex and to the public interest caused by KSR's unlawful conduct.

YOUNG & SUSSER, P.C.

BY:

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Dated: November 18, 2002

Appendix C

Exhibit	Supplemental Joint Appendix page
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APPENDIX D — ANSWER AND AFFIRMATIVE DEFENSES DATED DECEMBER 11, 2002

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

CASE NO: 02-74586

TELEFLEX INCORPORATED,

Plaintiff,

vs.

KSR INTERNATIONAL CO.,

Defendant.

RODGER D. YOUNG (P22652)
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KSR INTERNATIONAL CO.'S ANSWER AND AFFIRMATIVE DEFENSES TO COMPLAINT FOR PATENT INFRINGEMENT AND RELIANCE ON JURY DEMAND

Defendant, KSR International Co. ("KSR"), by and through its attorneys, Dean & Fulkerson, P.C., responds and answers the Complaint for Patent Infringement as follows:

PARTIES

1. Defendant lacks information sufficient to form a belief as to the truth of the allegations contained in paragraph 1, and therefore they are denied.

2. The allegations in paragraph 2 are admitted.

JURISDICTION

3. The allegations contained in paragraph 3 are conclusions of law, not statements of fact to which an answer is required. To the extent an answer is deemed to be required the allegations are denied.

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4. The allegations contained in paragraph 4 are conclusions of law, not statements of fact to which an answer is required. To the extent an answer is deemed to be required the allegations are denied.

5. The allegations contained in paragraph 5 are conclusions of law, not statements of fact to which an answer is required. To the extent an answer is deemed to be required the allegations are denied.

COUNT I
INFRINGEMENT OF '565 PATENT

6. Defendant incorporates by reference its answers to paragraphs 1 through 5, as if fully set forth herein.

7. Defendant lacks information sufficient to form a belief as to the truth of the allegations contained in paragraph 7, and therefore they are denied.

8. Defendant lacks information sufficient to form a belief as to the truth of the allegations contained in paragraph 8, and therefore they are denied.

9. The allegations in paragraph 9 are denied.

10. The allegations in paragraph 10 are denied.

11. The allegations in paragraph 11 are denied.

12. The allegations in paragraph 12 are denied.

13. The allegations in paragraph 13 are denied.

COUNT II
INFRINGEMENT OF '239 PATENT

14. Defendant incorporates by reference its answers to paragraphs 1 through 13, as if fully set forth herein.

15. Defendant lacks information sufficient to form a belief as to the truth of the allegations contained in paragraph 15, and therefore they are denied.

16. Defendant lacks information sufficient to form a belief as to the truth of the allegations contained in paragraph 16, and therefore they are denied.

17. The allegations in paragraph 17 are denied.

18. The allegations in paragraph 18 are denied.

19. The allegations in paragraph 19 are denied.

20. The allegations in paragraph 20 are denied.

21. The allegations in paragraph 21 are denied.

COUNT III
INFRINGEMENT OF '695 PATENT

22. Defendant incorporates by reference its answers to paragraphs 1 through 21, as if full set forth herein.

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23. Defendant lacks information sufficient to form a belief as to the truth of the allegations contained in paragraph 23, and therefore they are denied.

24. Defendant lacks information sufficient to form a belief as to the truth of the allegations contained in paragraph 24, and therefore they are denied.

25. The allegations in paragraph 25 are denied.

26. The allegations in paragraph 26 are denied.

27. The allegations in paragraph 27 are denied.

28. The allegations in paragraph 28 are denied.

29. The allegations in paragraph 29 are denied.

The prayer for relief, in whole and in all of its sub-parts, is not an allegation of fact to which an answer is required. To the extent an answer is deemed to be required, the demand for relief is denied in whole and in all of its sub-parts.

AFFIRMATIVE DEFENSES

1. U.S. Patent No. 6,237,565 is unenforceable.

2. U.S. Patent No. 6,237,565 is invalid for failure to meet or to comply with one or more requirements of Title 35 of the United States Code.

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3. U.S. Patent No. 6,237,565 has not been infringed by any product that Defendant makes, uses, sells or has caused to be made, used or sold.

4. U.S. Patent No. 6,305,239 B1 is unenforceable.

5. U.S. Patent No. 6,305,239 B1 is invalid for failure to meet or to comply with one or more requirements of Title 35 of the United States Code.

6. U.S. Patent No. 6,305,239 B1 has not been infringed by any product that Defendant makes, uses, sells or has caused to be made, used or sold.

7. U.S. Patent No. 6,374,695 is unenforceable.

8. U.S. Patent No. 6,374,695 is invalid for failure to meet or to comply with one or more requirements of Title 35 of the United States Code.

9. U.S. Patent No. 6,374,695 has not been infringed by any product that Defendant makes, uses, sells or has caused to be made, used or sold.

WHEREFORE, Defendant, KSR International Co., requests that the Complaint be dismissed with prejudice, and that it be awarded its costs and attorneys fees and such other relief as the Court deems appropriate.

Appendix D

Respectfully submitted,

DEAN & FULKERSON, P.C.

By: /s/
Robert M. Kalec (P38677)
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Dated: December 11, 2002

Appendix D

RELIANCE ON JURY DEMAND

NOW COMES Defendant, KSR International Co., by and through its attorneys, Dean & Fulkerson, P.C., and hereby relies upon the demand for jury trial previously filed by Plaintiff in the above-entitled cause.

Respectfully submitted,

DEAN & FULKERSON, P.C.

By: /s/
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Dated: December 11, 2002

APPENDIX E — BRIEF IN SUPPORT OF DEFENDANT'S MOTION FOR SUMMARY JUDGMENT DATED AND FILED JULY 7 2003

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

Case No: 02-74586

TELEFLEX INCORPORATED,

Plaintiff,

vs.

KSR INTERNATIONAL CO.,

Defendant.

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Appendix E

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BRIEF IN SUPPORT OF DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF INVALIDITY

[Tables intentionally omitted]

STATEMENT OF ISSUES

Non-party Technology Holding Company ("THC") is the assignee and sole owner of U.S. Patent Nos. 6,237,565B1 (the "'565 Patent"), 6,305,239B1 (the "'239 Patent") and 6,374,695B1 (the "'695 Patent"). In this action commenced November 18, 2002, THC's alleged licensee, plaintiff Teleflex Incorporated ("Teleflex"), has accused defendant KSR International Co. ("KSR") of selling position-adjustable, vehicular control pedals that allegedly embody THC-owned "patented invention[s]," within the meaning of 35 U.S.C § 271(a).

On April 2, 2003, KSR moved for an Order dismissing this action for lack of subject matter jurisdiction, on the grounds that (a) Teleflex is not a "patentee" having standing to sue under 35 U.S.C. § 281, and (b) "any defect in standing creates a defect in subject matter jurisdiction, necessitating dismissal

under Federal Rule of Civil Procedure 12(b)(1)." *Lans* v. *Gateway 2000, Inc.*, 84 F. Supp. 2d 112, 114 n.6 (D.D.C. 1999), *aff'd sub nom. Lans* v. *Digital Equip. Corp.*, 252 F.3d 1320, 1328 (Fed. Cir. 2001) ("if a party lacks title to a patent, that party 'has no standing to bringing an infringement action' under that patent") (citation omitted). KSR's motion to dismiss remains pending.

In *KSR International Co.* v. *Technology Holding Co.*, No. 03-277-KAJ (D. Del., filed Mar. 12, 2003) (the "Delaware Action"), THC has accused KSR of infringing the same three patents as its alleged licensee, Teleflex, has asserted in this action. On April 16, 2003, KSR moved in the Delaware Action for summary judgment of invalidity of each of the THC-owned patents that Teleflex has attempted to assert in this action.

If despite the foregoing, this Court determines to adjudicate the validity of the THC-owned patents that Teleflex has attempted to assert in this action, the following issues are raised by the present motion for summary judgment:

1. Whether the '239 Patent is invalid under 35 U.S.C. § 102.

2. Whether the '695 Patent is invalid under 35 U.S.C. § 102.

3. Whether Claim 4 of the '565 Patent is invalid under 35 U.S.C. § 103.

4. Whether the '239 and '695 Patents are invalid under 35 U.S.C. § 103.

KSR responds: *YES*

FACTS

KSR International Company ("KSR") is a corporation organized and existing under the laws of Nova Scotia, Canada, having its principal place of business in Ridgetown, Ontario, Canada (Declaration of Larry Willemsen, sworn to July 7, 2003 [hereinafter "Willemsen Decl."] ¶ 2). KSR manufactures and supplies pedal systems, throttle controls, latches, handles, and other components installed as original equipment in various makes of vehicles manufactured by General Motors Corporation ("GM"), Ford Motor Company ("Ford"), DaimlerChrysler Corporation ("Daimler"), and other vehicle manufacturers worldwide. A description of KSR's business may be found at the "web site" associated with www.ksrint.com (Willemsen Decl. ¶ 3).

Non-party Technology Holding Company ("THC") is a corporation organized and existing under the laws of Delaware, having its principal place of business in Little Falls Centre II, 2751 Centerville Road, Suite 310, Wilmington, Delaware 19808 (Declaration of James W. Dabney, sworn to July 6, 2003 [hereinafter, "Dabney Decl."] ¶¶ 2-4 & Exs. 1 -

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1. As described more fully *infra*, the alleged "inventions" disclosed in the '239 Patent and the '695 Patent were originally assigned to Claes Johansson Automotive AB, a Swedish entity (Dabney Decl. ¶¶ 11-12 & Exs. 10-11).

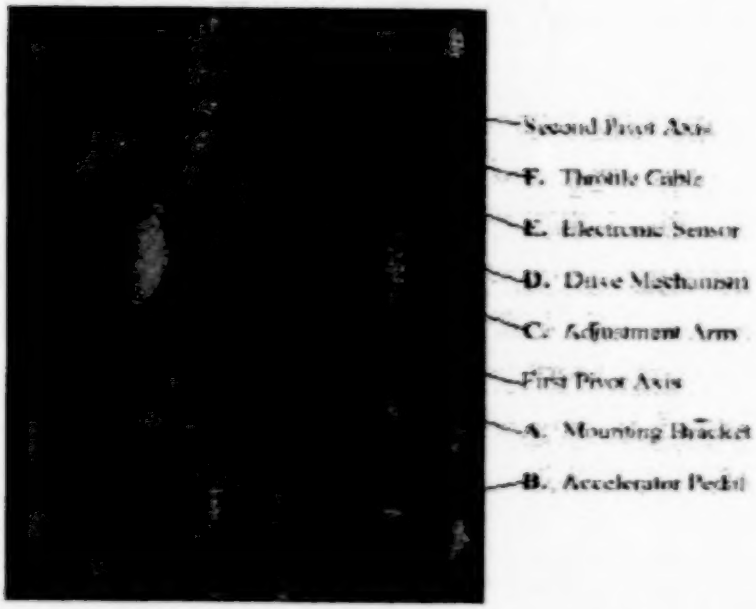
3). At the time this action was commenced on November 18, 2002, THC was the sole owner of the '565 Patent, the '239 Patent, and the '695 Patent (collectively the "THC Patents") by virtue of a series of assignments[1] including a written "Assignment of Patents" dated September 27, 2002, executed by Teleflex Inc. ("Teleflex") and recorded with the United States Patent and Trademark Office (the "September 2002 Assignment"; *see* Dabney Decl. ¶ 2 & Ex. 1).

Teleflex is a Delaware corporation headquartered in Plymouth Meeting, Pennsylvania (Dabney Decl. ¶ 2 & Ex. 1). Teleflex is a direct competitor of KSR in the business of supplying pedal systems to Ford, GM, Daimler, and other vehicle manufacturers.

Adjustable Pedal Assemblies

This case concerns position-adjustable vehicle pedals, commonly known as "gas pedals," that are used to actuate a motor vehicle's fuel system. A position-adjustable pedal is one whose resting position can be moved, or "adjusted," relative to a driver's seating position. Set forth below is an image of an "adjustable" pedal assembly that was installed in a 1975 Pontiac Grand Ville convertible (Willemsen Decl ¶ 7 & Ex. 1; Declaration of Daniel H. Kruger, sworn to July 6, 2003 [hereinafter, "Kruger Decl."] ¶ 21 & Ex. 1):

Appendix E



The pedal assembly depicted above includes a mounting bracket ("A") designed for attachment to a vehicle structure. The accelerator pedal ("B") is mounted on an adjustment arm ("C"). A drive mechanism ("D") is operably connected to the adjustment arm ("C"). Actuation of the drive mechanism ("D") causes the adjustment arm ("C") to rotate about its pivot axis, thereby moving the pedal ("B") between a plurality of operable positions (Willemsen Decl. ¶¶ 7, 27-28 & Exs. 1, 3-4)). Computer animations showing the actual movement of structures comprising a 1975 Pontiac Grand Ville adjustable accelerator pedal, and how those structures anticipate the asserted claims of the '239 and '695 Patents, appear in the files named "Pontiac" in the compact disk submitted as Exhibit 1 to this Brief (see Kruger Decl. ¶¶ 16-24 & Ex. 1).[2]

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2. The mpeg files in Exhibit 1 are best viewed with Windows Media Player or a similar program.

Appendix E

The 1975 Pontiac Grand Ville, like most cars built prior to 2002, came with an engine whose throttle was actuated by a cable. In vehicles equipped with cable-actuated throttle controls, depression of the accelerator pedal typically causes a cable to pull on a valve housed in a carburetor or fuel injection unit, thereby increasing the amount of fuel and air entering the engine and hence engine speed (Willemsen Decl. ¶ 8). Accelerator pedals designed to actuate throttle cables also often actuate electronic sensors, exemplified by the electronic sensor ("E") incorporated in the 1975 Pontiac Grand Ville pedal for controlling an automatic transmission (*id.* ¶ 7 & Ex. 1).

Commencing in the mid-1990's, increasing numbers of vehicles sold in the United States came equipped with engines whose throttles were controlled electronically, by computerized systems commonly known as "electronic throttle controls" ("ETC's"). Electronic throttle controls can accommodate improved traction control and vehicle directional stability systems, simplified cruise controls, and on-board computer-controlled systems for improving fuel economy and reducing tailpipe emissions (Willemsen Decl. ¶ 9). In vehicles whose engines are equipped with electronic throttle controls, accelerator pedals typically are coupled to a type of electronic sensor called a "potentiometer," which works something like a light dimmer (Willemsen Decl. ¶¶ 10 - 19 & Exs. 8-10).

In fact, an adjustable pedal assembly incorporating a potentiometer is disclosed in Figure 4 of published French Patent Application No. 2,739,947 to Urset ("Urset"), reprinted below (Dabney Decl. ¶ 7 & Ex. 6):

Appendix E

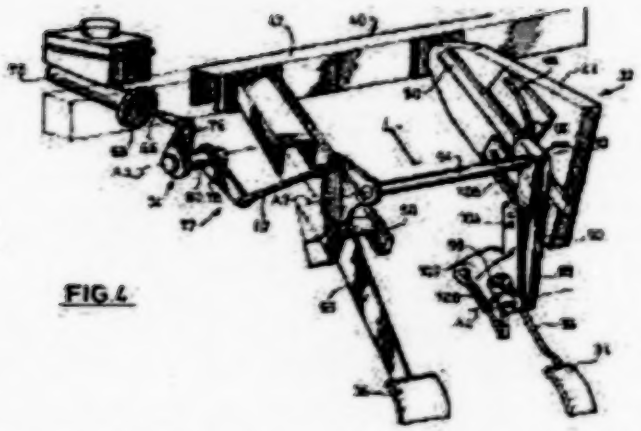

FIG. 4

In the above design, the accelerator pedal (34) acts on an electronic potentiometer (98) that modulates an electronic signal as a function of the angular position of the pedal around its pivoting axis A4 (Dabney Decl. ¶¶ 7-8 & Exs. 6-7; Willemsen Decl. ¶ 29 & Ex. 5). The electronic signal is communicated to a computer processor that, in turn, causes a fuel injection unit or other fuel system to vary the amount of fuel and air entering the engine (Willemsen Decl. ¶ 10). Computer animations showing the actual movement of structures disclosed in Urset, and how those structures anticipate the asserted claims of the '239 and '695 Patents, appear in the files named "Urset" in Exhibit 1 to this Brief (Kruger Decl. ¶¶ 32-39 & Ex. 1).

KSR Adjustable Pedals

In mid-1998, KSR was chosen by Ford to supply adjustable pedal systems for the Ford Crown Victoria, Mercury Grand Marquis, and Lincoln Town Car lines commencing with the 2001 model year. The Ford engines installed in these vehicles utilized cable-actuated throttle controls, and the KSR-supplied accelerator pedals

accordingly included cable-attachment arms. Neither Teleflex nor THC has ever alleged that any pedal systems supplied to Ford for the 2001, 2002, or 2003 model Crown Victoria, Grand Marquis, or Town Car programs incorporate or use any patented inventions allegedly owned by Teleflex or THC. KSR was awarded U.S. Patent No. 6,151,986 for the design of the adjustable pedal systems supplied to Ford commencing with the 2001 model year (Willemsen Decl. ¶ 24).

In mid-2000, KSR was chosen by GM to supply adjustable pedal systems for the Chevrolet and GMC light pick-up truck lines commencing with the 2003 model year. The GM engines installed in these vehicles utilized electronic throttle controls, and the KSR-supplied accelerator pedals accordingly included off-the-shelf electronic pedal position sensors — the identical sensors, in fact, as had been utilized in 1994 and later models of Chevrolet and GMC pick-up trucks equipped with optional diesel engines. KSR has patents pending on the design of the adjustable pedal system supplied to GM commencing with the 2003 model year (Willemsen Decl. ¶¶ 14-18, 25).

By letter dated March 28, 2001 — long prior to when Teleflex could have legitimately or legally seen the design of any KSR adjustable pedals that were then being developed for the 2003 model Chevrolet and GMC light pick-up truck lines — Teleflex sent a letter to KSR which stated in part (Willemsen Decl ¶ 26 & Ex. 2):

> We understand that you have made several proposals to General Motors Corporation based on an adjustable pedal product in combination

> with an electronic throttle control. . . . Teleflex believes that any supplier of a product that combines an adjustable pedal with an electronic throttle control necessarily employs technology covered by one or more of the above Teleflex patents and applications.

That is to say, Teleflex took — and apparently still takes — the position that it had somehow patented the "combination" of "an adjustable pedal with an electronic throttle control," and so could accuse KSR of patent infringement without even seeing how any KSR-manufactured pedal assemblies were designed or operated.

Course of Proceedings

After attempting and failing to persuade KSR to enter into a "business arrangement" involving "some type of royalty arrangement coupled with the supply by us [Teleflex] to you [KSR] of electronic throttle controls or other components of an adjustable pedal system" (Willemsen Decl. ¶ 26 & Ex. 2), Teleflex on December 17, 2001, commenced an action in this Court entitled *Teleflex Inc.* v. *KSR International Co.*, Case No. 01-74775 (the "First Teleflex Action"). The Complaint in the First Teleflex Action alleged that Teleflex was "the current assignee of all right, title and interest in the '565 Patent, including the right to bring and maintain this action with respect to the '565 Patent."[3] The

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3. Teleflex's Amended Complaint for Patent Infringement filed in the First Teleflex Action dated February 13, 2002, at ¶ 8.

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Complaint in the First Teleflex Action included no allegations relating to the '239 Patent or the '695 Patent.

On November 13, 2002, Teleflex voluntarily dismissed, without prejudice, its Complaint in the First Teleflex Action. Five days later, on November 18, 2002, Teleflex filed a new complaint commencing the present action, Case No. 02-74586 (the "Second Teleflex Action"). Teleflex's Complaint in this Second Teleflex Action alleged in part:

> 8. Teleflex is the current assignee as to all right, title and interest in the '565 Patent, including the right to bring and maintain this action with respect to the '565 Patent.
>
> 16. Teleflex is the current assignee as to all right, title and interest in the '239 Patent, including the right to bring and maintain this action with respect to the '239 Patent.
>
> 24. Teleflex is the current assignee as to all right, title and interest in the '695 Patent, including the right to bring and maintain this action with respect to the '695 Patent.

In fact, as KSR subsequently discovered, Teleflex as of November 18, 2002, was not the "assignee" or owner of any of the patents being asserted. Subsequent to the commencement of the First Teleflex Action, and prior to the commencement of the Second Teleflex Action, Teleflex on September 27, 2002, formally assigned to non-party THC "all of its [Teleflex's] right, title and interest in and to the

Inventions" covered by any "patent used exclusively or primarily in the conduct of Assignor's [Teleflex's] automotive, marine, aerospace/defense divisions businesses" (Dabney Decl. ¶ 2 & Ex. 1), including specifically "all claims by reason of infringement of the Patents and the right to sue and collect damages for such infringement" (*id.*). As KSR has previously demonstrated,[4] Teleflex's assignment of patents and patent claims to THC on September 27, 2002, destroyed any basis Teleflex might have had for claiming to be a "patentee" for purposes of 35 U.S.C. § 281, thus "necessitating dismissal under Federal Rule of Civil Procedure 12(b)(1)." *Lans* v. *Gateway 2000, Inc.*, 84 F. Supp. 2d 112, 114 n.6 (D.D.C. 1999), *aff'd sub nom. Lans* v. *Digital Equip. Corp.*, 252 F.3d 1320, 1321 (Fed. Cir. 2001) ("if a party lacks title to a patent, that party 'has no standing to bring an infringement action' under that patent") (citation omitted).

Promptly upon learning of Teleflex's non-ownership of the patents being asserted in this action, KSR commenced the Delaware Action against the patents' actual owner, non-party THC, and moved for an Order dismissing the present action for lack of subject matter jurisdiction.[5] On April 2, 2003, non-party THC served an answer in the Delaware Action that accused KSR of infringing the same three patents

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4. *See* Reply Brief in Support of Motion to Dismiss for Lack of Subject Matter Jurisdiction filed May 6, 2003.

5. See Brief in Support of Defendant's Motion to Dismiss for Lack of Subject Matter Jurisdiction filed April 2, 2003; Teleflex's Response to KSR's Motion to Dismiss for Lack of Subject Matter Jurisdiction filed April 22, 2003; Reply Brief in Support of Motion to Dismiss for Lack of Subject Matter Jurisdiction filed May 6, 2003.

(the "THC Patents") that Teleflex had attempted to assert in this Michigan action (Dabney Decl. ¶ 4 & Ex. 3). On April 16, 2003, KSR moved in the Delaware Action for summary judgment declaring the THC Patents invalid under 35 U.S.C. § 103 (*id.* ¶ 5 & Ex. 4). KSR's summary judgment motion in the Delaware Action remains pending and undecided.[6]

In the event that this Court determines to adjudicate the merits of the THC-owned patents and THC-owned claims for infringement that Teleflex has alleged in this action, KSR hereby moves for summary judgment declaring invalid each of the THC Patents under 35 U.S.C. §§ 102 and 103.

SUMMARY OF THE ARGUMENT

The claimed "inventions" of the THC Patents are invalid under 35 U.S.C. §§ 102 and 103, because prior art to the THC Patents expressly teaches both (a) the exact adjustable pedal configurations claimed in the THC Patents, and (b) the desirability of electronic pedal position sensors being deployed, mounted, and coupled to a vehicle's fuel system in the exact manner claimed in the THC Patents.

When it issued the THC Patents, the United States Patent and Trademark Office (the "Patent Office") did not have before it various references — including the 1975 Pontiac, Urset, U.S. Patent No. 5,010,782 to Asano ("Asano"), or U.S. Patent No. 2,860,720 to Huff ("Huff") — that disclosed each and every mechanical structure recited in the claims of the

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6. On April 28, 2003, the Court hearing the Delaware Action stayed proceedings in that action pending determination of KSR's pending motion to dismiss the within action for lack of subject matter jurisdiction.

THC Patents (Willemsen Decl. ¶¶ 27-41 & Exs. 1, 3-14; Kruger Decl. ¶¶ 2-39 & Ex. 1). Without the impediment of this art, Teleflex's and THC's patent counsel procured issuance of the THC Patents by arguing to the Patent Office — incorrectly — that the prior art supposedly did not disclose the mechanical configurations that the 1975 Pontiac, Urset, Asano, Huff, and other prior art indisputably do, in fact, disclose (Dabney Decl. ¶ 14 & Ex. 13 at 13, ¶ 15 & Ex. 14 at 21; ¶ 16 & Ex. 15 at 10; ¶ 17 & Ex. 16 at 11).[7]

The prior art submitted with this motion establishes, not just clearly and convincingly, but beyond any doubt whatsoever, that at relevant times the claimed "inventions" of the THC Patents were unpatentable under 35 U.S.C. §§ 102 and 103. Summary judgment is therefore warranted and appropriate. *Cf. Ryko Mfg. Co.* v. *Nu-Star, Inc.*, 950 F.2d 714 (Fed. Cir. 1990) (affirming summary judgment of invalidity under 35 U.S.C. § 103, where claimed "invention" consisted of mere substitution of electronic for mechanical activation device in automatic car wash).

ARGUMENT

United States patents contain "a grant to the patentee, his heirs or assigns, of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States . . . ." 35 U.S.C. § 154(a)(1). The scope of a patent "grant" is measured by the separately

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7. For purposes of the present motion, the Court may assume that THC's assignor's misdescriptions of the prior art during prosecution of the THC Patents were innocent.

numbered "claims" appearing at the end of a patent. *See Graver Tank & Mfg. Co.* v. *Linde Air Prods. Co.*, 336 U.S. 271, 277 (1949) ("We have frequently held that it is the claim which measures the grant to the patentee."). "While the cases more often have dealt with efforts to resort to specifications to expand claims, it is clear that the latter fail equally to perform their function as a measure of the grant when they overclaim the invention." *Id.*

The validity of a patent grant thus turns on whether its corresponding "claim" recites subject matter that is patentably distinct from the "prior art" that existed at relevant times. Overly broad patent claims cannot be "saved" from invalidity through judicial importation of limitations appearing only in the "specification" portion of a patent. *E.I. Du Pont de Nemours & Co.* v. *Phillips Petroleum Co.*, 849 F.2d 1430, 1433-34 (Fed. Cir.), *cert. denied*, 498 U.S. 986 (1988).

As used in the Patent Act, the term "prior art" refers to subject matter falling within the scope of 35 U.S.C. § 102. For purposes of the present motion, KSR relies on "prior art" meeting the standards of 35 U.S.C. §§ 102 (a) and (b) which provide:

> A person shall be entitled to a patent unless—
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, ...

According to interrogatory answers served by Teleflex, the alleged "inventions" of the '239 and '695 Patents were made on May 23, 1997 (Dabney Decl. ¶ 6 & Ex. 5, response to Interrogatory No. 11). Thus, under 35 U.S.C. § 102(a), the "prior art" of the '239 and '695 Patents includes any pertinent patents or printed publications issued prior to May 23, 1997, "in this or a foreign country," such as French Patent Appln. No. 2,739,947 to Urset published April 18, 1997 (Dabney Decl. ¶ 7 & Ex. 6).

The '239 and '695 Patents issued from "continuation" applications that claimed priority to a "parent" application filed November 24, 1997 (Dabney Decl. ¶¶ 14-15 & Exs. 13-14). Thus, under 35 U.S.C. § 102(b), the "prior art" of the '239 and '695 Patents also includes any pertinent products that were in public use or on sale in the United States on or prior to November 24, 1996, such as the adjustable pedals that were offered as an option in the 1975 Pontiac Grand Ville (Willemsen Decl. ¶ 7 & Ex. 1) and the electronic throttle control ("ETC") pedals that came standard in 1994 Chevrolet C/K pick-up trucks equipped with diesel engines (*id.* ¶¶ 14-19 & Exs. 8-10).

According to interrogatory answers served by Teleflex, the alleged "inventions" of the '565 Patent were made on February 14, 1998 (Dabney Decl. ¶ 6 & Ex. 5, response to Interrogatory No. 11). Thus, under 35 U.S.C. § 102(a), the

"prior art" of the '565 Patent includes any pertinent patents or printed publications issued prior to February 14, 1998, such as U.S. Patent No. 5,010,782 to Asano. The '565 Patent issued from a "continuation" application that claimed priority to a "parent" application filed January 26, 1999 (Dabney Decl. ¶ 17 & Ex. 16). Thus, under 35 U.S.C. § 102(b), the "prior art" of the '565 Patent also includes any pertinent products that were in public use or on sale in the United States on or prior to January 26, 1998.

I. THE '239 PATENT IS INVALID UNDER 35 U.S.C. § 102.

"It is well-settled that a claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference." *Celeritas Technologies, Ltd.* v. *Rockwell Int'l Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998). As set forth below, Claim 1 of the '239 Patent is fully anticipated by both Urset and the 1975 Pontiac Grand Ville adjustable accelerator pedal.

The '239 Patent (see Exhibit 2 hereto) discloses a single embodiment of an "adjustable pedal assembly" comprising the structures depicted below:

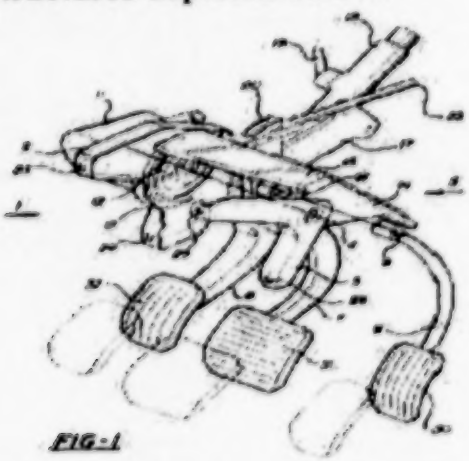

FIG-1

Appendix E

In the above design, an adjustable pedal assembly is disclosed comprising a "mounting arrangement" (2, 3, 23, 24, 25, 26) designed for attachment to a vehicle structure. A pedal (6, 7, or 8) is pivotally supported for rotation about a first pivot axis (9) with respect to the "mounting arrangement." An "adjustment element" (5) is pivotally supported for rotation about a second pivot axis (4) that is parallel to the first. A drive mechanism (11) is operably connected to the "adjustment element" (5) and causes it to rotate about its pivot axis, thereby causing the pedals to move between a plurality of operable positions. With regard to the accelerator pedal (6), the specification recites that it is "preferably connected to an electric control potentiometer," but that "a mechanical connection such as a wire or cable, can be used as an alternative to the electrical transfer" ('239 Patent at col. 5, lines 1, 41-43).[8]

Although the '239 Patent discloses various structures (e.g., the particular configuration of the disclosed, rearward facing "mounting arrangement") that THC's assignor(s) might have pointed out in claim 1 of the '239 Patent in order to distinguish the subject matter of that claim from the prior

---

8. The drawings submitted with the original Swedish "parent" application of the '239 Patent, filed by non-party Claes Johansson Automotive AB, notably did not include the Figure "36" or the associated text referring to "electronic control potentiometer 36" appearing in column 6, lines 1-9 of the '239 Patent (Dabney Decl. ¶ 11 & Ex. 10 at KSR007626). These matters appear to have been hand-written in by Teleflex's and THC's U.S. patent counsel.

art, [9] they did not do so. Rather, in an apparent attempt to exclude KSR from selling KSR-designed (and separately patented) pedal assemblies that are totally different, in design and mode of operation, from any "invention" even arguably disclosed in the '239 Patent, THC's and Teleflex's patent counsel wrote Claim 1 of the '239 so broadly and so generically that it is fully anticipated by prior art to the '239 Patent. [10]

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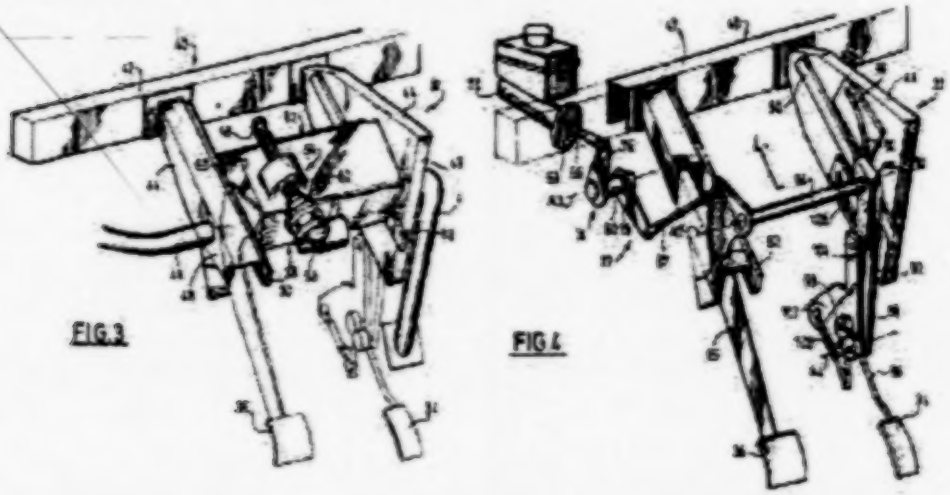
9. The '239 Patent was prosecuted as a "continuation" application filed September 5, 2000, based on the disclosure of a "parent" application that was filed nearly two (2) years previously and issued as U.S. Patent No. 6,151,984 (the "'984 Patent"; see Exhibit 3 hereto). The '984 Patent, whose claims are considerably narrower than those of the '239 and '695 Patents, has never been asserted against KSR.

10. It should be noted that, for purposes of determining whether a person is using a "patented invention" for purposes of 35 U.S.C. § 271(a), "the court must consider the substance of the invention along with the form of the claims," and must determine whether an accused product is or "is not the equivalent of the invention disclosed in [a] . . . patent". *Mead Digital Sys., Inc. v. A.B. Dick Co.*, 723 F.2d 455, 463 & n.12 (6th Cir. 1983) (emphasis added). See, e.g., *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 41-42 (1929) (quoting *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 573 (1864)); *Autogiro Co. of Am. v. United States*, 384 F.2d 391, 399-400 (Ct. Cl. 1967); *Nickerson v. Bearfoot Sole Co.*, 311 F.2d 858, 879-81 (6th Cir. 1962), *cert. denied*, 375 U.S. 815 (1963). No comparable "equivalents" analysis is pertinent to questions of anticipation under 35 U.S.C. § 102. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747-48 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

Appendix E

The '239 Patent is invalid under 35 U.S.C. § 102(a), because its sole claim is fully anticipated by Urset (*see* Willemsen Decl. ¶ 30 & Ex. 6; Kruger Decl. ¶ 32 & Ex. 1). A computer animation, comparing the words of Claim 1 of the '239 Patent with 3-dimensional images of the Urset disclosure, appears in the file named "Urset_239_claim_1.mpeg" in the disk submitted as Exhibit 1 to this Brief. A conventional claim chart comparing the language of Claim 1 of the '239 Patent with the Urset disclosure appears in Exhibit 6 to the accompanying Declaration of Larry Willemsen.

Figures 3 and 4 of Urset are reprinted below (Dabney Decl. ¶¶ 7-8 & Exs. 6-7):



In the above design, an adjustable pedal assembly is disclosed comprising a mounting arrangement (40, 44, 46, 52) designed for attachment to a vehicle structure. A pedal (34) is pivotally supported for rotation about a first pivot axis (A4) with respect to the mounting arrangement. An "adjustment element" (90) is pivotally supported on a shaft

(64) for rotation about a second pivot axis (A2) that is parallel to the first. A drive mechanism (56) is operably connected to the "adjustment element" (90) and causes it both to slide and to rotate about its pivot axis (A2), thereby moving the pedal (34) between a plurality of operable positions. Mounted adjacent to the accelerator pedal (34) is an "accelerator potentiometer" (98) whose electronic output varies "as a function of the angular position of the pedal 34 about its pivoting axis". The output of the disclosed "accelerator potentiometer" is independent of the pedal's adjustment movement between operable positions (Kruger Decl. ¶ 33; Willemsen Decl. ¶ 30 & Ex. 6; see Exhibit 1 hereto).

Under 35 U.S.C. § 282, "[t]he burden of establishing invalidity of the patent or any claim thereof shall rest with the party asserting such invalidity." Further, "the facts to support a conclusion of invalidity of an issued patent must be proved by clear and convincing evidence." *Ryko*, 950 F.2d at 716. These principles flow from the presumed expertise of the Patent Office in discharging its statutory functions, and the deference ordinarily due a Government agency when it considers a matter falling within its jurisdiction. *See American Hoist & Derrick Co.* v. *Sowa & Sons, Inc.*, 725 F.2d 1350, 1359 (Fed. Cir.), *cert. denied*, 469 U.S. 821 (1984).

But where, as here, an invalidity defense relies on prior art that was never considered by the Patent Office in issuing a challenged patent, there is no reason for a Court to defer to any non-existent judgment of the Patent Office with respect to the uncited art:

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> When an attacker, in sustaining the burden imposed by § 282, produces prior art or other evidence that was *not* considered in the PTO, there is . . . *no reason to defer* to the PTO so far as *its* effect on validity is concerned. Indeed, new prior art not before the PTO may so clearly invalidate a patent that the burden is fully sustained merely by proving its existence and applying the proper law. . . . When new evidence touching validity of the patent not considered by the PTO as relied on, the tribunal considering it is not faced with having to *disagree* with the PTO or with *deferring* to its judgment or with taking its expertise into account.

American Hoist, 725 F.2d at 1359-60 (emphasis in original).

"A patent, in the last analysis, simply represents a legal conclusion reached by the Patent Office," typically reached "in an *ex parte* proceeding, without the aid of the arguments which could be advanced by parties interested in proving patent invalidity." *Lear* v. *Adkins*, 395 U.S. 653, 670 (1969). The present case is a paradigm of one in which "new prior art not before the PTO . . . so clearly invalidate[s] a patent that the burden is fully sustained merely by proving its existence and applying the proper law." *American Hoist*, 725 F.2d at 1359-60.

Here as set forth above, in Willemsen Exhibit 6, and in the compact disk annexed as Exhibit 1 hereto, a single reference — Urset — clearly discloses each and every structure recited in Claim 1 of the '239 Patent. That claim is

accordingly invalid under 35 U.S.C. § 102(a). *Celeritas*, 150 F.3d at 1361.

Claim 1 of the '239 Patent is also fully anticipated by the adjustable pedal assembly that was installed as optional equipment in the 1975 Pontiac Grand Ville (Willemsen Decl ¶ 27 & Ex. 3; Kruger Decl. ¶ 18 & Ex. 1; see Exhibit 1 hereto). A computer animation, comparing the words of Claim 1 of the '239 Patent with 3-dimensional images of the 1975 Grand Ville accelerator pedal assembly disclosure, appears in the file named "Pontiac_239_claim_1.mpeg" in Exhibit 1 to this Brief. A conventional claim chart comparing the language of Claim 1 of the '239 Patent with photographs of the 1975 Grand Ville accelerator pedal assembly appears in Exhibit 3 to the accompanying Declaration of Larry Willemsen.

II. THE '695 PATENT IS INVALID UNDER 35 U.S.C. § 102

The disclosure of the '695 Patent (see Exhibit 4 hereto) is identical to that of the '239 Patent. The only difference between the '695 Patent and the '239 Patent is that the two claims of the '695 Patent include some additional descriptions of the alleged "inventions" that are not present in Claim 1 of the '239 Patent.

The '695 Patent is invalid under 35 U.S.C. § 102(a), because both of its claims are fully anticipated by Urset and the 1975 Pontiac Grand Ville accelerator pedal assembly (*see* Willemsen Decl. ¶ 28 & Ex. 4; Kruger Decl. ¶¶ 19-24 & Ex. 1). Computer animations, comparing the words of Claims 1 and 2 of the '695 Patent with 3-dimensional images of the

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Urset disclosure and the 1975 Pontiac Grand Ville accelerator pedal assembly, appear in the files whose names include "Urset" and "Pontiac" in the accompanying compact disk (see Exhibit 1 hereto). Conventional claim charts, comparing the language of Claims 1 and 2 of the '695 Patent with the Urset disclosure and the 1975 Pontiac Grand Ville accelerator pedal assembly, appear in Exhibits 4 and 7 to the accompanying Declaration of Larry Willemsen.

For the same reasons that Claim 1 of the '239 Patent is invalid under 35 U.S.C. § 102(a), Claims 1 and 2 of the '695 Patent are also and equally invalid under that statute. Each and every structure recited in Claims 1 and 2 of the '695 Patent is disclosed in Urset (*see* Exhibit 1 hereto; Willemsen Decl ¶ 31 & Ex. 7). Each and every structure recited in Claims 1 and 2 of the '695 Patent is also disclosed in the 1975 Pontiac Grand Ville pedal assembly (*id.* ¶ 28 & Ex. 4). These references are, without more, fatal to the validity of the '695 Patent.

When it issued the '695 Patent to THC's assignor, the Patent Office explained its action as follows (Dabney Decl. ¶ 15 & Ex. 14 at 26):

> The following is an examiner's statement of reasons for allowance: The prior art taken as a whole, neither teaches nor renders obvious an adjustable pedal assembly comprising a mounting arrangement, at least one pedal, an adjustment element, a first pivot axis connecting the pedal to the adjustment element, and a second pivot axis connecting the adjustment element to the

> mounting arrangement, said axises being parallel, and wherein the pedal is pivotal about the first axis which is movable with the adjustable element about the second axis (connected at the mounting arrangement).

When it made the above-quoted statement, the Patent Office did not have the benefit of Urset, the 1975 Pontiac Grand Ville Pedal, or U.S. Patent No. 2,860,720 to Huff ("Huff"; see Exhibit 13 hereto; Willemsen Decl. ¶ 40 & Ex. 14), each of which references disclosed the very combination of structure whose purported non-existence was the expressly stated basis for the Patent Office's issuance of the '695 Patent to Teleflex.[11] The record of this case shows, clearly and convincingly, that both claims of the '695 Patent are fully anticipated by prior art, and are therefore invalid under 35 U.S.C. § 102.

III. CLAIM 4 OF THE '565 PATENT IS INVALID UNDER 35 U.S.C. § 103.

35 U.S.C. § 103(a) provides:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth

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11. The Huff reference (see Exhibit 13 hereto) discloses all of the structure recited in the '239 Patent and '695 Patent claims except for the recited "electric generator", an off-the-shelf part used in vehicles whose engines utilize electronic, rather than cable-actuated, throttle controls. The Patent Office statement quoted in the text demonstrates clearly that there was and is no patentable novelty in attaching an off-the-shelf pedal position sensor to an otherwise old adjustable pedal configuration. The Huff reference is discussed more fully in Part IV, *infra*.

> in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

"Obviousness is a question of law based upon underlying factual determinations." *Sandt Technology, Ltd.* v. *Resco Metal & Plastics Corp.*, 264 F.3d 1344, 1354 (Fed. Cir. 2001) (quoting *Heidelberger Druckmaschinen AG* v. *Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1071 (Fed. Cir. 1994)). "Therefore, a district court can properly grant, as a matter of law, a motion for summary judgment on patent invalidity when the factual inquiries into obviousness present no genuine issue of material facts." *Ryko Mfg Co.* v. *Nu-Star, Inc.*, 950 F.2d 714, 716 (Fed. Cir. 1990).

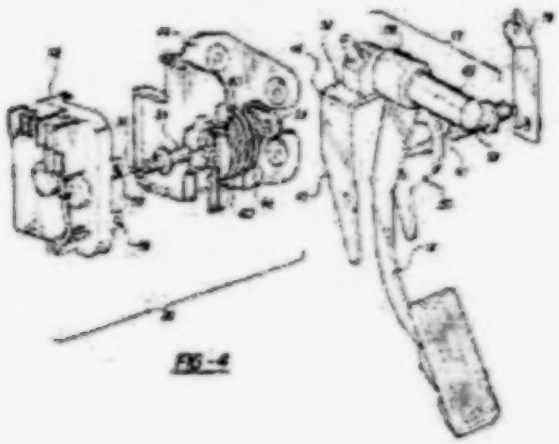
In *Graham* v. *John Deere Co.*, 383 U.S. 1, 17-18 (1966), the Supreme Court set forth the analytical framework for determining questions of patent invalidity under 35 U.S.C. § 103:

> Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt

> but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

As set forth below, Claim 4 of the '565 Patent is written so broadly as to leave no patentable "differences" between the claimed subject matter and the prior art of those patents. The absence of patentable "differences between the prior art and the claims at issue," 383 U.S. at 17, is demonstrated in the file named "Asano_565_claim_4.mpeg" of Exhibit 1 to the accompanying Declaration of Daniel H. Kruger and attached to this Brief as Exhibit 1. A conventional claim chart demonstrating the invalidity of the '565 Patent are submitted as Exhibit 12 to the accompanying Declaration of Larry Willemsen.

The '565 Patent (see Exhibit 5 hereto) discloses a "vehicle control pedal apparatus 12", the two preferred embodiments of which appear in the figures below:



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In the above design, an "adjustable pedal assembly 22" is pivotally mounted on a support (18, 44). A screw drive mechanism housed in a guide member (62) causes the pedal (14) to slide back and forth along the guide member. The position of the pivot (24) remains constant while the pedal arm (14) slides back and forth along a tubular guide member (62). In one embodiment, the assembly includes a "cable attachment member 78" for actuating an engine throttle cable. In a second embodiment, in lieu of or in addition to the "cable attachment member 78", the disclosed pedal assembly can optionally include an electronic pedal position sensor (42), characterized in the '565 Patent as an "electronic throttle control 28" (see Exhibit 5 hereto at col. 3, line 29). The disclosed "electronic throttle control" is a modular unit (42) attached to a portion of the pedal's support (18, 44) and engaged with the pivot member (34) of the pedal arm (14).

A. Scope and Content of Prior Art.

"The relevant art is defined by the nature of the problem confronting the would-be inventor." *Ryko*, 950 F.2d at 716. Here, the "problem" ostensibly confronting the '565 inventor was to provide an adjustable pedal assembly that could be installed in a vehicle whose engine utilized an electronic, rather than a cable-actuated, throttle control system. Thus, as the references cited on the face of the '565 Patent make clear, the "relevant art" to that patent includes (a) adjustable vehicle pedal assemblies and (b) electronic pedal position sensors.

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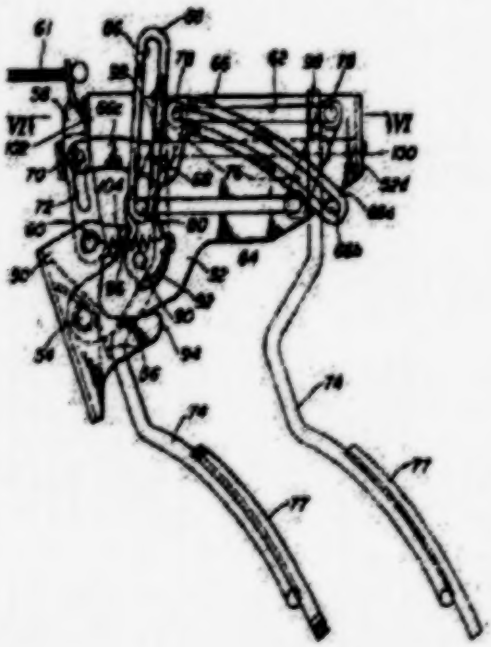
The prior art to the '565 Patent includes U.S. Patent No. 5,010,782 filed July 28, 1989 ("Asano"; see Exhibit 6 hereto). Figure 5 of Asano is reproduced at right, below; a computer animation of Asano appears at left, below (see Kruger Decl. ¶ 5):



In the above design, an adjustable pedal assembly is pivotally mounted on a support (50). The assembly includes a cable attachment structure (58) for actuating an engine throttle cable (61). A screw drive (100) housed in a guide member (52) causes the pedal (74) to slide back and forth along the guide member. The position of the support pivot (54) remains constant while the pedal arm (74) slides back and forth along a guide member (52). The operation of Asano is depicted in the computer animation file named "Asano_565_claim_4.mpeg" on the disk submitted as part of Exhibit 1 to the accompanying Declaration of Daniel H. Kruger. Asano was not cited to the Patent Office during

prosecution of the '565 Patent or its parent, even though Teleflex's and THC's patent counsel had cited Asano to the Patent Office during prosecution of the "parent" of the '239 Patent (see Exhibit 3 hereto).[12]

The prior art to the '565 Patent further includes specific teachings with respect to the desirability of electronic, as distinguished from mechanical, throttle controls in

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12. The design disclosed in the '565 Patent is virtually identical to that disclosed in U.S. Patent No. 5,722,302 filed October 2, 1996, and originally assigned to Comfort Pedals, Inc. (see Exhibit 1 at Rixon_Engelgau_565_4_compare.mpeg; Kruger Decl. ¶ 29 & Ex. 1; Willemsen Decl. ¶ 32 & Ex. 11; Dabney Decl. ¶ 9 & Ex. 8. KSR believes that pedal assemblies embodying the design disclosed in the '302 Patent were on sale or in public use long prior to January 26, 1998; however, THC and Teleflex have thus far interposed groundless objections to making discovery on this point. KSR has deferred challenging these objections in view of the pending motion to dismiss for lack of subject matter jurisdiction and KSR's co-pending motion filed April 25, 2003, for a stay of discovery-related proceedings pending determination of the subject matter jurisdiction issue.

The prior art status of the Ford Expedition pedal disclosed in Rixon '302 is a matter that KSR would pursue in discovery if this action were dismissed and proceedings in the Delaware Action resumed, or if the discovery period in this action were extended. In order to avoid a factual dispute concerning cumulative evidence of invalidity, KSR does not, in this motion, rely on Rixon '302, except to note that (a) Asano was cited during prosecution of Rixon '302, and thus not surprisingly, (b) the claims of Rixon '302 are much narrower than the claims of the '565 Patent.

automotive vehicles, from the point of view of engine management and pedal operability:

> Control of throttle in passenger cars and trucks is usually dependent upon the position of an accelerator pedal, which represents vehicle operator demand. The accelerator pedal position, or demand, is then linked to the engine throttle. Accelerator pedal movement was transmitted for many years through mechanical linkages consisting of solid rods and ball joints. In some applications, the solid rod linkage was replaced by a cable within a sleeve, referred to in the trade as a Bowden cable. These mechanical linkages are prone to problems which tend to affect all mechanical systems, such as sticking, freezing, breakage, and other mishaps. In addition, adaptation of the mechanical linkages to allow for special features such as more efficient energy utilization, reduced emissions, idle speed control, and "limp-home" modes of operation are generally not practical, or even possible in some cases.
>
> By using a sensor to sense accelerator demand, a servo-motor to control the throttle position, and a computer system to control operation of the throttle relative to the input from the accelerator pedal sensor and other various sensed inputs, a variety of special features may be incorporated in the accelerator-throttle linkage. In these computer-assisted systems, the throttle linkage is commonly

> referred to as a "drive-by-wire" system, since the linkage is electrical.

U.S. Patent No. 5,998,892 filed as of September 4, 1996; see Exhibit 7 at col. 1, lines 40-64.

The prior art to the '565 Patent further includes express teaching with regard to the desirability of electronic, as distinguished from mechanical, linkages between vehicle accelerator pedals and engine throttles:

> In the automotive art, accelerator type foot pedals are employed for controlling the flow of fluids to the engines. These usually include a pedal mounting affixed to the vehicle body and a series of links and levers, or Bowden wires, connecting the pedal to the carburetor, fuel injector, controller or the link. These link connections usually must be designed to withstand and accommodate engine movements relative to the vehicle frame, as well as to provide accurate control despite such movements. In addition, space must be provided for the linkages to function properly. The choices for routing of the mechanical control rods or wires are limited by their nature. With electrical sensing means directly associated with the pedal, the connection to a carburetor or the like can be accomplished with electrical wiring which relatively speaking, can free the connection problems from the special physical relationships of the older mechanical systems.

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U.S. Patent No. 5,408,899 filed June 13, 1993, at col. 1 lines14-32; see Exhibit 8.

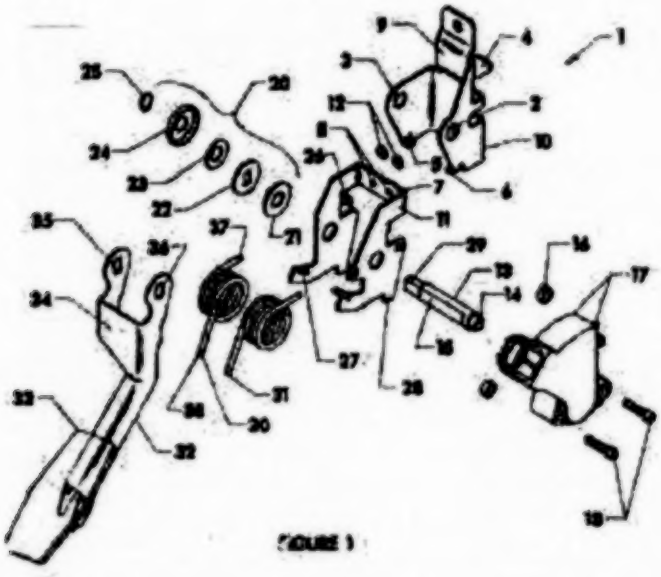
The prior art to the '565 Patent further includes express teachings with respect to the desirability of locating an electronic pedal position sensor adjacent to a vehicle's accelerator pedal, inside the vehicle's passenger compartment, rather than in a vehicle's engine compartment:

> An early design of an electronic control system located the movement detecting sensor in the engine compartment near the fuel pump; however, this arrangement proved undesirable due to the complex mechanical linkage required to connect the foot pedal to the sensor. Moreover, the harsh operating environment of the engine compartment exposed the sensor to heat, oil and dirt, which can contribute to premature failure of sensitive components. Subsequent designs thus located the sensor in the cab or operator compartment, the sensor being incorporated in a foot pedal arrangement that included a means for providing rotative motion of a potentiometer in response to depression of the foot pedal.

U.S. Patent No. 5,241,936 filed September 9, 1991; see Exhibit 9, at col. 1 lines 52-65.

The prior art to the '565 Patent further includes a number of modular, self-contained pedal position sensors that (a) were specifically designed to be mounted on the pivot of an accelerator pedal, and (b) were specifically intended and

marketed for use to actuate electronic throttle controls in vehicles. One example of a modular prior art pedal position sensor is disclosed in U.S. Patent No. 5,385,068 filed December 18, 1992 (the "'068 Patent"; see Exhibit 10; Willemsen Decl. ¶ 12). Figure 1 of the '068 Patent, depicting a "position sensor 17", is reproduced below:



A second example of a modular prior art pedal position sensor is the "503 Series" pedal position sensor manufactured by CTS Corporation of Elkhart, Indiana ("CTS") and offered for sale in the United States continuously since at least 1993 (Willemsen Decl. ¶¶ 14-19 & Exs. 8-10). A physical sample of a CTS 503 Series pedal position sensor is being submitted with this Brief (*id.* ¶ 18). The modular design of the CTS 503 Series sensor enabled it to be installed on different makes and models of vehicle accelerator pedal assemblies at relevant times (*id.* ¶ 19). At relevant times CTS provided specifications identifying minimum requirements (e.g., minimum surface requirements for attachment points) that

any person of ordinary skill in the pedal design art could follow and use to design a pedal assembly that could accommodate a CTS 503 Series sensor (*id.* ¶ 21)

The prior art to the '565 Patent further includes the accelerator pedal assembly installed in certain 1994 Chevrolet C/K pick-up trucks depicted in Exhibit 11 to this Brief (the "1994 GM ETC Pedal"). The 1994 GM ETC Pedal included a CTS 503 Series position sensor mounted on the pedal's support bracket, adjacent to the pedal and engaged with the pivot shaft about which the pedal rotated in operation (Willemsen Decl. ¶ 16). Depression of the 1994 GM ETC Pedal caused a pivot shaft to rotate inside the position sensor engaged with the pedal's pivot shaft, producing electronic signal outputs that vary with the pedal's operating position (*id.*). At all relevant times, CTS 503 Series pedal position sensors were specifically designed to be engaged with the rotating pivot shaft of an accelerator pedal assembly, and were preferably mounted adjacent to an accelerator's pivot shaft as exemplified by the 1994 GM ETC Pedal shown in Exhibit 6 to this brief (*id.* ¶¶ 19, 21).

The prior art to the '565 Patent further includes at least two adjustable pedal assemblies incorporating an electronic pedal position sensor, namely, Urset (described above) and U.S. Patent No. 5,819,593 filed August 17, 1995 ("Rixon '593"; see Exhibit 12). Figure 2 of Rixon '593 is reproduced below:

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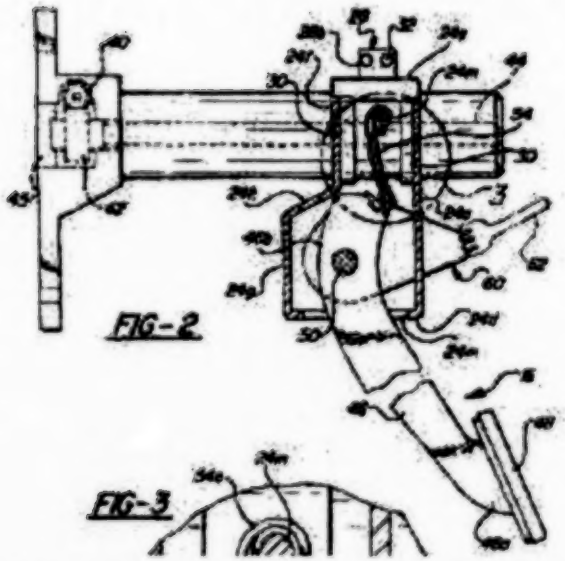

In the above design, an accelerator pedal (46) is pivotally mounted on the housing (24) of a sliding carrier assembly (12). A pedal position sensor, identified as "potentiometer 60", is engaged with the disclosed pedal's pivot shaft and emits varying electric signal outputs corresponding to the pedal's arm position as it pivots about the axis of the pivot shaft (50) between resting and applied positions. The pedal position sensor disclosed in Rixon is mounted in exactly the same way — engaged with the accelerator pedal's pivot shaft — as every other electronic pedal position sensor in the prior art of record, and also functions in exactly the same way as every other electronic pedal position sensor in the prior art of record.

B. Differences Between the Prior Art and Claim 4 of the '565 Patent

As is set forth in the computer animation file named "Asano_565_claim_4.mpeg" (see Exhibit 1 hereto; Kruger

Decl. ¶¶ 5-6), and as is also set forth in the claim chart submitted as Exhibit 12 to the accompanying Declaration of Larry Willemsen, Asano discloses each and every structure recited in claim 4 of the '565 Patent, with the exception of the optional "an electronic control (28) attached to said support" and "responsive to said pivot (24) for providing a signal (32) that corresponds to pedal arm position as said pedal arm pivots about said axis (26) between rest and applied positions." According to the '565 Patent, the recited "electronic control" can be "any of various electronic throttle control mechanisms known in the art, as the one described in" Rixon '593 (see Exhibit 12 hereto, at col. 3, lines 22-25).

C. The Level of Ordinary Skill in the Art at Relevant Times.

At relevant times, a person of average or "ordinary" skill in the art of the THC Patents would have had a minimum of two (2) years of college level training in mechanical engineering and two-three years' work experience spanning at least one complete pedal design "cycle" (Willemsen Decl. ¶ 20).[13] As set forth below, however, one need not have had

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13. Teleflex contends that a person of "ordinary" skill in the art of the THC Patents would have had "an undergraduate degree in mechanical engineering (or an equivalent amount of industry experience) who has familiarity with pedal control systems for vehicles" (Dabney Decl. ¶ 6 & Ex. 5, answer to Interrogatory No. 6). For purposes of this motion, the Court may assume, for purposes of argument, the skill level contended for by Teleflex, to the extent it differs from KSR's description.

any training in the mechanical arts in order to see that the subject matter of claim 4 of the '565 Patent was neither novel nor patentable as of January 26, 1998.

D. Claim 4 of the '565 Patent Recites a Trivial and Obvious Variant of Asano.

With regard to the '565 Patent, the legal question raised by this motion is whether, to a person of ordinary skill in the pedal design art as of January 26, 1998, it would have been obvious to combine (a) the adjustable pedal assembly of Asano, with (b) an off-the-shelf electronic pedal position sensor, such as the CTS 503 Series pedal position sensor. Under well-settled law, "when determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *Ecolochem, Inc.* v. *Southern Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000) (quoting *In re Beattie*, 974 F.2d 1309, 1311-12 (Fed. Cir. 1992) (quoting *Lindemann Maschinenfabrik GmbH* v. *American Hoist & Derrick Co.*, 730 F.2d 1452, 1462 (Fed. Cir. 1984))).

The record here abounds with evidence suggesting the "desirability" of adding an electronic pedal position sensor to Asano at relevant times:

— As of January 26, 1998, a vehicle manufacturer's choice of fuel system dictated whether a vehicle's accelerator pedal needed to be coupled to an electronic pedal position sensor, or not (Willemsen Decl. ¶ 22). Vehicles equipped

with electronic throttle controls require, by their very nature, the use of electronic sensors capable of sensing an accelerator pedal's position (*id.* ¶ 11). To be installable in a vehicle whose engines utilized an electronic throttle control, such as certain 1994 Chevrolet C/K pick-up trucks, the Asano pedal would have *had* to be coupled to an electronic pedal position sensor (*id.*). The fundamental requirements of electronic throttle control systems, without more, provided compelling suggestion and motivation to add an electronic pedal position sensor to Asano: without such an addition, the Asano pedal could not be installed in a vehicle with an electronic throttle control system,

— As of January 26, 1998, prior art of record expressly taught that electronic pedal position sensors coupled to electronic throttle controls had various operational advantages over mechanical cable linkages coupled to mechanical throttle controls (see Exhibits 7-9 hereto; Willemsen Decl. ¶ 9). These advantages (e.g., reduced emissions, better mileage, compatibility with "traction control" or similar features, avoidance of sticking or freezing of cables, etc.) all clearly pointed to the desirability of adding an electronic pedal position sensor to Asano: without such an addition, the owner of Asano could not offer the benefits of the Asano design to a vehicle manufacturer intending to utilize engine features dependent on electronic throttle control operation.

— As of January 26, 1998, prior art of record expressly taught that the preferred location for an electronic pedal position sensor in a vehicle was adjacent to the pivot shaft of an accelerator pedal (Willemsen Decl. ¶ 13). As of January

26, 1998, attaching a position sensor to a vehicle's accelerator pedal pivot shaft was a standard technique used to enable accelerator pedals to communicate with and actuate electronic throttle controls (*id.*). A prior art CTS 503 Series sensor could have been added to the Asano pedal design without materially altering that pedal (*id.* ¶ 36).

— As of January 26, 1998, prior art of record expressly taught that electronic pedal position sensors could be coupled to the accelerator pedal in an adjustable pedal assembly in exactly the same way as such sensors have been installed in non-adjustable pedal assemblies, namely, through engagement with the pivot shaft of the accelerator pedal (*compare* Exhibit 11 hereto (1994 GM ETC Pedal, with position sensor engaged with accelerator pedal pivot shaft) *with* Exhibit 12 hereto (Rixon adjustable pedal, with position sensor (60) engaged with accelerator pedal pivot shaft)).

The motivations for combining Asano with an electronic pedal position sensor, described above, are at least as clear and convincing as motivations that the Federal Circuit has found sufficient to invalidate patent claims under 35 U.S.C. § 103. For example, in *Ryko Mfg. Co.* v. *Nu-Star, Inc.*, 950 F.2d 714 (Fed. Cir. 1990), the patent-in-suit claimed an automatic car wash activated by an electronic keypad entry system. *Id.* at 717. The plaintiff alleged that he was the first to think of using a keypad entry system to activate a car wash (as distinct from some other type of powered system). In affirming a grant of summary judgment of invalidity under 35 U.S.C. § 103, the Federal Circuit in *Ryko* held that known advantages of using electronic keypad systems to control powered systems in general (e.g., garage doors) provided

ample motivation for using such a system to control a car wash. The present case is considerably more compelling than *Ryko*; for here, the record shows not only that pedal position sensors offer exactly the same functional advantages when coupled to adjustable and non-adjustable pedal systems, but that the choice of a vehicle engine's fuel management system, when electronic, actually *dictates* use of electronic pedal position sensors coupled to a vehicle's accelerator pedal as described above.

In *Novo Nordisk A/S* v. *Becton Dickinson & Co.*, 304 F.3d 1216 (Fed. Cir. 2002), the patent-in-suit claimed a 30 gauge needle in a pen-style insulin injection system. *Id.* at 1218-19. The prior art disclosed 30-gauge needles and pen-style insulin injection systems, but the plaintiff alleged that it was the first to think of offering the two features in combination. *Id.* In affirming a judgment holding the patent invalid under 35 U.S.C. § 103, the Federal Circuit cited evidence that the thinner needles "reduced the pain associated with self-administered insulin injections," and that "the known pain reduction provided the requisite motivation to narrow the needle" in the accused devices. *Id.* at 1219. Here, the known desirability, if not necessity, of utilizing electronic pedal position sensors to cooperate with an electronic throttle control in a vehicle provided "motivation" at least a compelling as that found invalidating in *Novo Nordisk*.

In *Richardson-Vicks Inc.* v. *Upjohn Co.*, 122 F.3d 1476 (Fed. Cir. 1997), the patent-in-suit claimed an over-the-counter ("OTC") medicine that combined the analgesic, ibuprofen, and the decongestant pseudo ephedrine. *Id.* at 1477. Although both medicaments were in the prior art, and

the prior art also included tablets combining pseudo ephedrine with aspirin and with acetaminophen, the plaintiff claimed that it was the first to think of offering pseudo ephedrine in a tablet with ibuprofen. In upholding a judgment of invalidity under 35 U.S.C. § 103, the Federal Circuit found that there was "strong motivation to combine the two ingredients into a single unit dosage" in view of publications announcing FDA intent to permit OTC sales of ibuprofen, and OTC industry anticipation that 'ibuprofen would quickly begin displacing acetaminophen and aspirin as the preferred analgesic." *Id.* at 1484. So too here, as of January 26, 1998, an increasing number of vehicles sold in the United States were being equipped with electronic throttle control systems because such systems offer various operational advantages over cable-actuated throttle control systems (Willemsen Decl. ¶ 9). This increased demand for pedals compatible with electronically controlled throttle systems provided clear commercial motivation for combining Asano and a CTS 503 Series sensor that was identical, in principle, to the motivation identified in *Richardson-Vicks* as warranting a conclusion of obviousness.

During the prosecution of the '565 Patent, the Patent Office took the position that "the use of an electronic throttle control means (28) attached to a support member (40, 26) in a pedal assembly is old and well-known in the art" (Dabney Decl. ¶ 17 & Ex. 16 at 4).[14] THC's assignor did not, and could not, dispute this contention. Instead, counsel for THC

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14. The Patent Office notably took the same position during prosecution of both the '239 Patent (Dabney Decl. ¶ 14 & Ex. 13 at 3-5) and the '695 Patent (id. ¶ 15 & Ex. 14 at 13).

and Teleflex argued that claim 4 of the '565 Patent was patentable because a *mechanical* limitation recited in the claim, namely, "wherein the position of said pivot (24) remains constant while said pedal arm (14) moves in fore and aft directions with respect to said pivot" (see Exhibit 5 hereto at col. 6, lines 34-36), purportedly did not exist in the prior art.[15] In fact, as illustrated in accompanying compact disk (Kruger Decl. Ex. 1; Willemsen Decl. ¶ 36), Asano discloses an adjustable pedal assembly whose support pivots remains in a constant position during pedal arm adjustment — the very feature that defendant's assignor argued distinguished claim 4 of the '565 Patent from the prior art.

Under a long and unbroken line of Supreme Court decisions, "[a] patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men." *Sakraida* v. *Ag Pro, Inc.*, 425 U.S. 273, 281 (1976) (quoting *Great Atl. & Pac. Tea Co.* v. *Supermarket Equip. Corp.*, 340 U.S. 147, 152 (1950)). The Supreme Court has thus repeatedly articulated and applied a special "test of

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15. With reference to what became claim 4 of the '565 Patent, defendant's assignor argued: "Independent claim 24 is a duplicate of claim 15 in the parent application except the word 'throttle' has been eliminated. . . . Accordingly, claim 24 is allowable for the same reasons claim 15 was allowed in U.S. Patent No. 6,129,241" (Dabney Decl. ¶ 17 & Ex. 16, at p. 11). THC's assignor argued that "claim 15 in the parent application" was allowable because the claim "require[d] the position of the pivot to remain constant while the pedal arm moves in fore and aft directions with respect to the pivot" (id. ¶ 16 & Ex. 15 at p. 10). That is exactly the design of Asano.

validity of combination patents," *Sakraida*, 425 U.S. at 482, which test asks whether an alleged invention "simply arranges old elements with each performing the same function that it had been known to perform," or whether a claimed combination produces "a 'new or different function'". *Id.* (quoting *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co.*, 396 U.S. 57, 60 (1969) (quoting *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U.S. 545, 549 (1938))).

In the present case, Claim 4 of the '565 Patent plainly flunks "the test of validity of combination patents." *Sakraida*, 425 U.S. at 282 (quoting *Anderson's-Black Rock*, 396 U.S. at 60). The claim purports to combine a pre-existing pedal assembly, such as Asano, with a pre-existing electronic position sensor, such as the CTS 503 series sensor, with both components doing nothing more than each component was designed, individually, to do. Claim 4 of the '565 Patent is thus indistinguishable in principle from the patent claim held invalid in *Anderson's-Black Rock*, where the claimed invention consisted of combining an old radiant heat burner with an old black top spreader, with neither component performing any new or different function from what they had been designed to do originally. As a matter of law, such a combination is "not an invention by the obvious-nonobvious standard." 396 U.S. at 63. "The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention." *Great Atl.*, 340 U.S. at 151 (quoting *Lincoln Engineering*, 303 U.S. at 549).

In view of the uncited Asano reference, the subject matter of claim 4 of the '565 Patent consists of nothing more than following the instructions associated with a CTS 503 Series position sensor and using such a sensor for its intended and designed purpose on a pre-existing adjustable pedal assembly design (Willemsen Decl. ¶¶ 17-21 & Exs. 8-10). The claim is clearly invalid under 35 U.S.C. § 103.

E. Secondary Considerations.

KSR is unaware of any secondary considerations as could support a legal conclusion of non-obviousness with respect to the subject matter of claim 4 of the '565 Patent (Willemsen Decl. ¶¶ 42-44). In response to interrogatories directed to this topic, Teleflex identified no secondary considerations tending to show non-obviousness (Dabney Decl. ¶ 6 & Ex. 5, answers to Interrogatory Nos. 8, 13).

Notably, however, as the Federal Circuit held in *Ryko*, summary judgment may be granted under 35 U.S.C. § 103 even where a patentee (which Teleflex is not) puts forward evidence of "secondary considerations" favoring patentability. The plaintiff in *Ryko* submitted affidavits that the claimed invention in that case — use of an electronic keypad to control a car wash — had enjoyed commercial success, had met a long felt need, and that others had tried and failed to solve the problem solved by the claimed invention. 950 F.2d at 719. The Federal Circuit nevertheless upheld the District Court's award of summary judgment invalidating the plaintiff's patent under 35 U.S.C. § 103, holding that "secondary considerations did not carry sufficient weight to override a determination of obviousness

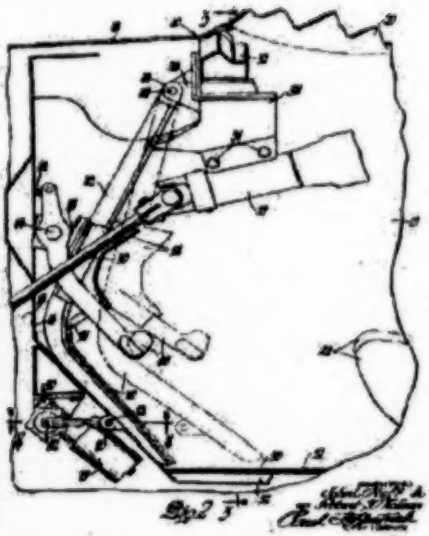
based on primary considerations," and that "a court is entitled to weight all the considerations, primary and secondary, and then render its decision" on the question of obviousness. *Id.*

IV. THE '239 AND '695 PATENTS ARE INVALID UNDER 35 U.S.C. § 103.

For substantially the same reasons that claim 4 of the '565 Patent is invalid under 35 U.S.C. § 103, claim 1 of the '239 Patent and claims 1 and 2 of the '695 Patent are equally invalid under that statute. The desirability, and thus the obviousness, of using pedal position sensors on vehicle pedal assemblies intended for use in vehicles having electronic throttle controls, described at pp. 23-27, *supra*, was no less documented as of November 20, 1996 (the critical date for the '239 and '695 Patents under 35 U.S.C. § 102(b)) than it was on January 26, 1998. The level of ordinary skill in the pedal design art was also the same as of both dates (Willemsen Decl. ¶ 20).

It remains only to be demonstrated that, as with the '565 Patent, the prior art considered by the Patent Office during the prosecution of the '239 and '695 Patents did not include a key reference, Huff (see Exhibit 13 hereto; Willemsen Decl. ¶¶ 38-40 & Exs. 13-14), which disclosed the exact mechanical configuration claimed in the '239 and '695 Patents. Figure 2 of Huff is reproduced at right, below; a computer animation of the Huff adjustable pedal assembly is reproduced at left, below (Kruger Decl. ¶ 7 & Ex. 1):

Appendix E



In the above design, an accelerator pedal (62) is pivotally supported for rotation about a first pivot axis (64). An "adjustment element" (42) is pivotally supported on a mounting arrangement (38) for rotation about a second pivot axis (48) that is parallel to the first. A drive motor (78) is operably connected to the "adjustment element" (42) and causes it to rotate about its pivot axis, thereby causing the pedals also to rotate about that axis. The accelerator pedal (62) is connected to a rod for actuation of a throttle control. Huff was not cited to the Patent Office during prosecution of the '239 Patent or the '695 Patent.

As set forth above, in the animations named "Huff" on Exhibit 1 hereto, and in the claim charts submitted as Exhibits 13 and 14 to the accompanying Declaration of Larry Willemsen, the sole difference between Huff, on the one hand, and the claimed "inventions" of the '239 and '695 Patents, on the other, is the presence of an optional, off-the shelf pedal position sensor, mounted on an accelerator pedal

pivot in exactly the same way as the pedal position sensor in the 1994 GM ETC Pedal, Urset, Rixon '593 and every other prior art pedal position sensor of record.

For all of the reasons set forth on pp. 28-35, above, claim 1 of the '239 Patent and claims 1 and 2 of the '695 Patent are invalid under 35 U.S.C. § 103. As of November 20, 1996, as the Patent Office repeatedly ruled during the prosecution of those patents,[16] there was no patentable novelty in adding on off-the-shelf pedal position sensor to a pre-existing adjustable pedal assembly, such as Huff. A position sensor could have been added to Huff without materially altering the design of Huff (Willemsen Decl. ¶ 41) and an artisan would have been naturally motivated to do this in order to render the Huff design usable in a modern vehicle whose fuel system was managed by an electronic throttle control (*id.* at ¶ 11). As of November 20, 1996, abundant motivations, incentives, and teachings existed to combine a modular position sensor, such as the CTS 503 Series sensor, with the Huff adjustable pedal assembly.

16. See Dabney Decl. ¶ 15 & Ex. 14 at 13; ¶ 14 & Ex. 13 at 3-5.

Appendix E

CONCLUSION

For all the reasons set forth above, defendant's motion for summary judgment should granted.

Dated: July 7, 2003 Respectfully submitted,

DICKINSON WRIGHT PLLC

By_____

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APPENDIX F — DECLARATION OF LARRY WILLEMSEN DATED AND FILED JULY 7, 2003

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

Case No: 02-74586

TELEFLEX INCORPORATED,

Plaintiff,

vs.

KSR INTERNATIONAL CO.,

Defendant.

DECLARATION OF LARRY WILLEMSEN

1. My name is Larry Willemsen. My business address is 95 Erie Street South, Ridgetown, Ontario, Canada N0P 2C0. I am Vice President of Design Engineering of KSR International Company ("KSR"). I have been employed by KSR continuously since 1985.

2. KSR is a corporation organized and existing under the laws of Nova Scotia, Canada, having its principal place of business in Ridgetown, Ontario, Canada.

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3. KSR manufactures and supplies pedal systems, throttle controls, latches, handles, and other components installed as original equipment in various makes of vehicles manufactured by General Motors Corporation ("GM"), Ford Motor Company ("Ford"), DaimlerChrysler Corporation ("Daimler"), and other vehicle manufacturers worldwide. A description of KSR's business may be found at the "web-site" associated with www.ksrint.com.

4. I attended Fanshawe College of Applied Arts and Technology between 1980 and 1984 concentrating in mechanical engineering technology. My initial employment by KSR in 1985 was as a Design Draftsman in which capacity I had personally designed all aspects of automotive pedal and latch products then offered sold by KSR.

5. Between 1988 and 1992 I held the title Product Design Engineer and worked as a liaison engineer to Ford Motor Company ("Ford") in connection with the design and development of brake, clutch, and accelerator pedals and latch systems that ultimately were installed in various Ford-manufactured car and light truck models. I personally worked on the design and development of pedal assemblies for the Ford programs FN9/DN5 (1986 Taurus/Sable/Continental), 90 Mark (1990 Lincoln Mark VII), FN36/EN53 (1992 Crown Vic/Grand Marquis/Town Car), FN10/MN12 (1992 T'Bird/ Cougar), the 1992 F-series pick-up trucks, and the 1992 ¾ Econoline.

6. Between 1992 and 2000 I held the title Product Design Engineering Manager and led a team of product engineers, designers, and prototype and testing technicians

engaged in the design and development of automotive pedal assemblies and other automotive products. During this period, I personally worked on the design and development of pedal assemblies for the Ford programs UPN105/106 (1995 Ranger/Explorer), WIN88 (1995 Windstar), DN101/ FN74 (1996 Taurus/Sable/Continental) and SN95 (1996 Mustang). During this period KSR also replaced Delphi Corp. as the supplier of accelerator pedals installed as standard equipment in Chevrolet and similar GMC pick-up trucks manufactured by GM and sold in the United States.

7. Annexed hereto as Exhibit 1 are photographs of a 1975 Pontiac Grand Ville convertible equipped with optional adjustable pedals. In the field of automotive pedal design, an "adjustable" pedal is one whose resting position can be moved, or "adjusted", relative to a driver's seating position. The adjustable pedal assembly depicted in Exhibit 1 includes (a) a mounting bracket ("A") for attachment to a vehicle structure; (b) an accelerator pedal ("B") mounted on an adjustment arm ("C") for pivotal rotation about a first pivot axis; (c) a drive mechanism ("D") connected to the adjustment arm ("C") for pivotal rotation of the latter about a second pivot axis; and (e) an electronic sensor ("E") that responds to movement of the pedal for controlling a vehicle system, namely, an automatic transmission.

8. The 1975 Pontiac Grand Ville, like most cars built before 2002, came with an engine whose throttle was actuated by a cable. In vehicles equipped with cable-actuated throttle controls, depression of the accelerator pedal typically causes a cable to pull on a valve housed in a carburetor or fuel

injection unit, thereby increasing the amount of fuel and air entering the engine and hence engine speed.

9. Commencing in the mid-1990's, increasing numbers of vehicles sold in the United States came equipped with engines whose throttles were actuated electronically, by computerized systems commonly known as "electronic throttle controls" or "ETC's". Electronic throttle controls are claimed to offer various operational advantages as compared with traditional cable-actuated throttle controls. These advantages include reduced tailpipe emissions, improved fuel economy, simplified cruise controls, and improved slip reduction and stability systems that are dependent on computer-controlled throttle actuation.

10. In vehicles whose engines are equipped with electronic throttle controls, depression of the accelerator pedal typically causes a shaft to rotate inside an electronic pedal position sensor, such as a potentiometer, resulting in the generation of an electronic signal of varying strength depending on the pedal position. The electronic signal is communicated to a computer processor that in turn causes a fuel injection unit or other fuel system to vary the amount of fuel and air entering the engine.

11. As of November 20, 1996 and January 26, 1998, the design of accelerator pedals installed in cars and light trucks sold in the United States was substantially determined by the type of engine and fuel system that an automaker specified was going to be installed in a vehicle. As of both November 20, 1996 and January 26, 1998, vehicles equipped with electronic throttle controls, by their very nature, required

the use of electronic sensors capable of sensing an accelerator pedal's position and emitting electrical signals corresponding to the pedal's position.

12. As of November 20, 1996 and January 26, 1998, one or more companies in the United States including CTS Corporation of Elkhart, Indiana made and sold modular electronic pedal position sensors that were (a) specifically designed to be mounted on the pivot of an accelerator pedal, and (b) specifically intended and marketed for use to actuate electronic throttle controls in vehicles, as exemplified by the "position sensor and switch assembly 17" disclosed in U.S. Patent No. 5,385,068 filed December 18, 1992 ("'068 Patent").

13. For accelerator pedals designed to actuate ETC-equipped engines in vehicles sold in the United States prior to November 20, 1996 and January 26, 1998, it was standard and preferred for electronic position sensors, such as potentiometers, to be mounted adjacent to the pivot of such a vehicle's accelerator pedal. This was done so as to enable the accelerator pedal pivot to double as, or to be coupled to, a shaft rotating inside the sensor. Additionally, being located inside a vehicle's passenger compartment, position sensors mounted adjacent to an accelerator pedal do not need to withstand the harsher operating environment existing under a vehicle's hood.

14. I am familiar with the GMC and Chevrolet C/K pick-up truck line that GM manufactured and sold in the United States during the 1994 model year which began in late 1993. Depending on which engine a customer ordered,

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1994 Chevrolet C/K pick-up trucks came equipped with either an electronic or a cable-actuated throttle controls. Different types of accelerator pedals were used to actuate the two types of throttle controls.

15. Annexed hereto as Exhibit 8 is a true copy of a GM engineering drawing dated February 9, 1993. Exhibit 8 depicts the design of the accelerator pedal that came installed in 1994 model Chevrolet C/K pick-up trucks equipped with optional diesel engines. The fuel systems in those vehicles were managed by an electronic throttle control.

16. As can be seen in Exhibit 8, the accelerator pedal assembly installed in certain 1994 Chevrolet C/K pick-up trucks (the "1994 GM ETC Pedal") included an electronic position sensor mounted on the pedal's support bracket, adjacent to the pedal and engaged with the pivot shaft about which the pedal rotated in operation. In the 1994 GM ETC Pedal, depression of the accelerator pedal causes a pivot shaft to rotate inside the position sensor engaged with the pedal's pivot shaft. Rotation of the pivot shaft produces electronic signal outputs that vary with the pedal's operating position and can be "read" and acted on by a microprocessor in an electronic throttle control.

17. The position sensor in the 1994 GM ETC Pedal was called a "503 Series" sensor manufactured by CTS Corporation of Elkhart, Indiana ("CTS"). CTS 503 Series position sensors have been offered for sale in the United States continuously since at least 1993.

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18. Annexed hereto as Exhibit 9 are true copies of CTS drawings dated April 5, 1994, and November 14, 1995, referring to CTS 503 Series pedal position sensors. Submitted with this declaration is a physical specimen of a CTS 503 Series pedal position sensor.

19. Annexed hereto as Exhibit 10 are photographs of a GM ETC Pedal with a CTS 503 Series position sensor of the type installed in 1994 and more recent models of Chevrolet pick-up trucks. As shown in Exhibit 10, CTS 503 Series sensors are modular, completely enclosed units with openings designed to fit over and engage a vehicle pedal's pivot shaft. This modular design enables CTS 503 Series position sensors to be installed on different makes and models of vehicle accelerator pedal assemblies.

20. As of November 20, 1996 and January 26, 1998, I was personally familiar with the education and work experience levels held by (a) a number of individuals reporting to me who were engaged in the design of automotive accelerator pedals, and (b) various individuals holding similar occupations with KSR competitors. As of both November 20, 1996 and January 26, 1998, a person having average or "ordinary" skill in the field of automotive pedal design would have had a minimum of two (2) years of college level training in mechanical engineering and 2-3 years' work experience spanning at least one complete pedal design "cycle".

21. CTS provides specifications identifying minimum requirements (for example, minimum surface requirements for attachment points) that any person of ordinary skill in

the pedal design art could follow and use to design a pedal assembly that would accommodate a CTS 503 Series sensor. As of both November 20, 1996 and January 26, 1998, attaching a position sensor to a vehicle's accelerator pedal pivot shaft was a standard technique used to enable accelerator pedals to communicate with and actuate electronic throttle controls.

22. As of November 20, 1996 and January 26, 1998, whether a vehicle pedal assembly actuated a cable, or an electronic position sensor, was dependent on the type of fuel system the pedal was being designed to actuate. As of both November 20, 1996 and January 26, 1998, it was a matter of mere choice, among known alternatives, whether a vehicle's engine incorporated a cable-actuated or an electronic throttle control. That choice, made by vehicle manufacturers, determined whether an accelerator pedal was or was not coupled to an electronic pedal position sensor.

23. As of and prior to November 20, 1996 and January 26, 1998, I was aware of electronic throttle control systems and the use of vehicle pedal position sensors to actuate such systems. The various Ford programs that I worked on between 1988 and 1996, described in paragraphs 5 - 6, above, involved vehicles whose engines utilized mechanical throttle controls. For example, the KSR-manufactured accelerator pedal developed for the 1995 Ford Windstar actuated a throttle cable, not because of any lack of familiarity on my or my staff's part with electronic throttle controls or pedal position sensors at the time, but simply because the fuel system installed in the 1995 Ford Windstar utilized a mechanical

throttle control and the manufacturer's pedal program accordingly specified a cable-actuated throttle.

24. In mid-1998, KSR was chosen by Ford to supply adjustable pedal systems for the Ford Crown Victoria, Mercury Grand Marquis, and Lincoln Town Car lines commencing with the 2001 model year. The Ford engines installed in these vehicles utilized cable-actuated throttle controls, and the KSR-supplied accelerator pedals accordingly included cable-attachment arms rather than electronic pedal position sensors. Neither Teleflex Incorporated ("Teleflex") nor Technology Holding Company ("THC") has ever alleged that any pedal systems supplied to Ford for the 2001, 2002, or 2003 model Crown Victoria, Grand Marquis, or Lincoln Town Car programs incorporate or use any patented inventions allegedly owned by Teleflex or THC. KSR was awarded U.S. Patent No. 6,151,986 for the design of the adjustable pedal system supplied to Ford commencing with the 2001 model year.

25. In mid-2000, KSR was chosen by GM to supply adjustable pedal systems for the Chevrolet light pick-up truck and GMC full size sport utility vehicle lines commencing with the 2003 model year. The GM engines installed in these vehicles utilized electronic throttle controls, and the KSR-supplied accelerator pedals accordingly included off-the-shelf CTS 503 Series electronic pedal position sensors — the same type and brand of sensors as had been utilized in 1994 and later models of Chevrolet and GMC pick-up trucks equipped with optional diesel engines as described in greater detail

below. KSR has patents pending on the design of the adjustable pedal system supplied to GM commencing with the 2003 model year.

26. Annexed hereto as Exhibit 2 is a true copy of a letter dated March 28, 2001, from Teleflex to KSR which states in part:

> We understand that you have made several proposals to General Motors Corporation based on an adjustable pedal product in combination with an electronic throttle control. . . . Teleflex believes that any supplier of a product that combines an adjustable pedal with an electronic throttle control necessarily employs technology covered by one or more of the above Teleflex patents and applications.

27. Annexed hereto as Exhibit 3 is a claim chart comparing (a) the words of claim 1 of U.S. Patent No. 6,305,239 B1 ("'239 Patent"), and (b) the 1975 Pontiac Grand Ville adjustable pedal assembly depicted in Exhibit 1 hereto. The descriptions in Exhibit 3 of the 1975 Pontiac Grand Ville adjustable pedal assembly are true and accurate.

28. Annexed hereto as Exhibit 4 are claim charts comparing (a) the words of claims 1 and 2 of U.S. Patent No. 6,374,695 B1 ("'695 Patent"), and (b) the 1975 Pontiac Grand Ville adjustable pedal assembly depicted in Exhibit 1 hereto. The descriptions in Exhibit 4 of the 1975 Pontiac Grand Ville adjustable pedal assembly are true and accurate.

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29. Annexed hereto as Exhibit 5 is a true copy of a figure from French Patent Application No. 2,739,947 to Urset and others published April 18, 1997 ("Urset"). This patent application discloses an adjustable pedal assembly designed to actuate a vehicle whose engine incorporates an electronic throttle control. The annexed figure from Urset depicts an accelerator pedal (34) and an electronic potentiometer (98) that modulates an electric signal as a function of the angular position of the accelerator pedal about its pivot axis A4.

30. Annexed hereto as Exhibit 6 is a claim chart comparing (a) the words of claim 1 of U.S. Patent No. 6,305,239 B1 ("'239 Patent"), and (b) excerpts from the English translation of Urset being submitted with the accompanying Declaration of James W. Dabney, Esq. (the "Urset Translation").

31. Annexed hereto as Exhibit 7 is a claim chart comparing (a) the words of claims 1 and 2 of U.S. Patent No. 6,374,695 B1 ("'695 Patent"), and (b) excerpts from the Urset Translation.

32. Annexed hereto as Exhibit 11 is a claim chart comparing (a) the words of claim 4 of U.S. Patent No. 6,237,565 B1 ("'565 Patent"), (b) excerpts from U.S. Patent No. 5,722,302 to Rixon, filed October 2, 1996 ("Rixon '302), and (c) the 1994 GM ETC Pedal depicted in Exhibits 8 and 10 hereto and embodied in 1994 and subsequent models of GMC and Chevrolet C/K pick-up trucks sold in the United States. The descriptions of the 1994 GM ETC Pedal in Exhibit 11 are true and accurate.

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33. The adjustable pedal assembly disclosed in the Rixon '302 Patent is pivotally supported by a mounting bracket (77), just as the 1994 GM ETC Pedal is. Conventional, off-the-shelf pedal position sensors that were on sale in the United States as of November 20, 1996 and January 26, 1998, including CTS 503 Series pedal position sensors, could have been fitted to the pivot at the mounting bracket (77) disclosed in Figure 6 of the Rixon '302 Patent without materially altering the Rixon '302 Patent pedal, in exactly the same way as the position sensor incorporated in the 1994 GM ETC Pedal is attached to the pivot shaft and support bracket in that pedal assembly.

34. As of November 20, 1996 and January 26, 1998, there were a number of specific motivations to combine (a) the CTS 503 Series position sensor of the 1994 GM ETC Pedal, and (b) the adjustable pedal assembly disclosed in the Rixon '302 Patent. As of both November 20, 1996 and January 26, 1998, an increasing number of vehicles sold in the United States came equipped with electronic throttle control systems because such systems offered various operational advantages over cable-actuated throttle control systems as described in paragraph 9, above. In order to function in a vehicle whose engine incorporated an electronic throttle control, the adjustable pedal assembly disclosed in the Rixon '302 Patent would have had to be coupled to an electronic pedal position sensor.

35. Annexed hereto as Exhibit 12 is a chart comparing (a) the words of claim 4 of U.S. Patent No. 6,237,565 B1 ("'565 Patent"), (b) excerpts from U.S. Patent No. 5,010,782 to Asano, filed July 28, 1989 ("Asano '782 Patent"), and (c)

the 1994 GM ETC Pedal depicted in Exhibits 8 and 10 hereto and embodied in 1994 and subsequent models of Chevrolet C/K pick-up trucks sold in the United States. The descriptions of the 1994 GM ETC Pedal in Exhibit 12 are true and accurate.

36. The adjustable pedal assembly disclosed in the Asano '782 Patent is supported by a pivot shaft (54), just as the 1994 GM ETC Pedal is. Conventional, off-the-shelf pedal position sensors that were on sale in the United States as of November 20, 1996 and January 26, 1998, including CTS 503 Series pedal position sensors, could have been fitted to the pivot (54) and support bracket (50) disclosed in Figure 5 of the Asano '782 Patent without materially altering the '782 Patent pedal, in exactly the same way as the position sensor incorporated in the 1994 GM ETC Pedal is attached to the pivot shaft and support bracket in that pedal assembly.

37. As of November 20, 1996 and January 26, 1998, the same motivations as existed for combining the Rixon '302 Patent and the CTS 503 Series position sensor of the 1994 GM ETC Pedal, described above, existed co-equally for combining that sensor with the Asano '782 Patent pedal. Prior to November 20, 1996 and January 26, 1998, a CTS 503 Series pedal position sensor could have been mounted adjacent to the pedal and pivot of the Asano '782 Patent without materially altering the Asano '782 Patent pedal.

38. Annexed hereto as Exhibit 13 is a chart comparing (a) the words of Claim 1 of U.S. Patent No. 6,305,239B1 ("'239 Patent"), (b) the disclosure of U.S. Patent No. 2,860,720 to Huff, filed Jan. 18, 1956 ("Huff '720 Patent"),

and (c) the 1994 GM ETC Pedal. The descriptions of the 1994 GM ETC Pedal included in Exhibit 13 are true and accurate.

39. As of November 20, 1996 and January 26, 1998, the same motivations as existed for combining the Rixon '302 or Asano '782 Patent, and the CTS 503 Series position sensor of the 1994 GM ETC Pedal, described above, existed co-equally for combining that sensor with the Huff '720 Patent pedal. Prior to November 20, 1996 and January 26, 1998, a CTS 503 Series pedal position sensor could have been mounted adjacent to the pedal and pivot of the Huff '720 Patent without materially altering the Huff '720 Patent pedal.

40. Annexed hereto as Exhibit 14 is a chart comparing (a) words of Claims 1 and 2 of U.S. Patent No. 6,374,695 B1 ("'695 Patent"), (b) excerpts from the Huff '720 Patent, and (c) the 1994 GM ETC Pedal. The descriptions of the 1994 GM ETC Pedal contained in Exhibit 14 are true and accurate.

41. At my request and direction, Dr. Daniel H. Kruger of Ames, Iowa, has prepared computer animations presenting the contents of the claim charts annexed hereto as Exhibits 3, 4, 6, 7, 11-14. In my opinion, the animations resident on Exhibit 1 to the accompanying Declaration of Daniel H. Kruger present fairly and accurately how the pedal position sensor of the 1994 GM ETC Pedal could be attached to either the Rixon '302 Patent pedal assembly, the Asano '782 Patent pedal assembly, or the Huff '720 Patent pedal assembly without materially altering any one of these assemblies.

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42. I am not aware of any need expressed by any vehicle manufacturer on or prior to November 20, 1996, for any position adjustable pedal assembly comprising an electronic pedal position sensor. I also am not aware of any person who attempted and failed to meet any need existing prior to November 20, 1996, for any position adjustable pedal assembly incorporating an electronic pedal position sensor.

43. Annexed hereto as Exhibits 15 and 16 are patent documents describing designs of KSR-manufactured adjustable pedal assemblies that Teleflex has accused of infringing one or more of the '565 Patent, the '239 Patent, or the '695 Patent (the "Accused Products"). The designs of the Accused Products differ in fundamental ways from any design described in any of the patents that Teleflex has asserted against KSR.

44. I am unaware of any connection between any (a) commercial success that the Accused Products, or any other position adjustable pedal products, have enjoyed, and (b) the mere fact that any such products may incorporate off-the-shelf electronic pedal position sensors.

45. Although I cannot speak for KSR's customers, I believe that the basis of automakers' demand for KSR-manufactured vehicle pedal assemblies stems from quality, innovation, price, performance, and service advantages that KSR offers relative to other manufacturers.

Appendix F

I, LARRY WILLEMSEN, hereby declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Dated: July 7, 2003

_____

Larry Willemsen

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APPENDIX G — DECLARATION OF DANIEL H. KRUGER DATED JULY 5, 2003 AND FILED JULY 7, 2003

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

Case No: 02-74586

TELEFLEX INCORPORATED,

Plaintiff,

vs.

KSR INTERNATIONAL CO.,

Defendant.

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Appendix G

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DECLARATION OF DANIEL H. KRUGER

1. My name is Daniel H. Kruger. My business address is Demonstratives, Inc., 2321 North Loop Drive, Ames, Iowa 50010 ("DI"). I was awarded a Ph.D. in Aerospace Engineering and Engineering Mechanics from Iowa State University in 1995. I was awarded an M.S. Degree in Aerospace Engineering and Engineering Mechanics from Iowa State University in 1992. I was awarded a B.S. degree in Physics and Mathematics from Morningside College in 1989. My undergraduate and graduate education in Engineering Mechanics included training in the reading of two-dimensional engineering drawings, such as patent drawings, and in the use of computer-aided design ("CAD") technology to create three-dimensional representations of objects depicted in two-dimensional engineering drawings. I have personal knowledge of the matters stated in this declaration.

2. Annexed hereto as Exhibit 1 is a compact disk containing twelve computer files entitled:

1. Asano_565_claim._4.mpeg

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2. Huff_239_claim_1.mpeg
3. Huff_695_claim_1.mpeg
4. Huff_695_claim_2.mpeg

5. Pontiac_239_claim_1.mpeg
6. Pontiac_695_claim_1.mpeg
7. Pontiac_695_claim_2.mpeg

8. Rixon_565_claim_4.mpeg
9. Rixon_Engelgau_565_claim_4_compare.mpeg

10. Urset_239_claim_1.mpeg
11. Urset_695_claim_1.mpeg
12. Urset_695_claim_2.mpeg

3. I personally supervised the creation of the contents of each of the computer files contained on Exhibit 1 using proprietary computer software tools developed by DI.

4. In creating the file on Exhibit I entitled "Asano_565_claim_4.mpeg," I studied the following documents: (a) U.S. Patent No. 5,010,782 to Asano ("Asano"); (b) a General Motors Corporation ("GM") drawing dated February 9, 1993, for Part No. 15974034 entitled "Pedal Assembly-Accelerator" and referring to "1994 C/K" (the "1994 GM Drawing"); and (c) U.S. Patent No. 6,237,565 B1 (the '565 Patent").

5. The file on Exhibit 1 entitled "Asano_565_claim_4.mpeg" includes true and accurate representations of (a) the position adjustable pedal assembly depicted in Figure 5 of Asano (the "Asano Pedal"); and (b) the pedal assembly depicted in the 1994 GM Drawing (the "1994 GM ETC

Pedal"). The trueness and accuracy of the images of the Asano Pedal and the 1994 GM ETC Pedal depicted in Exhibit 1 can best be seen by comparing those images to Asano Figure 5 and the 1994 GM Drawing.

6. The file on Exhibit 1 entitled "Asano_565_claim_4.mpeg," further includes demonstrative illustrations of the following: (c) how the modular position sensor attached to the support of the 1994 GM ETC Pedal could be similarly attached to the support of the Asano Pedal; (d) how, if a position sensor were attached to the support of the Asano Pedal, the sensor would provide a signal that corresponded to pedal's arm position as it pivoted about its axis between rest and applied positions; (e) how the position of the pivot supporting the Asano Pedal remains constant while the Asano Pedal arm moves in fore and aft directions with respect to the pivot; and (f) how the words of Claim 4 of the '565 Patent, read literally, may correspond to structures disclosed in Asano and the 1994 GM ETC Pedal.

7. In creating the file on Exhibit 1 entitled "Huff_239_claim_1.mpeg," I studied the following documents: (a) U.S. Patent No. 2,860,720 to Huff ("Huff"); (b) the 1994 GM Drawing; and (c) U.S. Patent No. 6,305,239 B1 (the "'239 Patent").

8. The file on Exhibit 1 entitled "Huff_ 239_claim_1.mpeg" includes true and accurate representations of (a) the position adjustable pedal assembly depicted in Figure 2 of Huff (the "Huff Pedal"); and (b) the 1994 GM ETC Pedal. The trueness and accuracy of the images of the Huff Pedal and the 1994 GM ETC Pedal depicted in Exhibit 1 can best

be seen by comparing those images to Huff and the 1994 GM Drawing.

9. The file on Exhibit 1 entitled "Huff_239_claim_1.mpeg" further includes demonstrative illustrations of the following: (c) how the modular position sensor mounted adjacent to the 1994 GM ETC Pedal could be similarly mounted adjacent to the support of the Huff Pedal; (d) how a position sensor, if mounted adjacent to the Huff Pedal, would emit an electric signal that varied with the position of the pedal about its pivot axis; (e) how the signal output of a position sensor so mounted would vary independently of the pedal's movement between different operable positions; and (f) how the words of Claim 1 of the '239 Patent, read literally, may correspond to structures disclosed in Huff and the 1994 GM Pedal.

10. In supervising the creation of the file on Exhibit 1 entitled "Huff_695_ claim_1.mpeg," I studied the following documents: (a) Huff; (b) the 1994 GM Drawing; and (c) U.S. Patent No. 6,374,695 B1 (the "'695 Patent").

11. The file on Exhibit 1 entitled "Huff_695_claim_1.mpeg" includes true and accurate representations of (a) the position adjustable pedal assembly depicted in Figure 2 of Huff (the "Huff Pedal"); and (b) the 1994 GM ETC Pedal. The trueness and accuracy of the images of the Huff Pedal and the 1994 GM ETC Pedal depicted in Exhibit 1 can best be seen by comparing those images to Huff and the 1994 GM Drawing.

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12. The file on Exhibit 1 entitled "Huff_695_claim_1_.mpeg" further includes demonstrative illustrations of the following: (c) how the modular position sensor mounted adjacent to the 1994 GM ETC Pedal could be similarly mounted adjacent to the support of the Huff Pedal; (d) how a position sensor, if mounted adjacent to the Huff Pedal, would emit an electric signal in response to movement of the pedal about its pivot axis; (e) how the signal output of a position sensor so mounted would respond to the pedal's pivotal movement in any of its adjusted positions; and (f) how the words of Claim 1 of the '695 Patent, read literally, may correspond to structures disclosed in Huff and the 1994 GM Pedal.

13. In supervising the creation of the file on Exhibit 1 entitled "Huff_695_claim_2.mpeg," I studied the following documents: (a) Huff; (b) the 1994 GM Drawing; and (c) U.S. Patent No. 6,374,695B1 (the "'695 Patent").

14. The file on Exhibit 1 entitled "Huff_695_claim_2.mpeg" includes true and accurate representations of (a) the position adjustable pedal assembly depicted in Figure 2 of Huff (the "Huff Pedal"); and (b) the 1994 GM ETC Pedal. The trueness and accuracy of the images of the Huff Pedal and the 1994 GM ETC Pedal depicted in Exhibit 1 can best be seen by comparing those images to Huff and the 1994 GM Drawing.

15. The file on Exhibit 1 entitled "Huff_695_claim_2.mpeg" further includes demonstrative illustrations of the following: (c) how the modular position sensor mounted adjacent to the 1994 GM ETC Pedal could be similarly

mounted adjacent to the support of the Huff Pedal; (d) how a position sensor, if mounted adjacent to the Huff Pedal, would emit an electric signal in reaction to pivotal movement of the pedal about its pivot axis; (e) how the signal output of a position sensor so mounted would respond to the pedal's pivotal movement in any of its adjusted positions; and (f) how the words of Claim 2 of the '695 Patent, read literally, may correspond to structures disclosed in Huff and the 1994 GM Pedal.

16. In creating the file on Exhibit 1 entitled "Pontiac_239_claim_1.mpeg," I studied the following documents: (a) excerpts from a service manual for the 1974 Pontiac Grand Ville; (b) photographs of an adjustable pedal assembly installed in an actual 1975 Pontiac Grand Ville; and (c) U.S. Patent No. 6,305,239 B1 (the "'239 Patent").

17. The file on Exhibit 1 entitled "Pontiac_239_claim_1.mpeg" includes true and accurate representations of an adjustable pedal assembly installed in an actual 1975 Pontiac Grand Ville. The trueness and accuracy of the images of the 1975 Pontiac Grand Ville pedal assembly depicted in Exhibit 1 can best be seen by comparing those images to the photographs of the 1975 Pontiac Grand Ville being submitted with the accompanying Declaration of Larry Willemsen.

18. The file on Exhibit 1 entitled "Pontiac_239_claim_1.mpeg" further includes demonstrative illustrations of the following: (a) how an electronic sensor mounted adjacent to the 1975 Pontiac Grand Ville accelerator pedal emits an electric signal that varies with the position of the pedal about its pivot axis; (b) how the signal output of the

disclosed electronic sensor varies independently of the pedal's movement between different operable positions; and (c) how the words of Claim 1 of the '239 Patent, read literally, may correspond to the structures disclosed in the 1975 Pontiac Grand Ville adjustable pedal assembly.

19. In creating the file on Exhibit 1, entitled "Pontiac_695_claim_1.mpeg," I studied the following documents: (a) excerpts from a service manual for the 1974 Pontiac Grand Ville; (b) photographs of an adjustable pedal assembly installed in an actual 1975 Pontiac Grand Ville; and (c) U.S. Patent No. 6,374,695 B1 (the "'695 Patent").

20. The file on Exhibit 1 entitled "Pontiac_695_claim_1.mpeg" includes true and accurate representations of an adjustable pedal assembly installed in an actual 1975 Pontiac Grand Ville. The trueness and accuracy of the images of the 1975 Pontiac Grand Ville pedal assembly depicted in Exhibit 1 can best be seen by comparing those images to the photographs of an actual 1975 Pontiac Grand Ville being submitted with the accompanying Declaration of Larry Willemsen.

21. The file on Exhibit 1 entitled "Pontiac_695_claim_1.mpeg" further includes demonstrative illustrations of the following: (a) how an electronic sensor mounted adjacent to the 1975 Pontiac Grand Ville accelerator pedal emits an electric signal in response to pivotal movement of the pedal about its pivot axis; (b) how the disclosed electronic sensor responds to the accelerator pedal's pivotal movement in any of the pedal's adjusted positions; and (c) how the words of Claim 1 of the '695 Patent, read literally, may correspond

to the structures disclosed in the 1975 Pontiac Grand Ville adjustable pedal assembly.

22. In creating the file on Exhibit 1, entitled "Pontiac_695_claim_2.mpeg," I studied the following documents: (a) excerpts from a service manual for the 1974 Pontiac Grand Ville; (b) photographs of an adjustable pedal assembly installed in an actual 1975 Pontiac Grand Ville; and (c) U.S. Patent No. 6,374,695 B1 (the "'695 Patent").

23. The file on Exhibit 1 entitled "Pontiac_695_claim 2.mpeg" includes true and accurate representations of an adjustable pedal assembly installed in a 1975 Pontiac Grand Ville. The trueness and accuracy of the images of the 1975 Pontiac Grand Ville pedal assembly depicted in Exhibit 1 can best be seen by comparing those images to the photographs of an actual 1975 Pontiac Grand Ville being submitted with the accompanying Declaration of Larry Willemsen.

24. The file on Exhibit 1 entitled "Pontiac_695_claim_2.mpeg" further includes demonstrative illustrations of the following: (a) how an electronic sensor mounted adjacent to the 1975 Pontiac Grand Ville accelerator pedal emits an electric signal in reaction to pivotal movement of the pedal about its pivot axis; (b) how the disclosed electronic sensor responds to the pedal's pivotal movement in any of its adjusted positions; and (c) how the words of Claim 2 of the '695 Patent, read literally, may correspond to structures disclosed in the 1975 Pontiac Grand Ville adjustable pedal assembly.

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25. In creating the file on Exhibit 1 entitled "Rixon_565_claim_4.mpeg," I studied the following documents: (a) U.S. Patent No. 5,722,302 to Rixon ("Rixon"); (b) a General Motors Corporation ("GM") drawing dated February 9, 1993, for Part No. 15974034 entitled "Pedal Assembly-Accelerator" and referring to "1994 C/K" (the "1994 GM Drawing"); and (c) U.S. Patent No. 6,237,565 B1 (the "'565 Patent").

26. The file on Exhibit 1 entitled "Rixon 565_claim_4.mpeg" includes true and accurate representations of (a) the position adjustable pedal assembly depicted in Figure 6 of Rixon (the "Rixon Pedal"); and (b) the pedal assembly depicted in the 1994 GM Drawing (the "1994 GM ETC Pedal"). The trueness and accuracy of the images of the Rixon Pedal and the 1994 GM ETC Pedal depicted in Exhibit 1 can best be seen by comparing those images to Rixon Figure 6 and the 1994 GM Drawing.

27. The file on Exhibit 1 entitled "Rixon_565_claim_4.mpeg," further includes demonstrative illustrations of the following: (c) how the modular position sensor attached to the support of the 1994 GM ETC Pedal could be similarly attached to the support of the Rixon Pedal; (d) how, if a position sensor were attached to the support of the Rixon Pedal, the sensor would provide a signal that corresponded to pedal's arm position as it pivoted about its axis between rest and applied positions; (e) how the position of the pivot supporting the Rixon Pedal remains constant while the Rixon Pedal arm moves in fore and aft directions with respect to the pivot; and (f) how the words of Claim 4 of the '565 Patent, read literally, may correspond to structures disclosed in Rixon and the 1994 GM ETC Pedal.

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28. In creating the file on Exhibit 1 entitled " Rixon_ Engelgau_565_claim_4_compare.mpeg," I studied the following documents: (a) U.S. Patent No. 5,722,302 to Rixon ("Rixon"); (b) a General Motors Corporation ("GM") drawing dated February 9, 1993, for Part No. 15974034 entitled "Pedal Assembly-Accelerator" and referring to "1994 CfK" (the "1994 GM Drawing"); and (c) U.S. Patent No. 6,237,565 B1 (the "'565 Patent").

29. The file on Exhibit 1 entitled "Rixon_Engelgau _565_ claim_4_compare.mpeg" includes true and accurate representations of (a) the position adjustable pedal assembly depicted in Figure 6 of Rixon (the "Rixon Pedal"); and (b) the position adjustable pedal assembly depicted in the '565 Patent (the "Engelgau Pedal"). The trueness and accuracy of the images of the Rixon Pedal and the Engelgau Pedal depicted in Exhibit 1 can best be seen by comparing those images to Rixon Figure 6 and the '565 Patent, respectively.

30. The file on Exhibit 1 entitled "Rixon_565_claim_ 4.mpeg," further includes demonstrative illustrations of the following: (c) how the modular position sensor attached to the support of the 1994 GM ETC Pedal could be similarly attached to the support of the Rixon Pedal, in substantially the same way as a position sensor is optionally attached to the Engelgau Pedal; (d) how, if a position sensor were attached to the support of the Rixon Pedal, the sensor would provide a signal that corresponded to pedal's arm position as it pivoted about its axis between rest and applied positions, in substantially the same way as it does in the embodiment of the Engelgau Pedal incorporating a position sensor, (e) how the position of the pivot supporting the Rixon Pedal

remains constant while the Rixon Pedal arm moves in fore and aft directions with respect to the pivot, in substantially the same way as it does on the Engelgau Pedal; and (f) how the words of Claim 4 of the '565 Patent, read literally, may correspond to structures disclosed in Rixon, the 1994 GM ETC Pedal, and the Engelgau Pedal.

31. In creating the file on Exhibit 1, entitled "Urset_239_claim_1.mpeg," I studied the following documents: (a) a translation of French Patent Application No. 2,739,947 to Urset ("Urset"); and (b) U.S. Patent No. 6,305,239 B1 (the '239 Patent").

32. The file on Exhibit 1 entitled "Urset_239_claim_1.mpeg" includes true and accurate representations of the adjustable pedal assembly depicted in Figs. 3 and 4 of Urset ("Urset Pedal"). The trueness and accuracy of the images of the Urset Pedal depicted in Exhibit 1 can best be seen by comparing those images to Figs. 3 & 4 of Urset.

33. The file on Exhibit 1 entitled "Urset_239_claim_1.mpeg" further includes demonstrative illustrations of the following: (a) how an electronic sensor mounted adjacent to the pedal of the Urset Pedal emits an electric signal that varies with the position of the pedal about its pivot axis; (b) how the signal output of the disclosed electronic sensor varies independently of the pedal's movement between different operable positions; and (c) how the words of Claim 1 of the '239 Patent, read literally, may correspond to structures disclosed in the Urset Pedal.

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34. In creating the file on Exhibit 1, entitled "Urset_695_claim_1.mpeg," I studied the following documents: (a) French Patent Application No. 2,739,947 to Urset ("Urset"); and (b) U.S. Patent No. 6,374,695 B1 (the "'695 Patent").

35. The file on Exhibit 1 entitled "Urset_695_claim_1.mpeg" includes true and accurate representations of the adjustable pedal assembly depicted in Figs. 3 and 4 of Urset (the "Urset Pedal"). The trueness and accuracy of the images of the Urset Pedal depicted in Exhibit 1 can best be seen by comparing those images to Figs. 3 and 4 of Urset.

36. The file on Exhibit 1 entitled "Urset_695_claim_1.mpeg" further includes demonstrative illustrations of the following: (a) how an electronic sensor mounted adjacent to the Urset accelerator pedal emits an electric signal in response to pivotal movement of the pedal about its pivot axis; (b) how the disclosed electronic sensor responds to the pedal's pivotal movement in any of its adjusted positions; and (c) how the words of Claim 1 of the '695 Patent, read literally, may correspond to structures disclosed in Urset.

37. In creating the file on Exhibit 1, entitled "Urset_695_claim_2.mpeg," I studied the following documents: (a) French Patent Application No. 2,739,947 to Urset ("Urset"); and (b) U.S. Patent No. 6,374,695 B1 (the "'695 Patent").

38. The file on Exhibit 1 entitled "Urset_695_claim_2.mpeg" includes true and accurate representations of the adjustable pedal assembly depicted in Figs. 3 and 4 of Urset (the "Urset Pedal"). The trueness and accuracy of the images

of the Urset Pedal depicted in Exhibit 1 can best be seen by comparing those images to Figs. 3 and 4 of Urset.

39. The file on Exhibit 1 entitled "Urset_695_claim_1.mpeg" further includes demonstrative illustrations of the following: (a) how an electronic sensor mounted adjacent to the Urset accelerator pedal emits an electric signal in reaction to pivotal movement of the pedal about its pivot axis; (b) how the disclosed electronic sensor responds to the pedal's pivotal movement in any of its adjusted positions; and (c) how the words of Claim 2 of the '695 Patent, read literally, may correspond to structures disclosed in Urset.

I, DANIEL H. KRUGER, hereby declare under penalty of perjury that the foregoing is true and correct.

Dated: July 5, 2003

s/ Daniel H. Kruger
Daniel H. Kruger

Appendix G

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APPENDIX H — DECLARATION OF JAMES W. DABNEY DATED JULY 6, 2003 AND FILED JULY 7, 2003

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

Case No: 02-74586

TELEFLEX INCORPORATED,

Plaintiff,

vs.

KSR INTERNATIONAL CO.,

Defendant.

DECLARATION OF JAMES W. DABNEY

1. My name is James W. Dabney. I am a member of the Bar of the States of New York and New Jersey and of the firm of Pennie & Edmonds LLP, co-counsel for plaintiff KSR International Company ("KSR") in this action. I make this declaration in support of KSR's Motion for Summary Judgment of Invalidity.

2. Annexed hereto as Exhibit 1 is a certified copy of an Assignment of Patents dated September 27, 2002, and recorded in the United States Patent and Trademark Office on October 21, 2002.

3. Annexed hereto as Exhibit 2, less exhibits, is a copy of the Complaint filed March 12, 2003, in *KSR Int'l Co.* v. *Technology Holding Co.*, No. 03-277, currently pending in the United States District Court for the District of Delaware (the "Delaware Action").

4. Annexed hereto as Exhibit 3, less exhibits, is a true copy of the Answer and Affirmative and Other Defenses that non-party Technology Holding Company ("THC") served in the Delaware Action on April 2, 2003.

5. Annexed hereto as Exhibit 4, less exhibits, is the Opening Brief in Support of Plaintiff's Motion for Summary Judgment of Invalidity of the Patents-in-Suit that KSR filed April 16, 2003, in the Delaware Action. On April 28, 2003, proceedings in the Delaware Action were stayed pending the determination of KSR's motion filed April 2, 2003, to dismiss the within action for lack of subject matter jurisdiction in view of Teleflex's admitted non-ownership of any of the patents being asserted in this action.

6. Annexed hereto as Exhibit 5 are copies of Plaintiff's Response to Defendant's First Set of Interrogatories as served in this action dated April 29, 2003.

7. Annexed hereto as Exhibit 6 is a copy of published French Patent Application No. 2,739,947 to Urset ("Urset").

8. Annexed hereto as Exhibit 7 is a certified English translation of the Urset reference.

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9. Annexed hereto as Exhibit 8 are excerpts from the file wrapper and contents of United States Application Serial No. 08/720,682 filed October 2, 1996, and assigned to Comfort Pedals Inc. This application matured into U.S. Patent No. 5,722,302.

10. Annexed hereto as Exhibit 9 are excerpts from the Annual Report on Form 10-K filed by Teleflex Incorporated with the Securities and Exchange Commission ("SEC") for the fiscal year ending December 28, 1997.

11. Annexed hereto as Exhibit 10 is a copy of Swedish Patent Application No. 9704288-1 filed November 21, 1997, and assigned to Claes Johansson Automotive AB of Dalstorp, Sweden (the "Swedish Priority Application").

12. Annexed hereto as Exhibit 11 is a certified English-language translation of the Swedish Priority Application.

13. Annexed hereto as Exhibit 12 are excerpts from the file wrapper and contents of United States Application Serial No. 09/174,748 filed October 19, 1998. This application matured into U.S. Patent No. 6,151,984.

14. Annexed hereto as Exhibit 13 are excerpts from the file wrapper and contents of United States Application Serial No. 09/655,159 filed September 5, 2000. This application matured in to U.S. Patent No. 6,305,239 B1.

15. Annexed hereto as Exhibit 14 are excerpts from the file wrapper and contents of United States Application

Serial No. 09/654,642 filed September 5, 2000. The application matured into U.S. Patent No. 6,374,695 B1.

16. Annexed hereto as Exhibit 15 are excerpts from the file wrapper and contents of United States Application Serial No. 09/236,975 filed January 26, 1999. This application matured into U.S. Patent No. 6,109,241.

17. Annexed hereto as Exhibit 16 are excerpts from the file wrapper and public contents of United States Application No. 09/643,422 filed August 22, 2000. This application matured into U.S. Patent No. 6,237,565 B1.

I, JAMES W. DABNEY, hereby declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Dated: July 6, 2003

_____

James W. Dabney

Appendix H

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APPENDIX I — TELEFLEX' S RESPONSE TO KSR'S MOTION FOR SUMMARY JUDGMENT OF INVALIDITY DATED AUGUST, 2003

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

Case No. 02 74586

TELEFLEX INCORPORATED,

Plaintiff,

v.

KSR INTERNATIONAL CO.,

Defendant.

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Appendix I

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TELEFLEX' S RESPONSE TO KSR' S MOTION FOR SUMMARY JUDGMENT OF INVALIDITY

SUBMITTED BY:

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I. INTRODUCTION

To succeed in its attempt to invalidate the Engelgau Patent, KSR must prove to the Court by clear and convincing evidence that, as a matter of law, it is invalid — despite the fact that the experts, the United States Patent and Trademark Office, have already affirmed its validity. To do so, KSR has attempted to demonstrate that the Engelgau Patent describes nothing more than an adjustable pedal with an attached electronic control and that it would have been obvious to combine these two features. But KSR's attempt fails because,

among other reasons, it has mischaracterized the Engelgau Patent as simply a combination of two known features. Actually, the Engelgau Patent represented a unique way to combine an adjustable pedal with an electronic control — until that point, many inventors had tried to combine these two elements but none had been able to do so in the way that Engelgau did. As a result, the United States Patent and Trademark Office bestowed on him a patent.

KSR's approach here highlights the true issue between the parties: Whether as a factual question, the Engelgau Patent would have been obvious at the time to one of ordinary skill in the art. This is a question that a jury should decide after the trial (currently scheduled to begin in December 2003). Teleflex respectfully suggests that in light of its dispositive motion on KSR's infringement of the Engelgau Patent, the only viable issues that remain in this case are whether the Engelgau Patent is valid and the amount of damages. Teleflex requests that the Court deny KSR's invalidity motion, grant Teleflex's infringement motion, and allow the jury to decide the issues of validity and, if appropriate, damages.

II. STATEMENT OF FACTS

Teleflex is a leading manufacturer and supplier of adjustable pedal systems that are used by the automotive industry in automobile platforms. Adjustable pedals allow drivers to move the pedals closer to their feet, enabling them to attain maximum comfort while still sitting as far back from the steering wheel as possible to prevent air bag related injuries.

Appendix I

Some of the Teleflex adjustable pedal systems include an electronic control. An electronic control is a device that senses the depression and release of the pedal and produces an electronic signal corresponding to this movement. Adjustable pedal systems with electronic controls send the electronic signals to the engine to register the pressure applied by the driver on the accelerator, clutch, and/or brake. These adjustable pedal systems are designed to offer enhanced vehicle performance and better control than the traditional pedal system utilizing a cable or rod mechanism. The manufacture and supply of adjustable pedal systems with electronic controls is an expanding and profitable product market.

KSR is also an automotive industry supplier and a Teleflex competitor. KSR also manufactures and sells adjustable pedals that incorporate electronic controls. On its website, KSR claims that it is "an industry leader in the design, engineering and manufacturing of adjustable and fixed brake pedal modules [and] electronic throttle controls . . ." [*See, http://www.ksrint.com/about%20ksr.htm*] KSR's sales numbers support this claim; KSR's "[a]nnual brake pedal production for adjustable and fixed units exceeds 310 million components assembled into over 14 million modules." [*See, http://www.ksrint.com/english.htm*] A significant portion of these modules are the type of product at issue in this case — an adjustable pedal with an incorporated electronic control. Indeed, KSR's website touts its electronic throttle control as a "companion to the patented KSR adjustable pedal technology." [*See, http://www.ksrint.com/electronic%20throttle%20controls.htm*]

Appendix 1

In its Second Amended Complaint, Teleflex alleged that certain KSR adjustable pedals with an incorporated electronic control infringe three Teleflex patents: United States Patent No. 6,237,565, invented by Steven Engelgau ("the Engelgau Patent"); United States Patent No. 6,374,695 ("the '695 Patent") and United States Patent No. 6,305,239 ("the '239 Patent") (together the '695 Patent and the '235 Patent will be referenced as "the Johansson Patents").

The Engelgau Patent claims an adjustable pedal that allows a driver to move the pedal closer to or farther from the driver to achieve maximum driving comfort. It also describes and claims an electronic control that replaces the traditional cable linkage between the pedal and the corresponding part of the vehicle. In the Engelgau Patent, the electronic control module is attached to the mounting bracket of the adjustable pedal and, consequently, it remains fixed both when the pedal arm moves during adjustment and when the pedal arm moves operationally. [*See,* **Ex. A**, ¶5.]

The Johansson Patents also describe and claim an adjustable pedal that incorporates an electronic control. The Johansson Patents, however, describe and claim a different design than that described in the Engelgau Patent. Specifically, in the Johansson Patents, the electronic control moves with the pedal during adjustment — that is, the pedal arm itself moves about one pivot point, and the pedal assembly as a whole moves about a second pivot point.

Appendix I

III. PROCEDURAL HISTORY

On November 18, 2002, Teleflex filed this action against KSR for infringement of the Engelgau Patent and the Johansson Patents. On March 13, 2003, KSR filed a declaratory judgment action in Delaware against Technology Holding, a wholly owned subsidiary of Teleflex, claiming that KSR does not infringe the Engelgau and Johansson Patents and, if it does, that those patents are invalid. The Delaware action is the mirror image of the Michigan action. In it, KSR maintained that Technology Holding, not Teleflex, was the proper party to allege infringement against KSR. On April 2, 2003, KSR filed a Motion to Dismiss for Lack of Subject Matter Jurisdiction in this Court. This Court recently denied KSR's Motion to Dismiss as it relates to the Engelgau Patent. The Delaware action has been stayed pending this Court's jurisdictional ruling.[1]

On July 7, 2003, Teleflex filed two Motions for Summary Judgment of Infringement, one relating to the Engelgau Patent and the other relating to the Johansson Patents. On the same day, KSR filed its Motion for Summary Judgment of Invalidity, requesting that the Court declare the Engelgau and Johansson Patents invalid.

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1. The simple solution to KSR's concerns regarding jurisdiction would be to have Teleflex amend its Complaint to join Technology Holding as a Plaintiff. In doing so, neither the substance nor timing of this case would change, given that Technology Holding is merely a holding company and does not manufacture, make, or use any parts or patents. For a more detailed discussion of the jurisdictional issue, Teleflex refers the Court to its Response to KSR's Motion to Dismiss for Lack of Subject Matter Jurisdiction.

Appendix I

The parties recently stipulated to the dismissal with prejudice of the Johansson Patents, which Teleflex has decided to dedicate to the public under 35 U.S.C. § 253. Because of the dismissal of the Johansson Patents, the single remaining claim in this case relates to KSR's infringement of the Engelgau Patent. Based on this recent development, Teleflex's Motion for Summary Judgment of Infringement of Johansson Patents and KSR' s arguments relating to the validity of the Johansson Patents are moot. Therefore, in this Response Brief, Teleflex intends to address only KSR's validity arguments regarding the Engelgau Patent. Teleflex will explain in this Response why the adjustable pedal patents and products that KSR cites as prior art do not render the Engelgau Patent obvious. Indeed, this prior art demonstrates why the United States Patent and Trademark Office was correct in deciding to award a patent for the Engelgau invention.

IV. APPLICABLE LAW

A. Burden of Proof

Importantly, on the issue of validity, KSR bears the burden of proof. 35 U.S.C. § 282. This burden of proof is not the standard "preponderance of the evidence" burden; rather, KSR must prove invalidity by clear and convincing evidence. *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1574 (Fed. Cir. 1995).[2] KSR must meet this burden because once

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2. The Court of Appeals for the Federal Circuit maintains exclusive appellate jurisdiction over civil suits that arise under the federal patent laws. *See*, J. Thomas McCarthy, *McCarthy's Desk Encycloedia of Intellectual Property*, Second Edition, p. 104.

a patent has been granted, it is presumed to be valid, primarily because the United States Patent and Trademark Office subjects a patent application to rigorous scrutiny; the presumption of validity requires that the decision-maker employ an approach "that starts with the acceptance of the patent claimed as valid and that looks to the challenger for proof to the contrary." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1534 (1983).[3]

Moreover, a party that asserts invalidity "not only has the procedural burden of proceeding first in establishing *a prima facie* case, but the burden of persuasion on the merits remains with that party until a final decision." *Stratoflex*, 713 F.2d at 1534 (emphasis added). According to the United States Supreme Court, in order to demonstrate a proposition by clear and convincing evidence, the party carrying the burden must "place in the mind of the ultimate fact finder an **abiding conviction** that the truth of its factual contentions are 'highly probable.'" *Colorado v. New Mexico*, 467 U.S. 310, 316, *reh'g denied*, 468 U.S. 1224 (1994), *quoting C.* McCormick, Law of Evidence 320, p. 679 (1954) (emphasis

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3. See, *SIBIA Neurosciences, Inc. v. Cadus Pharmaceutical Corp.*, 225 F.3d 1349, 1355 (Fed. Cir. 2000); *Robotic Vision Systems, Inc. v. View Engineering, Inc.*, 189 F.3d 1370, 1377 (Fed. Cir. 1999) ("There is a strong presumption of validity for issued patents . . . therefore an accused infringer who raises patent invalidity as a defense bears the burden of showing invalidity by facts supported by clear and convincing evidence."); *Avia Group, Int'l, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1567 (Fed. Cir. 1998) (granting motion for summary judgment of non-obviousness).

added). Thus, for purposes of its motion for summary depicted in the Engelgau Patent would have been obvious to one of ordinary skill in the art — despite the fact that the United States Patent and Trademark Office found the patent to be valid.

B. Obviousness

1. Test for Obviousness

In order to prove that a patent claim is invalid as obvious, a party must demonstrate that the differences between the claimed invention as a whole and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103.[4] An obviousness inquiry is highly fact specific, and requires an examination of the following: (1) the scope and content of the prior art; (2) the differences between the patented invention and what already existed in the prior art; (3) the ordinary level of skill of people working in the field; and (4) other objective evidence which may suggest that the invention would not have been obvious. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18; 86 S. Ct. 684; 15 L. Ed.2d 545 (1966); *Ashland Oil, Co. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 291 (Fed. Cir. 1985). The facts here argue against KSR's invalidity motion.

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4. Prior art encompasses the existing body of technological information against which an invention is judged to determine if it is patentable as being a novel and nonobvious invention. See, J. Thomas McCarthy, *McCarthy's Desk Encyclopedia of Intellectual Property*, Second Edition, p. 341.

Appendix I

2. Combination of Elements within the Prior Art

An accused infringer who challenges a patent on obviousness grounds is essentially admitting that no one piece of prior art describes the invention; instead, the infringer is saying that if one were to choose certain aspects of prior art and then mix and match them, one would arrive at the patent-in-suit (here, the Engelgau Patent). Courts have traditionally been skeptical of this approach because, at some level, virtually all inventions are combinations of old elements.[5] Indeed, in hindsight, many inventions seem obvious. Therefore, courts have held that there must be some **suggestion** to combine specific prior art in such a way as to arrive at the particular combination disclosed in the patent at issue. *See, e.g., Yamanouchi Pharmaceutical Co.*, 231 F.3d at 1343 ("To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness."); *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods.*, 21 F.3d 1068, 1072 (Fed. Cir.

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5. See, *Yamanouchi Pharmaceutical Co., Ltd. v. Danbury Pharmacal, Inc.*, 231 F.3d 1339, 1343 (Fed. Cir. 2000) *quoting In Re Rouffet*, 149 F.3d 1350, 1357-58 (Fed. Cir. 1998) ("If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner [or accused infringer] to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.").

1994). In other words, there must be "something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination."[6]

This requirement of a suggestion to combine prior art to demonstrate obviousness prevents hindsight reconstruction by accused infringers, like KSR, who try to use the patent-in-suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. *Grain Processing Corp. v. American Maize Products Corp.*, 840 F.2d 902, 907 (Fed. Cir. 1988). *See also, Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000) ("[T]he best defense against hindsight-based obvious analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. . . . Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability — the essence of hindsight."). It is well-established that the showing of the motivation to combine references must be "clear and particular."

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6. See, *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985); *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 959 (Fed. Cir. 1986) (a patent will not be deemed invalid merely because it is made up of a 'combination of old elements.'); *SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 887 (Fed. Cir. 1988) ("A finding that claims which combine several prior art references are invalid based merely upon the fact that those similar elements exist is 'contrary to statute and would defeat the congressional purpose in enacting Title 35.'").

Appendix I

In *Heidelberger, supra,* the assignee of a patented device called a "chopper," which folded sheets of printed matter as they emerged from a printing press, sued a printing press manufacturer for infringement. The defendant alleged that the patent was invalid for obviousness. Although each of the elements of the patent could be found somewhere within the prior art, the Federal Circuit rejected the obviousness challenge and emphasized that "the several prior art choppers were encumbered by limitations and disadvantages that had not previously been overcome." *Heidelberger,* 21 F.3d at 1072. Moreover, several companies, including the defendant, had tried and failed to meet the particularized need for a precise and high-speed chopper. By combining a "double offset circle drive mechanism" with a "printing press chopper," the patentee was able to overcome many of the limitations that had hindered progress in this area. Explicitly noting that "[t]he motivation to combine references can not come from the invention itself," the court held that "[t]here is nothing in the prior art to lead a person of ordinary skill to the combination of the structures in these references to design a high-speed chopper for use in rotary printing presses, other than the hindsight knowledge of [the inventor's] construction." *Id. See also, Ecolochem, supra,* 227 F.3d at 1371 ("'Hindsight reconstruction' cannot be used 'to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'"); *ATD Corp v. Lydall Inc.,* 159 F.3d 534, 546 (Fed. Cir. 1998); *Winner International Royalty Corp. v. Wang,* 202 F.3d 1340, 1348 (Fed. Cir. 2000).

If it were sufficient for a party to simply demonstrate that all of the elements of a claim are found in multiple patents, virtually all patents would be invalidated on

obviousness grounds. *Lindemann Maschinefabrik Gmbh v. American Hoist and Derrick Company,* 730 F.2d 1452 (Fed. Cir. 1984), is instructive in this regard. In *Lindemann,* the patent at issue related to a machine used for crushing massive metal scrap. The invention combined one feature previously used in a garbage compactor with a second feature found in a large shearing device. The Federal Circuit held that the district court's broad definition of the problem as "the problem of compressing waste materials" was clearly erroneous and reversed the holding of obviousness. *Id.* at 1460. "That the claimed invention may employ known principles does not in itself establish that the invention would have been obvious. Most inventions do." *Id.* at 1462.

Significantly, courts routinely hold that it is a *question of fact* whether a party has established the requisite motivation to combine. See, *e.g., Winner International Royalty Corp., supra,* 202 F.3d at 1348; *Emerson Electric Co. v. Spartan Tool, LLC,* 223 F. Supp.2d 856 (N.D. Ohio 2002).

3. Problem Addressed by the Invention

In determining whether a particular combination of prior art would be obvious, a court is to consider the nature of the problem that the inventor was trying to solve. The problem confronting the inventor is significant because whether one of ordinary skill in the art would find a particular combination to be obvious depends on whether this hypothetical person was confronted with the same problem as the inventor. *See, In Re Rouffet,* 149 F.3d at 1357 (to make a finding of obviousness, there must be evidence that

"a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed").[7] In other words, an obviousness challenge must fail if it does not frame the challenge in terms of the problem confronted by the inventor.

V. ARGUMENT

A. Summary of Argument

KSR claims that the Engelgau Patent is obvious. However, before the Engelgau Patent, no inventor had combined, in the way that Engelgau did, an adjustable pedal and an electronic control **so that the electronic control was attached to the pedal mounting bracket.** The Engelgau Patent represented a departure from the evolution of the relevant prior art in the fields of pedal assemblies and electronic controls. Initially, there were fixed pedals with cable-actuated throttle control mechanisms. Subsequently, inventors replaced cables with electronic controls on these

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7. *See also, WMS Gaming, Inc. v. International Game Technology,* 184 F.3d 1339, 1359 (Fed. Cir. 1999) (court found that patent was not obvious where prior art in gaming technology did not teach decreasing odds of winning, which was a critical element of the patent at issue, and the stated objectives of the prior art patents was to "overcome the deficiencies of mechanical reels, such as noise and being susceptible to wear and tampering"); *Aero Industries, Inc. v. John Donovan Enterprises-Florida, Inc.*, 80 F. Supp. 2d 963, 975 (S.D. Ind. 1999) (court held that the alleged infringer failed to demonstrate that the prior art was "reasonably pertinent" to the problem that the inventor attempted to solve).

fixed pedal assemblies. These electronic controls were attached to the pedal itself. The next significant inventions were adjustable pedals with electronic controls. In the early adjustable pedal with electronic control designs, the electronic control was attached directly to the pedal, in the same manner that those electronic controls had been attached to fixed pedal assemblies. The novelty of the Engelgau Patent stems from the decision to separate the pedal from the electronic control. Engelgau viewed this change as a way to overcome the major disadvantage of prior adjustable pedal/ electronic control designs: They were complicated and expensive to assemble and took up a significant amount of packaging space. [*See*, **Ex. A**, ¶7.]

KSR's invalidity challenge fails because it is built on an erroneous assumption. KSR assumed that the problem that the inventor, Steven Engelgau, wanted to solve was the following: How to attach an electronic control to an adjustable pedal. Having made this assumption, KSR found prior art that solved this problem — the combination of the Asano adjustable pedal patent (United States Patent No. 5,010,782) and the CTS 503 Series electronic control. It then concluded that a typical pedal engineer who needed to attach an electronic control to an adjustable pedal assembly would have known to combine an assembly like Asano with an electronic control like the CTS sensor.

But this house of cards falls because the problem that Engelgau was trying to solve was not simply the combination of an adjustable pedal with an attached electronic control. Rather, Engelgau tried to invent an adjustable pedal assembly with an electronic control that was less complex, less expensive,

and easier to package than its predecessors. [*See,* **Ex. A,** ¶7.] In particular, Engelgau needed to develop an adjustable pedal with electronic control that would allow the movement of the pedal back and forth within a narrow pedal compartment; he solved his space constraints by (among other means) placing the electronic control on the pedal mounting bracket as opposed to the variety of other locations at which he could have placed the electronic control. [*See,* **Ex. A,** ¶8.]

The Engelgau patent examiner had before him several examples of adjustable pedals and electronic controls — including prior art that is actually closer to the Engelgau Patent than that cited by KSR here — but none of these examples suggested a combination like the one that Engelgau invented.[8] Because no other person had invented an adjustable pedal assembly with electronic control that placed the electronic control on the pedal mounting bracket like Engelgau did, the United States Patent and Trademark Office issued a patent to Engelgau.

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8. The most pertinent prior art references for purposes of this Motion are United States Patent Nos. 5,632,183; 4,915,075; 4,958,607; 5,233,882; and 5,887,488. [*See*, **Exs. B, C, D, E, F.**] The relevancy of these patents will be discussed in greater detail below. Attached as **Exhibit G** is the form that the patent examiner used to indicate the prior art that he considered.

B. No Teaching or Suggestion in Prior Art to Combine the Elements in the Manner Specified in Claim 4 of the Engelgau Patent

Obviousness determinations are made by placing oneself in the shoes of a person of ordinary skill in the art.[9] Teleflex's experts are Professor Clark Radcliffe and Timothy Andresen. Dr. Radcliffe is a professor of mechanical engineering at Michigan State University; Mr. Andresen is an automotive pedal engineer with 26 years of experience at Ford Motor Company. Both have concluded that the Engelgau Patent involved a combination of elements that would not have been obvious to one of ordinary skill in the art. [*See*, **Ex. H**, ¶14; **Ex. I**, ¶¶17,9.] Conversely, neither Larry Willemsen nor Daniel Kruger (whose Declarations KSR attached to KSR's Motion for Summary Judgment) have offered any opinion regarding whether the combination found in the Engelgau design would have been obvious to one of ordinary skill in the art. See, *Wesley Jessen Corp. v. Coopervision, Inc.*, 207 F. Supp.2d 1103, 1109 (C.D. Cal. 2002) (court denied summary judgment on invalidity where the defendant's expert

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9. Teleflex defines a person of ordinary skill in the art as one with an undergraduate degree in mechanical engineering (or an equivalent amount of industry experience) who has familiarity with pedal control systems for vehicles. KSR's definition sets a lower threshold of a person with "a minimum of two (2) years of college level training in mechanical engineering and two-three years' work experience spanning at least one complete pedal design 'cycle'." [*See*, Brief in Support of KSR's Motion for Summary Judgment on Invalidity ("Invalidity Brief"), p. 18.] Regardless of which definition this Court chooses to adopt, the obviousness analysis would remain substantially unaffected.

"does not state in either his declaration or deposition that the language of the [prior art] patent suggested to a person of ordinary skill in the art that the Knapp patent should be combined with the LeGrand Fuhrman lenses").[10]

KSR has done little to meet its substantial burden of demonstrating that Professor Radcliffe and Mr. Andresen are wrong. In fact, KSR has done nothing more than claim that both adjustable pedals and electronic controls existed within the prior art. This is far from sufficient to carry the burden of proving that this combination **in the manner claimed in Claim 4 of the Engelgau Patent** would have been obvious to one of ordinary skill in the art. As explained in Subsection IV.B of this Brief, before this Court can declare the Engelgau Patent invalid, KSR must demonstrate, among other things, that there was some teaching or suggestion in the prior art to combine the elements in the manner specified in the claim. *See, e.g., Ecolochem, Inc., supra,* 227 F.3d at 1371. KSR seeks to satisfy the motivation requirement by arguing that the prior art includes "specific teachings with respect to the desirability of electronic, as distinguished from mechanical, throttle controls in automotive vehicles" and, in particular, includes teaching of the desirability of employing "linkages between vehicle accelerator pedals and engine throttles" and of locating an electronic pedal position sensor "inside the vehicle's passenger compartment, rather than in a vehicle's engine compartment." [*See,* Invalidity Brief, p. 23-24.]

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10. Even if KSR belatedly offered opinions from Mr. Willemsen and Dr. Kruger, these opinions would be suspect because Mr. Willemsen is a KSR employee and Dr. Kruger's background is in aerospace, not automotive, engineering.

Appendix 1

KSR claims that Teleflex's motivations for combining Asano with an of-the-shelf electronic pedal position sensor are at least as convincing as the motivations that the Federal Circuit found sufficient to prove obviousness in the following cases: *Ryko Manufacturing Co., v. Nu-Star Co.*, 950 F.2d 714, 717 (Fed. Cir. 1991); *Novo Nordisk A/S v. Becton Dickinson & Co.*, 304 F.2d 1216 (Fed. Cir. 2002); *Richardson-Vicks, Inc. v. Upjohn Co.*, 122 F.3d 1476 (Fed. Cir. 1997). KSR's argument would only have merit if the problem confronted by Engelgau were as simple as KSR seeks to characterize it — that is, merely combining an adjustable pedal assembly with an electronic control.

Such simplistic combinations are the defining characteristic of the cases cited by KSR. For instance, in *Ryko Manufacturing Co.*, the Federal Circuit characterized the "difference between the prior art and the claim at issue [as] essentially the substitution of a keypad code device for a coin box or other common input device." There, the problem that the inventor tried to solve was putting a keypad code in an automatic car wash. Because the keypad entry system that the patentee combined with an automatic car wash was prevalent in the prior art, and there was nothing unique about the structure of the combination, the court deemed the patent invalid as obvious.

Similarly, in *Richardson-Vicks, Inc. v. Upjohn Co.*, 122 F.3d 1476 (Fed. Cir. 1997), the court held that the combination of two well-known medications into one tablet for the relief of cough, cold and flu symptoms was invalid as obvious. There, the problem that the inventor tried to solve was putting two common medications together. The

overriding factor in the court's analysis was that doctors had long prescribed both medications together, although not combined into one mixture, for that very purpose.

Finally, in *Novo Nordisk A/S v. Becton Dickinson & Co.,,* 304 F.2d 1216 (Fed. Cir. 2002), the relevant claim involved an injection pen with 30 gauge needles. The prior art included pen-style insulin injection systems that either did not state the needle size or showed needles of 27 and 28 gauge. In addition, the prior art included 30 gauge needles for insulin injections. The court determined that there was nothing unique about the manner in which the inventor combined the two elements from the prior art.[11]

Again, these cases are inapposite because they address situations in which the problems that the inventors tried to solve simply required the perfunctory combination of common elements. Here, the actual problem that Engelgau confronted — as distinguished from the fictional problem that KSR fabricates in its brief — could not be solved by the routine combination of common elements.

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11. Moreover, the Federal Circuit in *Novo Nordisk* merely upheld a jury's verdict that the invention was obvious. Affirming a jury verdict involves a far more lenient standard than this Court faces in ruling on a motion for summary judgment. The *Novo Nordisk* court merely had to determine that a reasonable jury could have found that the invention was obvious. Conversely, KSR asks this Court to find, as a matter of law, that no reasonable jury could find that the invention was not obvious.

C. KSR Mischaracterized Problem Solved by the Engelgau Patent

KSR's entire invalidity argument is based on an erroneous assumption. KSR has claimed that the problem faced by Engelgau could have been solved by combining the design of the Asano patent with any off-the-shelf electronic throttle control like the CTS 503 Sensor. However, combining Asano with an electronic control would not have solved any of the problems confronting Engelgau in his design of the Engelgau Patent.

KSR acknowledges that "[t]he relevant art is defined by the nature of the problem confronting the would-be inventor." [*See,* Invalidity Brief, p. 21.] However, KSR has mischaracterized the problem facing Mr. Engelgau at the time that he developed the Engelgau Patent in order to ease its burden of proving obviousness. KSR has claimed that "the 'problem' ostensibly confronting the '565 inventor was to provide an adjustable pedal assembly that could be installed in a vehicle whose engine utilized an electronic, rather than a cable-actuated, throttle control system." [*See,* Invalidity Brief, p. 2[illegible]] But this was not the essence of the problem Engelgau confronted. Indeed, the Engelgau Patent concedes that adjustable pedals for use with engines utilizing electronic throttle control systems were known in the prior art. In fact, in the section of the Engelgau Patent entitled "Background of the Invention," the patent states that "[o]ne such adjustment apparatus used with an electronic throttle control is shown in U.S. Pat. No. 5,819,593 assigned to the assignee of the present invention." [*See.* **Ex. J**, Col. 1, lines 43-47.] Clearly, therefore, KSR's characterization of the problem addressed by Engelgau cannot be correct.

Rather, as expressly stated in the Engelgau Patent, the problem that Engelgau confronted was developing a pedal assembly that not only "includes both an adjustment apparatus and an electronic control" but that is not expensive, time consuming to assemble, and that does not require a significant amount of packaging space. [*See,* **Ex. J**, col. 1, lines 48-53.] KSR disingenuously ignores multiple, credible references to the actual problem confronted by Engelgau. In its First Set of Interrogatories, KSR requested that Teleflex "identify each and any problem that Teleflex contends (a) was [solved by] any claimed invention of any Patent-in-Suit; and (b) was not solved by any pedal assembly disclosed in the prior art of any of the Patents-in-Suit." Teleflex responded as follows:

> To the extent that this interrogatory asks which problem or problems Teleflex contends were intended to be solved by the Teleflex Automotive Patents, Teleflex responds as follows: as for the '565 Patent, **Teleflex attempted to provide a design for an adjustable pedal system with electronic control that would address issues of packaging, assembly, and cost . . .**

(emphasis added). Teleflex's response mirrored the text of the Engelgau Patent which sets forth the background of the invention and provides a detailed explanation of the problem that Engelgau set out to solve.

> When a vehicle control pedal assembly includes both an adjustment apparatus and an electronic throttle control, the pedal assembly can be

> complex with a great number of parts. These control pedal assemblies can be expensive, time consuming to assemble, and require a significant amount of packaging space.

[*See,* **Ex. J**, col. 1, lines 48-53.] The "Summary of the Invention and Advantages" section of the Engelgau Patent further explains that "the subject invention provides a simplified vehicle control pedal assembly that is less expensive, and which uses fewer parts and is easier to package within the vehicle." [*See*, **Ex. J**, col. 2, lines 2-5.]

There were various possible ways that Engelgau could have sought to resolve this problem and there was nothing in the nature of the problem that inexorably led him to the design of the Engelgau Patent. For example, Engelgau could have placed the electronic control in any number of locations within the vehicle, such as inside the engine compartment, on a vehicle firewall spaced from the mounting bracket, on a vehicle dashboard, or on a different type of adjustment element. [*See*, **Ex. A**, ¶8.]

D. KSR's Misuse of Prior Art

Because KSR cannot demonstrate motivation to combine by looking at the prior art **at the time of the Engelgau Patent,** it engaged in an improper hindsight analysis. That is, KSR started with the elements of the Engelgau Patent and then attempted to locate each of those elements in the prior art. Courts have been careful to prevent hindsight reconstruction by accused infringers like KSR who try to use the patent-in-suit as a guide through the maze of prior

art references, combining the right references in the right way so as to achieve the result of the claims in suit. *See, Grain Processing Corp, supra,* 840 F.2d at 907. If this were the proper way to test for obviousness, virtually every patented invention would be deemed invalid. Rather, the appropriate way to view obviousness is to ask whether, without knowing of the Engelgau Patent, the prior art references make obvious Engelgau's solution to the problem of developing an inexpensive, more easily assembled, and more conveniently packaged adjustable pedal assembly with electronic control. This question must be answered in the negative.

1. Asano Pedal Involved a Complex Design that Could Not Have Motivated Solution to Problem Solved by Engelgau

The Engelgau Patent provided a feature previously unavailable, specifically, an "electronic throttle control attached to the support for controlling an engine throttle." This electronic control responded to the pivotal motion of the adjustable pedal at the support, thereby providing a simpler mounting position that was both less expensive and easier to package than devices in the prior art. [*See,* **Ex. A**, ¶7; **Ex. H**, ¶15.] Contrary to KSR's suggestions, it would not have made sense for Engelgau to combine the design of the Asano patent with the CTS 503 Series pedal position sensor in order to create an adjustable pedal with ETC that would be inexpensive, easily assembled, and would utilize less vehicle space. First, the Asano patent nowhere discloses an adjustable pedal assembly that includes an electronic control. Nor does KSR point to any teaching or suggestion

in the Asano patent to incorporate an electronic control into the pedal assembly, let alone any suggestion that it be incorporated in the manner specified in Claim 4 of the Engelgau Patent. Second, the Asano patent is directed to an entirely different problem than that confronted by Engelgau. Asano addressed the problem of developing an adjustable pedal in which the force applied to the pedal "is held substantially constant under the same pivotal displacement distance of the pedal pad caused by a driver's depression action of the pedal, irrespective of the adjusted pedal pad position." [*See,* **Ex. K**, col. 1, lines 57-60][12] In other words, Asano wanted to invent an adjustable pedal that would require the same pressure to move the pedal regardless of where the pedal was located on the adjustment spectrum.

In order to solve this problem, Asano developed a complex mechanical assembly that was expensive, time consuming to assemble, and required a significant amount

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12. The "Summary of the Invention" section of the Asano patent sets forth the goals that the inventor sought to accomplish and the problem(s) that the design was intended to solve:

> Therefore, it is an object of the present invention to provide a pedal assembly for a vehicle which enables a position of a pedal pad . . . to be adjusted forwardly and rearwardly of the vehicle, i.e. in a longitudinal direction of the vehicle, wherein a force applied to an operating member which transmits the applied force to a vehicle operation system such as a braking system, an

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of packaging space. [*See,* **Ex. A,** ¶10; Ex. **H,** ¶16.] Thus, someone in Engelgau's shoes, who was trying to create an adjustable pedal assembly with an attached electronic control that was easy to package in a narrow space and was also relatively simple and inexpensive, would shun Asano.

2. Patent Examiner Review of Prior Art

Significantly, the Engelgau patent examiner considered

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> engine throttle valve and a clutch system, is held substantially constant under the same pivotal displacement distance of the pedal pad caused by a driver's depression action of the pedal, irrespective of the adjusted pedal pad position.
>
> Another object of the present invention is to provide a position adjustable pedal assembly, wherein a required depression force or leg power for depressing the pedal pad by the same distance is maintained substantially constant, irrespective of the adjusted pedal pad position.
>
> A further object of the present invention is to provide a position adjustable pedal assembly, wherein a full depression displacement distance of the pedal pad in circumferential direction is held substantially constant by using adjustable stopper means, irrespective of the adjusted pedal position.
>
> A still further object of the present invention is to provide a position adjustable pedal assembly, wherein a reaction force applied to components of the pedal assembly in

(Cont'd)

a patent that was far closer to the Engelgau Patent than was the Asano patent; he also considered numerous patents that were analogous to the CTS 503 Series pedal position sensor. Having considered these superior references, the examiner still allowed the Engelgau Patent to issue. The reference that is superior to Asano is United States Patent No. 5,632,183 ("the Rixon '183 patent"), which was invented by another Teleflex employee and a co-worker of Engelgau. [*See,* **Ex. B.**] The patents that are analogous to the CTS 503 Series pedal position sensors are United States Patent Nos. 4,915,075 ("the '075 patent"); 4,958,607 ("the '607 patent"); 5,233,882 ("the '882 patent"); and 5,887,488 ("the '488 patent") (collectively referred to as "the cited electronic sensor patents") [*See,* **Exs. C, D, E, F.**]

KSR does not discuss the Rixon '183 patent at all in its Invalidity Brief because KSR recognizes that the Rixon '183 patent is closer to the Engelgau patent than is the Asano patent. Similarly, KSR did not discuss any of the cited electronic sensor patents in its Invalidity Brief because KSR

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> the direction along a length of the vehicle, i.e. in the longitudinal direction of the vehicle to be generated in response to the depression force applied to the pedal pad by the driver is considerably reduced so as to attain the strength of the pedal assembly as well as smooth pedal operation feelings.

[*See,* **Ex. K**, col. 1, lines 48-68; col. 2, lines 1-12.] Clearly, none of the objectives that Engelgau sought to address were considered by Asano.

recognized that these patents are at least equivalent to the CTS 503 Series pedal position sensor. In other words, the patent examiner considered the same, or better, prior art than that presented by KSR and determined that the Engelgau Patent was not obvious based on the teachings in that prior art.

3. KSR's Discussion of the Rixon '593 Patent

KSR briefly discusses another Teleflex patent, namely United States Patent No. 5,819,593 ("the Rixon '593 patent") in its Invalidity Brief. [*See*, **Ex. L.**] Unlike the Asano Patent which lacks an electronic control, the Rixon '593 patent depicts an adjustable pedal assembly with electronic control. Therefore, KSR's suggestion that "the 'problem' ostensibly confronting the '565 inventor was to provide an adjustable pedal assembly that could be installed in a vehicle whose engine utilized an electronic, rather than a cable-actuated throttle control system" is completely erroneous. The Rixon '593 patent had already solved that problem. Moreover, given that the inventor of the '593 patent had assigned his invention to Teleflex, there would have been no motivation for Teleflex to engage Engelgau to find a solution to a problem that had already been solved by one of its own employees.

The adjustable pedal assembly depicted in the Rixon '593 patent contains an electronic control situated away from the pedal assembly's support, thereby requiring more complex mounting — both mechanically and electrically — than the Engelgau Patent. The complexity, cost and packaging difficulties associated with the Rixon '593 patent highlighted the problem subsequently addressed by the Engelgau Patent. [*See*, **Ex. A**, ¶7; **Ex. H**, ¶17.]

E. Secondary Considerations of Non-Obviousness Bolster Teleflex's Position that the Engelgau Patent Is Valid

Commercial success represents an objective indicator of non-obviousness. *See, Avia Group Int'l, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1563-64 (Fed. Cir. 1988). Teleflex has experienced considerable commercial success with its adjustable pedal assemblies conceived from the Engelgau Patent. For example, Teleflex's adjustable pedal assembly design has been placed in Ford's U-137/P-131 program. [*See,* **Ex. M**, ¶3.] The U-137/P-131 program vehicles are the Ford Excursion, F-250, and F-350. [*See,* **Ex. M**, ¶4.] To date, Teleflex has shipped approximately 150,000 adjustable pedal units to Ford for the U-137/P-131 program. [*See,* **Ex. M**, ¶5] In addition, upon information and belief, the GMT-800 and GMT-360 platforms are large-volume programs, further demonstrating the commercial success of Engelgau's invention.

VI. CONCLUSION

Based on the stipulated dismissal with prejudice of Teleflex's claim for infringement of the Johansson Patents, this Court need not make any findings with respect to the validity or invalidity of the Johansson Patents. With respect to the Engelgau Patent, KSR has failed to demonstrate via clear and convincing evidence that the combination of elements found in the Engelgau Patent would have been obvious to one of ordinary skill in the art. At least, this is an issue of disputed fact to be decided by a jury. Therefore, Teleflex respectfully requests that this Court deny KSR's

Appendix 1

Motion for Summary Judgment on Invalidity of the Engelgau Patent in its entirety.

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APPENDIX J — REPLY BRIEF IN SUPPORT OF DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF INVALIDITY DATED AND FILED AUGUST 26, 2003

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

Case No: 02-74586

TELEFLEX INCORPORATED,

Plaintiff,

vs.

KSR INTERNATIONAL CO.,

Defendant.

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REPLY BRIEF IN SUPPORT OF DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF INVALIDITY

[Tables intentionally omitted]

On August 8, 2003, plaintiff Teleflex Inc. ("Teleflex") and non-party Technology Holding Company ("THC") stipulated to the dismissal, with prejudice, of Teleflex's claims in this action alleging infringement of U.S. Patent No. 6,305,239 B1 (the "'239 Patent") and U.S. Patent No. 6,374,695 B1 (the "'695 Patent"), in view of published French Patent Application No. 2,739,947 to Urset (see Exhibit 1 hereto, at 2).[1]

1. The Urset reference clearly invalidated the '239 and '695 Patents under 35 U.S.C. § 102(a), as demonstrated in Exhibits 6 and (Cont'd)

Appendix J

This Court on August 11, 2003, ordered the dismissal, with prejudice, of the second and third claims for relief asserted in Teleflex's Second Amended Complaint filed November 18, 2002 (*id.*). This Court further "ORDERED that the '239 Patent and the '695 Patent be and are dedicated to the public under 35 U.S.C. § 253" (*id.* at 3). In view of these developments, the Court need not take any further action on KSR's pending Motion for Summary Judgment of Invalidity filed July 7, 2003, insofar as the '239 and '695 Patents are concerned.[2]

With regard to plaintiff's lone surviving claim for alleged infringement of Claim 4 of U.S. Patent No. 6,237,565 B1 (the "'565 Patent"), Teleflex's Response to KSR's Motion for Summary Judgment of Invalidity ("Pltf. Opp. Br.") does not address or controvert a single one of the facts presented by KSR in support of its defense of invalidity under 35 U.S.C. § 103 (a) (Willemsen Decl. ¶¶ 1-22, 32-44 & Exs. 1-2, 8-12;

(Cont'd)

7 of the Declaration of Larry Willemsen filed July 7, 2003 (hereinafter, "Willemsen Decl.") and in the computer animation files named "Urset" in Exhibit 1 to the Declaration of Daniel H. Kruger filed July 7, 2003 (hereinafter, "Kruger Decl."). *See also* KSR's Brief in Support of Defendant's Motion for Summary Judgment of Invalidity filed July 7, 2003 ("KSR Main Br.") at 4-5, 16-19, and Exhibit 1.

2. It is a measure of this lawsuit's unusual character that Teleflex and THC totally abandoned the '239 and '695 Patents scarcely a month after Teleflex filed a Motion for Summary Judgment of Infringement of those same patents on July 7, 2003.

Kruger Decl. ¶¶ 4-6, 25-30 & Ex. 1; *see* KSR Main Br. at 1-11, 19-35 & Exs. 1, 5-12).

Thus, under Fed. R. Civ. P. 56(c) and (e), this Court can and should determine that there is no genuine issue to be tried as to any of the following facts:

Background

— As of January 26, 1998, the design of accelerator pedals installed in cars and light trucks sold in the United States was substantially determined by the type of engine and fuel system that an automaker specified was going to be installed in a vehicle (Willemsen Decl. ¶¶ 11, 22).

— As of January 26, 1998, an increasing number of vehicles sold in the United States came equipped with electronic throttle control systems ("ETC's"), because such systems offered various operational advantages over cable-actuated throttle control systems such as reduced emissions, improved fuel economy, simplified cruise controls, and improved slip reduction (Willemsen Decl. ¶¶ 9, 34; *see* KSR Main Br. at 23-24 & Exs. 7-8).

— As of January 26, 1988, vehicles equipped with electronic throttle controls, by their very nature, required the use of electronic sensors capable of sensing an accelerator pedal's position and emitting electrical signals corresponding to the pedal's position (Willemsen Decl. ¶ 11, 22).

— As of January 26, 1998, whether a vehicle pedal assembly actuated a cable, or an electronic position sensor,

was dependent on the type of fuel system the pedal was being designed to actuate (Willemsen Decl. ¶ 22).

— As of January 26, 1998, one or more companies in the United States including CTS Corporation of Elkhart, Indiana ("CTS") made and sold modular electronic pedal position sensors that (a) were specifically designed to engage the pivot of an accelerator pedal, and (b) were specifically intended and marketed for use to actuate electronic controls in vehicles, as exemplified by the "position sensor and switch assembly 17" disclosed in U.S. Patent No. 5,385,068 filed December 18, 1992 (Willemsen Decl. ¶ 12; KSR Main Br. at 25 & Ex. 10), and as further exemplified by the CTS "503 Series" sensor installed in certain 1994 Chevrolet C/K pick-up trucks (*id.* ¶¶ 14-19 & Exs. 8-10).

— As of January 26, 1998, coupling a position sensor to a vehicle's accelerator pedal pivot shaft (with the sensor housing attached to the pedal's support bracket) was a standard technique used to enable accelerator pedals to communicate with and actuate electronic throttle controls (Willemsen Decl. ¶¶ 13, 21), as shown in various printed publications in the prior art (e.g., KSR Main Br. Ex. 9, disclosing "potentiometer 12" mounted to "side wall 18" of "support structure 4" and engaged with "axial shaft 76"; KSR Main Br. Ex 10, disclosing "position sensor 17" mounted on "moving bracket 11" and engaged with "shaft 13"), and as further as exemplified by the accelerator pedals installed in certain 1994 Chevrolet C/K pick-up trucks (*id.* ¶¶ 14-19 & Exs. 8-10).

Appendix J

Prosecution History of '565 Patent Claim 4

— The '565 Patent issued on U.S. Application No. 09/643,422 filed August 22, 2000 (the "'422 Application"). The '422 Application was a "continuation" of U.S. Application No. 09/236,975 filed January 26, 1999 (the "'975 Application"). The latter application matured into U.S. Patent No. 6,109,241 issued August 29, 2000 (the "'241 Patent").

— Concurrently with the filing of the '422 Application, Teleflex filed a "Preliminary Amendment" which cancelled all claims that had been made in the "parent" '975 Application, and set forth four new claims designated "Claims 20-23" (see Exhibit 2 hereto; Third Declaration of James W. Dabney, sworn to August 25, 2003 [hereinafter, "Third Dabney Decl."] ¶ 3 & Ex. 2).

— As shown in Exhibit 2 hereto, the original "Claims 20-23" filed by Teleflex in the '422 Application each recited (a) "a support (18) for mounting to a vehicle structure"; (b) "a guide member (62) rotatably supported by said support (18) for pivotal movement about a pivot axis"; (c) "a pedal arm (14) supported on said guide member (62) for rectilinear movement in fore and aft directions relative to said guide member (62) and said pivot axis (26) between various adjusted positions"; and (d) "an electronic control (28) supported on said support (18) and responsive to pivotal movement of said pedal arm (14) and said guide member (62) about said pivot axis" (see Exhibit 2). The original claims were silent with respect to whether the recited pedal

pivot axis remained constant during "rectilinear movement in fore and aft directions" (*id*).[3]

— In an Office Action dated November 6, 2000 (see Exhibit 3 hereto), the Examiner of the '422 Application rejected each of the original "Claims 20-23" as being unpatentable under 35 U.S.C. § 103(a) in view of two references, namely, U.S. Patent No. 5,460,061 to Redding ("Redding"; see Exhibit 4 hereto) and U.S. Patent No. 5,063,811 to Smith ("Smith"; see Exhibit 5 hereto). Redding discloses an adjustable accelerator pedal assembly whose accelerator pedal arm (20) slides back and forth along a guide member (72) (see Exhibit 4 hereto). Smith discloses an electronic pedal position sensor (28) attached to an accelerator pedal support bracket (40, 26) and engaged with a pivot shaft (70) (see Exhibit 5 hereto).

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3. It bears noting that, unlike asserted Claim 4 of the '565 Patent, the original Claims 20-23 of the '422 Application recited structure (e.g., "a guide member (62) rotatably supported") comprising the alleged "invention" described in the application — structure that clearly does not exist in the accused GMT-360 and GMT-800 pedal systems manufactured by KSR. In asserting that the accused GMT-360 and GMT-800 pedal systems purportedly embody the "invention" described in the '565 Patent, Teleflex simply ignores that "claims are directed to the invention that is described in the specification; they do not have meaning removed from the context from which they arose." *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1352 (Fed. Cir. 2001). "[N]either do the claims enlarge what is patented beyond what the inventor has described as the invention." *Id.*

— In concluding that the subject matter recited in original "Claims 20-23" was unpatentable under 35 U.S.C. § 103(a), the Examiner stated (see Exhibit 3 hereto, at 2):

> Smith shows that the use of an electronic throttle control means (28) attached to a support member (40, 26) in a pedal assembly is old and well known in the art. Since the prior art references are from the field of endeavor, the purpose disclosed by Brown [sic] would have been recognized in the pertinent art of Redding. Therefore, it would have been obvious at the time the invention was made to provide the device of Redding with the electronic throttle control means attached to a support member as taught by Smith.

— In response to the Examiner's rejection of its original claims, Teleflex did not traverse, or voice any disagreement with, any of the Examiner's reasoning or conclusions quoted above. Teleflex made no argument, for example, that the subject matter recited in original "Claims 20-23" was patentable because the recited "electronic control" was "attached to the pedal mounting bracket," as opposed to being "attached to the pedal itself," as Teleflex now asserts for the first time in opposition to summary judgment (Pltf. Opp. Br. at 10-11). Teleflex also did not traverse, or voice any disagreement with, the Examiner's conclusion that at the time of the alleged "invention," a person of ordinary skill in the art of the '422 Application would have been motivated to combine, and would have considered it obvious to combine, the electronic position sensor disclosed in Smith (see Exhibit 5 hereto) with the

adjustable pedal assembly disclosed in Redding (see Exhibit 4 hereto) to arrive at what Teleflex was then pointing to, in original Claims 20-23, as the subject matter that Mr. Engelgau purportedly regarded as his "invention."[4]

— Instead, by a further Amendment of the '422 Application dated January 29, 2001 (see Exhibit 6 hereto), Teleflex's patent counsel submitted a wholly new Claim 24 (which became Claim 4 of the '565 Patent) which *excluded* the Redding pedal design from the scope of the subject matter sought to be patented through addition of the limitation, "wherein the position of said pivot (24) remains constant while said pedal arm (14) moves in fore and aft directions with respect to said pivot (24)" (*see* Exhibit 6 hereto, at 2). The Redding reference, by contrast, disclosed an adjustable pedal assembly whose accelerator pedal pivot moved during adjustment (see Exhibit 3 hereto at col. 7, lines 33-38; "As the pedal arm moves fore and aft relative to the adjuster member, cam pin 112 rides in cam member slot 76d to . . . selectively adjust the position of pivot axis pin 110").

— Having thus restated the subject matter sought to be patented using claim language that excluded the adjustable pedal design disclosed in Redding, Teleflex's patent counsel then stated to the Examiner: "Independent claim 24 is a duplicate of claim 15 in the parent application except the

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4. 35 U.S.C. § 112 ¶ 2 requires, as a condition to the issuance of a valid patent, that the "specification" of a patent application "conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

word 'throttle' has been eliminated from claim 15 just in case there could be an argument that claim 15 does not cover the control of a brake system. Accordingly, claim 24 is allowable for the same reasons claim 15 was allowed in parent patent 6,109,241" (see Exhibit 6 hereto, at 3).

— The prosecution history of the "parent patent 6,109,241" exhibits the same pattern as the prosecution history of the '565 Patent: Teleflex originally filed claims reciting "an adjustable pedal assembly (22)" in combination with "an electronic throttle control attached to said support (18)" (see Exhibit 7 hereto, at 7); the claims, as originally filed, were declared unpatentable under 35 U.S.C. § 103(a) in view of Redding and prior art showing that "it would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the device of Redding with the electronic throttle control means attached to a support member" (see Exhibit 8 hereto); and once again, without disagreeing, at all, with the Examiner's reasoning or conclusions as to the obviousness and unpatentability of modifying Redding to include an off-the-shelf pedal position sensor, Teleflex amended what became Claim 15 of the parent '241 Patent to exclude the Redding design from its coverage through addition of the claim language, "wherein the position of said pivot (24) remains constant while said pedal arm (14) moves in fore and aft directions with respect to said pivot (24)" (see Exhibit 9 hereto, at 2).

— During the prosecution of the '565 Patent and its parent, Teleflex submitted three (3) separate Information Disclosure Statements ("IDS's") purporting to disclose prior art of which Teleflex and its patent counsel were aware (see

Exhibit 10 hereto). In not one of those statements did Teleflex disclose U.S. Patent No. 5,010,782 to Asano ("Asano") or U.S. Patent No. 5,722,302 to Rixon ("Rixon '302"), notwithstanding that (a) Teleflex's counsel admittedly was aware of both references at relevant times (KSR Main Br. at 22 & n.12); and (b) both references disclosed adjustable pedal assemblies whose pedal pivots did not move during pedal arm adjustment (see Willemsen Decl. ¶¶ 34-37 & Exs.11-12; Kruger Decl. ¶¶ 4-6, 25-30 & Ex. 1).[5]

Asano Combined With a Pedal Position Sensor

— Asano discloses each and every structure recited in claim 4 of the '565 Patent, with the exception of "an electronic control (28) attached to said support (18) for controlling a vehicle system" (see Exhibit 11 hereto; Willemsen Decl. ¶ 35 & Ex. 12; Kruger Decl. ¶ 5 & Ex. 1). Unlike the Redding reference described above, Asano (KSR Main Br. at 22 & Exs. 1, 6) discloses a position-adjustable pedal assembly (a) whose entire pedal arm (74) moves in

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5. Rixon '302 issued on an application filed October 2, 1996, and unquestionably constituted prior art to the parent '241 Patent under 35 U.S.C. 102(e). Since the filing of KSR's Motion for Summary Judgment of Invalidity, Teleflex has produced documents (Third Dabney Decl. ¶ 12) which establish, clearly and convincingly, that the accelerator pedals embodying the Rixon '302 design were commercially offered for sale by no later than October 24, 1996, thus rendering that design prior art to the '565 Patent under 35 U.S.C. § 102(b). *See Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68-69 (1998) (offer of product for sale triggers application of 35 U.S.C. § 102(b)). Teleflex ironically cites and relies on Rixon '302 in its opposition (see Declaration of Timothy L. Andresen filed August 11, 2003, ¶ 4).

rectilinear, "fore and aft" directions along a guide member, and (b) whose pedal pivot (54) remains in a constant position while the pedal arm (74) moves in "fore and aft" directions with respect to the pivot (Kruger Decl. ¶ 5 & Ex. 1).[6]

— Conventional, off-the-shelf pedal position sensors that were on sale in the United States as of January 26, 1998, including CTS "503 Series" sensors, could have been attached to the accelerator pedal support bracket (50) disclosed in Figure 5 of Asano, for engagement with the disclosed accelerator pedal's pivot shaft (54), without materially altering the Asano pedal (Willemsen Decl. ¶ 36; Kruger Decl. ¶ 6 & Ex. 1).

— Submitted with KSR's Main Brief was a specimen CTS "503 Series" pedal position sensor of a type that was on sale in the United States prior to January 26, 1998 (Willemsen Decl. ¶¶ 18-19 & Exs. 9-10). The housing of the submitted CTS "503 Series" sensor includes two holes for mounting surface fasteners, such as screws (*id.*).

— CTS "503 Series" sensors are modular, completely enclosed units with openings designed to fit over and engage a vehicle pedal's pivot shaft (Willemsen Decl. ¶ 19 & Exs. 9-10). The modular design of CTS "503 Series" position sensors enables those sensors to be installed on different makes and models of vehicle accelerator pedal assemblies (Willemsen Decl. ¶ 19).

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6. Unlike the design embodied in the accused GMT-360 and GMT-800 pedal systems manufactured by KSR, Asano discloses an adjustable pedal system comprising a guide member (52) and a pedal arm (74) that slides in its entirety along the guide member.

Appendix J

— As of January 26, 1998, CTS provided specifications identifying minimum requirements (for example, minimum surface requirements for attachment points) that any person of ordinary skill in the pedal design art could follow and use to design a pedal assembly that would actuate a CTS 503 Series sensor (Willemsen Decl. ¶ 21 & Ex. 9).

— The computer animation file named "Asano_565_claim_4.mpeg", submitted as part of Exhibit 1 to KSR's Main Brief, contains true and accurate representations of (a) the position-adjustable pedal disclosed in Figure 5 of Asano, (b) the accelerator pedal installed in certain 1994 GM pick-up trucks (the "1994 GM ETC Pedal"), and (c) how the modular, CTS "503 Series" position sensor attached to the support of the 1994 GM ETC Pedal could be similarly attached to the support of the Asano pedal (Kruger Decl. ¶¶ 4-6 & Ex. 1; Willemsen Decl. ¶¶ 35-37, 41 & Ex. 12).

— As of January 26, 1998, a person of "ordinary" skill in the art of the '565 Patent would have had a minimum of two (2) years of college level training in mechanical engineering and 2-3 years' work experience spanning at least one complete pedal design "cycle" (Willemsen Decl. ¶ 20).[7]

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7. Plaintiff contends that a person of "ordinary" skill in the art of the '565 Patent would have even more education than KSR believes he or she would have (Pltf. Opp. Mem. at 12 n.9). For purposes of the present motion the Court may assume the correctness of plaintiff's position. Teleflex acknowledges that "[r]egardless of which definition this Court chooses to adopt, the obviousness analysis would remain substantially unaffected" (*id.*).

Appendix J

I. "OBVIOUSNESS" IS A QUESTION OF LAW, NOT A QUESTION OF FACT.

Teleflex asserts that summary judgment is inappropriate because "the true issue between the parties" supposedly is: "Whether *as a factual question*, the Engelgau Patent would have been obvious to one of ordinary skill in the art" (Pltf. Opp. Br. at 1; emphasis added).[8] In fact, as was set forth in KSR's Main Brief (KSR Main Br. at 19), "the ultimate question of patent validity is one of law." *Graham* v. *John Deere Co.*, 383 U.S. 1, 17 (1966). "[W]here the ultimate legal conclusion of obviousness is disputed, but not the underlying facts, there is no issue of fact requiring a trial, even though some facts favor obviousness, some nonobviousness." *Newell Co.* v. *Kenney Mfg. Co.*, 864 F.2d 757, 763 (Fed. Cir. 1988), *cert. denied*, 493 U.S. 814 (1989).

Here there is no dispute as to any of the facts put forward by KSR in support of its Motion for Summary Judgment of Invalidity, as summarized above.[9] Rather, the question raised

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8. As described infra, besides erroneously asserting that "obviousness" is "a factual question," Teleflex's opposition is also erroneous in its focus on the "Engelgau Patent," (Pltf. Opp. Br. at 6), rather that on the subject matter recited in asserted Claim 4 of the '565 Patent.

9. In view of Teleflex's failure to controvert any of the factual predicates put forward by KSR in support of summary judgment, Teleflex's discussion of the "burden of proof" (Pltf. Opp. Br. at 5-6) is beside the point. Regardless of how much proof constitutes "clear

(Cont'd)

to the Court is purely one of law, namely, whether "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). It is well-settled that "a district court can properly grant, as a matter of law, a motion for summary judgment on patent invalidity when the factual inquiries into obviousness present no genuine issue of material facts." *Ryko Mfg. Co.* v. *Nu-Star, Inc.*, 950 F.2d 714, 716 (Fed. Cir. 1991).

It is equally well-settled that "[o]pinion testimony by experts concluding that an invention would or would not have been obvious . . . raise no issue of fact." *Peterson Mfg. Co.* v. *Central Purchasing, Inc.*, 740 F.2d 1541, 1548 (Fed. Cir. 1984) (affirming summary judgment of invalidity under 35 U.S.C. § 103). *Accord Avia Group Int'l, Inc.* v. *L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1562-64 (Fed. Cir. 1988) ("a conflict in the legal opinions of experts creates no dispute of fact"). It is, thus, no bar to summary judgment that Teleflex has found two experts who apparently are prepared to say, in conclusory fashion, that "the Engelgau Patent involved a combination of elements that would not have been obvious

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(Cont'd)
and convincing evidence" of a factual contention, KSR's factual contentions here — e.g., the disclosure of Asano — are totally undisputed. In such circumstances, "the entire question of obviousness is one for the court." *Badalamenti v. Dunham's, Inc.*, 680 F. Supp. 256, 259 (E.D. Mich.) (Feikens, J.), *aff'd mem.*, 862 F.2d 322 (Fed. Cir. 1988). *See Structural Rubber Prods., Inc. v. Park Rubber Co.*, 749 F.2d 707, 721 (Fed. Cir. 1984).

to one of ordinary skill in the art" (Pltf. Opp. Br. at 12-13). "That the parties fervently dispute the ultimate conclusion of obviousness is not enough to raise a factual question." *Structural Rubber Prods., Inc.* v. *Park Rubber Co.*,749 F.2d 707, 721 (Fed. Cir. 1984).

"Whether a reference or a combination of references renders a claimed invention obvious under 35 U.S.C. § 103 is a question of law subject to full and independent review in this court." *In re GPAC Inc.*, 57 F.3d 1573, 1577 (Fed. Cir. 1995). KSR's motion calls upon the Court to determine that the combination of (a) Asano and (b) an off-the-shelf pedal position sensor, such as the CTS "503 Series" sensor, renders the subject matter of asserted claim 4 of the '565 Patent unpatentable as a matter of law, just as the Patent Office earlier ruled that the similar combination of Redding and Smith, described above, was unpatentable under 35 U.S.C. § 103(a) (*see* Exhibits 3-5 hereto). "[W]here the only issue is, as here, the application of the statutory standard of obviousness (35 U.S.C. § 103) to an established set of facts, there is only a question of law to be resolved by the trial judge." *Newell*, 864 F.2d at 762.

II. "OBVIOUSNESS" MUST BE DETERMINED BY REFERENCE TO SUBJECT MATTER RECITED IN AN ASSERTED CLAIM, NOT BY REFERENCE TO SUBJECT MATTER "DEPICTED" IN A PATENT.

On the legal question of validity, the entire thrust of Teleflex's opposition to summary judgment is misdirected and erroneous, for it focuses on "the design *depicted* in the

Engelgau Patent" (Plft. Opp. Br. at 6; emphasis added), rather than "the subject matter sought to be patented," 35 U.S.C. § 103(a), that is, the subject matter recited in asserted Claim 4 of the '565 Patent.

In writing Claim 4 of the '565 Patent, Teleflex's patent counsel chose to describe the alleged "invention" in terms (e.g., "an adjustable pedal assembly (22) having a pedal arm (14) moveable in fore and aft directions") that omitted any description of the physical characteristics and arrangement of the structures depicted in the drawings of the '565 Patent.[10] Far from limiting asserted Claim 4 to the "design depicted in the Engelgau Patent" (Pltf. Opp. Br. at 6), the '565 Patent specification actually states that "[t]he adjustable pedal assembly 22 can be any of various adjustable pedal assemblies known in the art" ('565 Patent at col. 2, lines 55-56; *see* KSR Main Br. & Ex. 5). It is that sweeping

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10. As KSR has elsewhere argued (see Brief in Opposition to Plaintiff's Two Motions for Summary Judgment of Infringement filed July 28, 2003, at 28-29), besides being invalid under 35 U.S.C. § 103, asserted claim 4 of the '565 Patent represents a classic violation of "the doctrine that a patentee may not broaden his product claims by describing the product in terms of function." *General Elec. Co. v. Wabash Co.*, 304 U.S. 364, 371 (1938). Accord *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 243 (1942); *Holland Furniture Co. v. Perkins Glue Co.*, 277 U.S. 245, 257 (1928). It was only by describing Mr. Engelgau's alleged "invention" in terms of its "function", and omitting reference to the physical structures comprising the "invention", that Teleflex could even argue that KSR was making or selling pedal systems embodying that alleged "invention". This is a separate and independent ground for awarding summary judgment to KSR.

claim — not the "design depicted in the Engelgau Patent" — that the Court must evaluate for validity under 35 U.S.C. § 103(a), in view of (a) Asano and (b) electronic pedal position sensors, such as the CTS "503 Series" sensor, that were specifically designed to be attached to vehicle pedal's pivot and support bracket (e.g., KSR Main Br. at 25 & Ex. 10), such as the pivot (54) and support bracket (50) disclosed in Figure 5 of Asano (KSR Main Br. at 22 & Ex. 6).

III. TELEFLEX ERRONEOUSLY RELIES ON ALLEGED "DIFFERENCES" THAT DO NOT EXIST IN ASSERTED CLAIM 4 OF THE '565 PATENT.

Teleflex does not dispute that Asano, in combination with an off-the-shelf pedal position sensor, meets each and every limitation of asserted claim 4 of the '565 Patent (Willemsen Decl. ¶ 35 & Ex. 12; Kruger Decl. ¶ 5 & Ex. 1). Teleflex also does not dispute that combining Asano with an off-the-shelf position sensor would have been obvious to a person of ordinary skill in the art of the '565 Patent, just as the Patent Office ruled that combining Redding with such a sensor would have been unpatentably obvious during prosecution of the 2565 Patent (see Exhibits 3-5 and 8 hereto), a ruling that Teleflex repeatedly acquiesced in (*see* Exhibits 6, 9 hereto).

Yet according to Teleflex, summary judgment should be denied because "combining Asano with an electronic control would not have solved any of the problems confronting Engelgau in his design of the Engelgau Patent" (Pltf. Opp. Br. at 15). This is so, Teleflex argues, because "someone in Engelgau's shoes, who was trying to create an adjustable pedal assembly with an attached electronic control *that was easy to package in a narrow space and was also relatively*

simple and inexpensive, would shun Asano" (Pltf. Opp. Br. at 20; emphasis added).

Teleflex's argument is erroneous at several levels. In the first place, Teleflex's argument simply ignores the language of asserted claim 4 of the '565 Patent. Claim 4 of the '565 Patent is not limited to adjustable pedal assemblies that are "inexpensive", "more easily assembled", or "more conveniently packaged" (Pltf. Opp. Br. at 11, 18). Claim 4 of the '565 Patent similarly does not exclude adjustable pedal assemblies that are "complicated," "expensive", "time consuming to assemble", or "require a significant amount of packaging space" (*id.* at 11, 19). Even assuming, for purposes of argument, that differences of this sort existed between the design disclosed in Asano and "the design depicted in the Engelgau Patent" (*id.* at 6), those alleged differences cannot be relied on to withstand summary judgment, for Teleflex's assignor(s) included no such limitations in asserted claim 4 of the '565 Patent. *E.g.*, *Graver Tank & Mfg. Co.* v. *Linde Air Prods. Co.*, 336 U.S. 271, 277 (1949); *E.I. Du Pont de Nemours & Co.*, 849 F.2d 1430, 1433-34 (Fed. Cir.), *cert. denied*, 498 U.S. 986 (1988).[11]

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11. As noted above, Teleflex and THC produced documents on July 29, 2003, demonstrating that the accelerator pedal described in Rixon '302 constitutes prior art to the '565 Patent (Third Dabney Decl. ¶ 12). The mechanical configuration of the accelerator pedal disclosed in Rixon '302 is virtually identical to that disclosed in the '565 Patent. *See* Kruger Decl. ¶¶ 28-30 & Ex. 1. Thus even assuming, for purposes of argument, that there were any relevance to unclaimed "differences" between Asano and the subject matter recited in claim 4 of the '565 Patent, no such differences exist with respect to Rixon '302.

For similar reasons, Teleflex's assertion, "combining Asano with an electronic control would not have solved any of the problems confronting Engelgau in his design of the Engelgau Patent" (Pltf. Opp. Br. at 15), is legally irrelevant, for asserted Claim 4 of the '565 Patent "reads on" precisely that combination (see Exhibit 11 hereto; Kruger Decl. ¶ 5 & Ex. 1; Willemsen Decl. ¶ 35 & x. 12). Furthermore, the standard of patentability under 35 U.S.C. § 103(a) is not what would have been obvious to Mr. Engelgau (Pltf. Opp. Mem. at 18), but what would have been obvious to "the hypothetical person of ordinary skill in the art who is charged with knowledge of all the contents of the relevant prior art." *In re Carlson*, 983 F.2d 1032, 1037-38 (Fed. Cir. 1992).

Where, as here, "the references are all in the same or analogous fields, knowledge thereof by the hypothetical person of ordinary skill is presumed." *In re Katz*, 933 F.2d 982, 986 (Fed. Cir. 1991). Teleflex's assertion that a person of ordinary skill in the art of the '565 Patent, seeking to develop the subject matter recited in Claim 4 of that patent, would have "shunned Asano" (Pltf. Opp. Br. at 20) is thus erroneous as a matter of law.

IV. TELEFLEX IGNORES PRIOR ART TEACHING THE PLACEMENT OF PEDAL POSITION SENSORS ON PEDAL SUPPORT BRACKETS.

Teleflex's assertion that "[t]he Engelgau Patent provided a feature previously unavailable, specifically, an electronic throttle control attached to the support for controlling an engine throttle" (Pltf. Opp. Br. at 18), as distinguished from being "attached to the pedal itself" (*id.* at 11), is unsupported

and contrary to the record. In fact, during the prosecution of the '565 Patent and its parent, Teleflex *acquiesced* in the Patent Office's conclusion that "the use of an electronic throttle control means (28) *attached to a support member* (40, 26) in a pedal assembly is old and well-known in the art" (see Exhibit 3 hereto, at 2; emphasis added). *Cf. Deere*, 383 U.S. at 34-35 (holding patent invalid where allegedly novel feature was disclosed in prior art).

The prior art further and expressly teaches the preferability of pedal position sensors being mounted adjacent to, and engaged with, an accelerator pedal's *pivot shaft*, regardless of where such a pivot shaft might be located (Willemsen Decl. ¶¶ 13-21 & Exs. 8-10; KSR Main Br. at 23-27). The optional position sensor (42) disclosed in the '565 Patent *follows* this teaching. Teleflex's assertion that "[t]he novelty of the Engelgau Patent stems from the decision to separate the pedal from the electronic control" (Pltf. Opp. Br. at 11) flies in the face of the '565 Patent itself: the optional position sensor (42) disclosed in the '565 Patent is engaged with the pivot shaft (54) of the disclosed position-adjustable pedal assembly (22), in precisely the same way as is shown in the prior art (KSR Main Br. at 25 & Exs. 9-10).

The prosecution history of the '565 Patent also belies Teleflex's speculation (Pltf. Opp. Mem. at 20) that the Examiner of the '565 Patent application supposedly recognized the invalidity arguments put forward by KSR herein, and supposedly formed a legal conclusion as to the patentability of claim 4 of the '565 Patent notwithstanding those arguments. As described at pp. 3-7 above, Teleflex procured allowance of claim 4 of the '565 Patent by (a) filing

an amendment to its original claims that the added limitation, "wherein the position of said pivot (24) remains constant while said pedal arm (14) moves in fore and aft directions with respect to said support" (*compare* Exhibit 2 hereto *with* Exhibit 6 hereto), and then (b) arguing that *with this limitation*, the subject matter of Claim 4 allegedly was patentably distinct from the prior art. Teleflex's prosecution amendment and argument are flatly inconsistent with its theory, put forward for the first time in opposition to summary judgment, that the "non-moving pivot" limitation added by the amendment was known to exist in a *brake* pedal system disclosed in U.S. Patent No. 5,632,183 to Rixon (Pltf. Opp. Br. at 20).

At all events, "[a] patent, in the last analysis, simply represents a legal conclusion reached by the Patent Office", typically "in an *ex parte* proceeding, without the aid of the arguments which could be advanced by parties interested in proving patent invalidity." *Lear, Inc.* v. *Adkins*, 395 U.S. 653, 670 (1969). Such legal conclusions are not binding on this Court, and indeed are not even subject to "deference" on direct appeal from determinations of the Patent Office in *inter partes* proceedings. *See In re Baker Hughes, Inc.*, 215 F.3d 1297, 1300 (Fed. Cir. 2000). Whatever unarticulated legal reason(s) may have lain behind the Examiner's allowance of '565 Patent claim 4 following his receipt of an argument that Teleflex now attempts to disavow, those unknown and unknowable reason(s) have no bearing on KSR's motion. *Cf. Celeritas Techs. Ltd.* v. *Rockwell Int'l Co.*, 150 F.3d 1354, 1360-61 (Fed. Cir. 1998), *cert. denied*, 525 U.S. 1106 (1999) (patent held invalid over reference that had been disclosed to Patent Office).

Teleflex's opposition also ignores a legion of Supreme Court decisions holding that "[t]he mere aggregation of a number of old parts or elements, which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention." *Great Atl. & Pac. Tea Co.* v. *Supermarket Equip. Corp.*, 340 U.S. 147, 152 (1950).[12] Here it is undisputed that asserted claim 4 of the '565 Patent, as written, merely "unite[s] old elements with no change in their respective functions," *Sakraida* v. *Ag Pro, Inc.*, 425 U.S. 273, 281 (1976) (quoting *Great Atl.*, 340 U.S. at 152), and thus clearly fails "the test of validity of combination patents." *Sakraida*, 425 U.S. at 282 (quoting *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co.*, 396 U.S. 57, 60 (1969)). This is a separate and independent ground for awarding summary judgment to KSR.

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12. *Accord Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 281-82 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 60 (1969); *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U.S. 350, 355-56 (1939); *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549 (1938); *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U.S. 477, 486 (1935); *Pickering v. McCullough*, 104 U.S. 310, 318 (1881); *Reckendorfer v. Faber*, 92 U.S. 347, 356-57 (1875); *Hailes v. Van Wormer*, 87 U.S. (20 Wall.) 353, 368 (1873). Teleflex's assertion that "Courts traditionally have been skeptical of" invalidity challenges based on obviousness (Pltf. Opp. Mem. at 7) is unsupported and insupportable. The Supreme Court has "observed a notorious difference between the standards applied by the Patent Office and by the courts." *Graham v. John Deere Co.*, 383 U.S. 1, 18 (1966) (holding two patents invalid under 35 U.S.C. § 103).

Appendix J

V. SECONDARY FACTORS

As its final ground of opposition, Teleflex relies on an Affidavit of Charles Meier ("Meier Aff.") stating that "[t]he adjustable pedal assembly design referenced in the Engelgau patent (U.S. Patent No. 6,237,565) has been placed in Ford's U-137/P131 program," and "Teleflex has shipped approximately 150,000 adjustable pedal units to Ford for the U-137/P-131 program." These facts, even if accepted at face value, are clearly insufficient "to override a determination of obviousness based on primary considerations." *Ryko*, 950 F.2d at 719 (affirming award of summary judgment under 35 U.S.C. § 103(a), notwithstanding that "secondary consideration weighted in favor of" the patentee).

In the first place, the '565 Patent describes two embodiments of a vehicle control pedal apparatus, one comprising a "cable attachment member 78" for actuating an engine throttle cable, and second comprising an optional "electronic throttle control 28". The embodiment comprising a "cable attachment member 78" is *not* protected by '565 Patent claim 4. Teleflex has presented no evidence identifying its sales of pedal systems embodying the subject matter of asserted claim 4, as distinct from cable-actuated accelerator pedal assemblies that are described but not claimed in the '565 Patent.[13]

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13. Teleflex's failure to claim the cable-actuating version of the pedal system described in the '565 Patent demonstrates, in dramatic fashion, that the purported "invention" of Mr. Engelgau consisted of nothing more than adding an off-the-shelf pedal position sensor to an otherwise old and (in 1999) clearly unpatentable design.

Equally important, "secondary" considerations such as "commercial success" are "relevant only in a close case where all other proof leaves the question of invention in doubt." *Dow Chem. Co.* v. *Halliburton Oil Well Cementing Co.*, 324 U.S. 320, 330 (1945). This is not such a case. *Cf. Sakraida*, 425 U.S. at 282-83 (holding patent invalid under 35 U.S.C. § 103(a) notwithstanding "commercial success" of alleged "inventions"); *Anderson's-Black Rock*, 396 U.S. at 60 (same).

CONCLUSION

For the reasons set forth above and in KSR's Main Brief, the Court should grant summary judgment dismissing the sole surviving claim of the Complaint.

Dated: August 26, 2003

Respectfully submitted,
DICKINSON WRIGHT PLLC

By _____

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APPENDIX K — THIRD DECLARATION OF JAMES W. DABNEY DATED AUGUST 25, 2003 AND FILED AUGUST 26, 2003

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

Case No: 02-74586

TELEFLEX INCORPORATED,

Plaintiff,

vs.

KSR INTERNATIONAL CO.,

Defendant.

THIRD DECLARATION OF JAMES W. DABNEY

1. My name is James W. Dabney. I am a member of the Bar of the States of New York and New Jersey and of the firm of Pennie & Edmonds LLP, co-counsel for defendant KSR International Company ("KSR") in this action. I make this declaration in further support of KSR's Motion for Summary Judgment of Invalidity filed July 7, 2003. I have personal knowledge to the matters stated in this declaration.

2. Exhibit 1 to the accompanying Reply Brief in Support of Defendant's Motion for Invalidity ("Defendant's Reply Brief") is a Stipulation and Order for Dismissal With

Prejudice of Claims II and III of Teleflex's Second Amended Complaint in this action.

3. Exhibit 2 to Defendant's Reply Brief is a Preliminary Amendment dated August 22, 2000, that was filed in support of U.S. Application No. 09/643,422 (the "'422 Application"), which application matured into U.S. Patent No. 6,237,565 B1 (the "'565 Patent").

4. Exhibit 3 to Defendant's Reply Brief is an Office Action dated November 6, 2000, that was issued with respect to the '422 Application.

5. Exhibit 4 to Defendant's Reply Brief is a copy of U.S. Patent No. 5,460,061 to Redding ("Redding"), which reference was cited in Exhibit 3 hereto.

6. Exhibit 5 to Defendant's Reply Brief is a true copy of U.S. Patent No. 5,063,811 to Smith ("Smith"), which reference was cited in Exhibit 3 hereto.

7. Exhibit 6 to Defendant's Reply Brief is an Amendment dated January 29, 2001, that was filed in support of the '422 Application.

8. Exhibit 7 to Defendant's Reply Brief are excerpts from U.S. Application No. 09/236,975 filed January 26, 1999 (the "'975 Application"), which application matured into U.S. Patent No. 6,109,241 (the "'241 Patent"), commonly referred to as the "parent" of the '565 Patent.

9. Exhibit 8 to Defendant's Reply Brief is an Office Action dated December 10, 1999, that was issued with respect to the '975 Application.

10. Exhibit 9 to Defendant's Reply Brief is an Amendment dated March 22, 2000, that was filed in support of the '975 Application.

11. Exhibit 10 to Defendant's Reply Brief comprises true copies of three (3) Information Disclosure Statements that were filed in support of the '422 Application and the '975 Application.

12. Attached to this declaration are copies of documents that counsel for plaintiff produced on July 29, 2003.

I, JAMES W. DABNEY, hereby declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Dated: August 25, 2003

_____

James W. Dabney

Appendix K

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